

TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1910.

No. 139.

MARK JACOBS, APPELLANT,

vs.

JOSEPH BEECHAM.

APPEAL FROM THE UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT.

FILED JANUARY 28, 1909.

(21,498.)

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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1908.

No. 702.

MARK JACOBS, APPELLANT,

vs.

JOSEPH BEECHAM.

APPEAL FROM THE UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT.

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Complainant's Bill.

United States Circuit Court,

EASTERN DISTRICT OF NEW YORK.

JOSEPH BEECHAM,
Complainant,
against
MARK JACOBS,
Defendant.

} In Equity.

2

To the Honorable the Judges of the Circuit Court
of the United States in and for the Eastern
District of New York:

3

JOSEPH BEECHAM, trading under the name
of Thomas Beecham, a citizen of, and residing in
the Kingdom of Great Britain and Ireland, and
a subject of the King thereof, brings this his Bill
of Complaint against Mark Jacobs, a citizen of,
and residing in, the State of New York.

And thereupon your orator complains and says:

FIRST.—That he is a citizen and resident of the
Kingdom of Great Britain and Ireland, and re-
sides at Huyton, Lancashire, England.

4

SECOND.—That the defendant, Mark Jacobs, is
a citizen and resident of the State of New York, re-
siding in the town of Maspeth, Long Island, in said
State.

5 THIRD.—That continuously since the year 1884
 your orator, either alone or while in partnership
 with his father, Thomas Beecham, has manufac-
 tured and sold great quantities of medicinal pills,
 made of uniform shape and composition. That
 these pills are made for human use in accordance
 with a certain secret formula which is the property
 of your orator, and that they are of the class known
 generally as proprietary or patent medicines. That
 your orator has made such sales in immense num-
 6 bers and in many parts of the world, and in par-
 ticular that your orator has sold continuously since
 1884, and your orator's father, the said Thomas
 Beecham, did sell continuously for many years
 prior thereto, the said pills, in the City of New
 York, and in all the larger cities in the United
 States, besides selling them in many other places
 throughout the country.

7 FOURTH.—That ever since your orator's father,
 the said Thomas Beecham, began to sell the said
 pills in the United States, either he, or your orator,
 or both in partnership, have continuously printed
 upon all labels pasted on all wooden boxes contain-
 ing said pills, and on all cartons or cardboard
 boxes to hold the wooden boxes of pills, and upon
 all circulars wrapped about, or within said wooden
 boxes, and upon all advertisements the words
 "Beecham's Pills," and that your orator still con-
 tinues so to do. That such words have in all cases
 8 been used to indicate that the said pills were made
 and sold by your orator or his father, the said
 Thomas Beecham, or both in partnership, and that
 they have indeed indicated such fact, and that the
 said pills so made by your orator, or his said father,
 or by both in partnership, have become very widely
 known to the public throughout this country by the
 name of "Beecham's Pills" and have never been

known by any other name. That the name "Beech- 9
 am's Pills" has, moreover, been exclusively used to
 designate such pills in this country.

FIFTH.—That the said pills are spherical in form
 and are covered with a tasteless white coating.
 That they are put up in cylindrical wooden boxes
 of two sizes, of which the larger is one and three-
 eighths inches in diameter and one inch in height,
 and contains forty pills. That upon the top of 10
 such box is pasted an orange label upon which are
 printed the words "Beecham's Patent Pills. Price
 25 Cents, sold by the Proprietor, St. Helens, Lan-
 cashire, England." That about the circular surface
 of the box is another label containing the words
 "Beecham's Patent Pills, St. Helens, Lancashire,"
 and further upon the top are repeated the words
 "Beecham's Pills, Saint Helen's." That around the
 outside of the box is wrapped a circular a copy of
 which is annexed to this bill marked Schedule "A,"
 and by this reference made a part hereof. 11

SIXTH.—That on the 23rd day of August, 1887,
 your orator and his father, Thomas Beecham, were
 located at St. Helen's, Lancashire, England and
 were, and had for three years been, engaged in ship-
 ping from Great Britain the aforesaid pills to the
 United States of America for sale therein, and in
 particular in the City of New York. That the said
 Kingdom of Great Britain and Ireland was then
 and is now a country affording to citizens of the 12
 United States similar privileges of registering
 trade-marks to those afforded at that time in the
 United States to citizens of other countries.

SEVENTH.—That on said 23rd day of August,
 1887, the said Thomas Beecham, on behalf of the
 firm consisting of himself and your orator, and in

- 13 accordance with the Act of Congress in that case
made and provided, upon due application therefore,
duly procured the registration as a trade-mark
under the said Act of the words "Beecham's Pills."

- EIGHTH.—That the said name "Beecham's Pills"
was the first applied to any pills or to any medicinal
or other article by your orator's father, Thomas
Beecham, more than fifty (50) years ago, at the
time when he first manufactured and sold the same.
14 That the said Thomas Beecham continued alone
to manufacture and to sell said pills from that time,
and to print upon all the labels, circulars, cartons
and advertisements used in connection with said
pills the name "Beecham's Pills," until his retire-
ment as hereinafter set forth. That in the year
1884 your orator and the said Thomas Beecham
mutually signed articles of copartnership and
entered into partnership in the said business, and
that the said Thomas Beecham and your orator con-
15 tinued to conduct the said business in partnership
and to manufacture the said Pills until the year
1895. That during the year 1895 the said Thomas
Beecham assigned to your orator his entire interest
and title in and to all the property possessed or
owned by the said partnership, including all his
right, title and interest to the use of the said trade-
mark "Beecham's Pills," both at common law and
under the aforesaid statute. That since the time of
such assignment your orator has exclusively used
16 said trade-mark and the name "Beecham" as above
set forth.

NINTH.—That the defendant is the manufacturer
and vendor of certain medicinal pills for human
use, and upon the labels pasted upon the boxes con-
taining said pills, without the consent of your
orator, he now prints and threatens and intends to
continue to print the words "Beecham's Pills" and

in general has adopted and threatens and intends to 17
 continued to adopt the name "Beecham's Pills" to
 indicate the pills so manufactured and sold by him,
 and in so doing falsely and maliciously to represent
 and indicate that his said pills are in fact manu-
 factured by your orator, to the great damage and
 hurt of your orator. That by so doing the said de-
 fendant, by the use of a name substantially iden-
 tical with the trade-mark of your orator, has re-
 produced, counterfeited, copied and colorably 18
 imitated his said trade-mark of your orator, and
 diverts and fraudulently intends to divert to him-
 self from your orator prospective customers, and to
 induce them to buy his pills as and for pills made
 by your orator, and by so doing to injure and de-
 stroy the trade-mark of your orator, in creating
 which your orator has expended hundreds of thou-
 sands of dollars in the United States alone.

TEXTIL.—That the defendant put up his pills in
 cylindrical wooden boxes of exactly the same size 19
 as your orator's. That the pills are spherical in
 form and covered with a tasteless white covering,
 and are not distinguishable from your orator's
 except by a person expert in the business, or by
 one who has both pills before him. That upon the
 top of the box the defendant pastes a circular
 orange label containing the words "Beecham
 (price 25 cents) Pills manufactured and sold by
 Mark Jacobs, Maspeth, L. I., N. Y., U. S. A." In
 addition is a scroll of the letters "B P C" and the 20
 words (in the finest type), "Copyright 1905 by
 Mark Jacobs." That the words "Beecham Pills"
 are more than twice as large as any other printing
 on the label. Around the box is a white label with
 the words "Beecham Pills" twice repeated and
 the words "To open box cut on this line. Non exiet
 genuine without this signature, Mark Jacobs."

21 Within the box is a circular describing the merits of the pills. That the defendant has deposited in Patent Office and has attempted to obtain, and has obtained, a registration under the copyright act of the above-described label, in so far as the Act of Congress permits him to obtain such registration, in aid of his fraudulent imitation of your orator's trade-mark.

22 ELEVENTH.—That the defendant, in so making and putting up his pills, has falsely, fraudulently and maliciously imitated colorably the appearance and make-up of your orator's pills, and has intended, and still intends, to pass the same off as and for the pills of your orator, and falsely, fraudulently and maliciously to divert from your orator customers who would buy and have bought his pills, and fraudulently to indicate that the said pills are in fact and truth the pills made and sold by your orator. That he does in fact falsely, fraudulently and
23 maliciously so divert customers from your orator, and procures purchases of persons desiring and intending to purchase of your orator.

TWELFTH.—That the defendant further wrongfully, maliciously and fraudulently uses and intends and threatens to use in his said business of manufacturing and selling said pills the name "Beecham Pill Company," to indicate and denote himself, and with the fraudulent intention of
24 diverting from this plaintiff prospective purchasers of his pills, and of leading them to believe that he, the defendant, is your orator, and that in buying pills sold by him they are buying pills manufactured and sold by your orator, all to the great damage and loss of your orator, and that by so doing he does in fact so divert customers from

your orator and lead them to believe that he is 25
 your orator or authorized or connected in some
 way with your orator.

That the defendant has further filed in the office
 of the Clerk of the County of New York, a written
 statement signed and acknowledged by himself,
 asserting his intention to do the business of mak-
 ing and selling medicines under the name "Bee-
 cham Pill Company". That such statement is as-
 serted to be in conformity with the provisions of 26
 Section 363b of the Penal Code of the State of
 New York, and is in such conformity except for the
 fact that the said Code does not authorize a fraud-
 ulent imitation of your orator's name such as the
 defendant has adopted.

THIRTEENTH.—That the defendant was present at
 the criminal prosecution by your orator before a
 City Magistrate of the City of New York, during
 October and November, 1904, of one Simeon B. 27
 Minden and others, for the fraudulent counter-
 feiting of your orator's trade-mark, which said
 prosecution resulted in the conviction, at the Court
 of Special Sessions in the County of New York, of
 the said Minden and his two clerks and of one
 accomplice. That the excuses therein attempted to
 be set up by the said Minden were that your orator
 had used the word "Patent" upon his pills, and had
 alleged that the pills were made in England, while
 the fact was asserted to be that the pills were not 28
 patented and the pills were made in Brooklyn, New
 York. That the defendant now, as a fictitious and
 fraudulent excuse for his fraudulent and dishonest
 simulation of your orator's name, trade-mark and
 make-up, alleges that your orator has no right to
 protect his trade-mark, first, because he uses the
 word "Patent" upon his labels, second, because

29 your orator asserts that the pills are made by
 Thomas Beecham, while they are in fact made by
 your orator; third, because your orator asserted
 that the pills are made in England, while they are
 in fact made in America; fourth, that the assign-
 ment of the registered trade-mark from Thomas
 Beecham to your orator has not been registered in
 Washington at the Patent Office. That all but the
 first of the aforesaid fraudulent and fictitious ex-
 30 cuses are untrue in fact, and that as to the first
 your orator submits to the Court that there is no
 statement anywhere upon your orator's labels or
 packages that his pills are patented. Your orator
 asserts that his pills are of the kind of medicine
 known as proprietary, or patent medicine, which
 terms in no sense indicate, or are intended to in-
 dicate, that the composition so designated is made
 under Letters Patent, and he further asserts that
 the word when used to denote such a medicine is
 31 not understood to indicate that the medicine is
 patented. That these excuses are put forward by
 the defendant solely in the hope of extorting money
 from your orator as the price of discontinuing his
 fraudulent imitation of your orator's name, trade-
 mark and make-up, and that the said defendant has
 already attempted to procure money of your orator
 in a so-called settlement of his alleged rights in the
 matter.

32 FOURTEENTH.—That the value of your orator's
 trade-mark "Beecham's Pills" is greater than the
 sum of Two Thousand (\$2,000) Dollars.

For as much as your orator can have no ade-
 quate relief except in this Court, and to the end
 therefore, that the defendant may, if he can, show

why your orator should not have the relief hereby
 prayed, and may make a full discovery and dis-
 closure of all the matters aforesaid, and according
 to the best and utmost of his knowledge, remem-
 brance, information and belief, full, true, direct
 and perfect answer make to the matters hereinbe-
 fore stated and charged, but not under oath; an
 answer under oath being hereby expressly waived.

And that the defendant may be decreed to account
 for and pay over the income or profits which have
 been unlawfully derived from the violation of your
 orator's rights, and may be restrained from any
 further violation of said rights, your orator prays
 that your Honors may grant a writ of injunction
 issuing out of and under the seal of this Honorable
 Court, perpetually enjoining and restraining the
 said defendant, his agents, servants, employees,
 workmen, attorneys or any other persons at his
 procurement, from using the words, "Beecham
 Pills" or "Beecham's Pills," or any other word or
 words of similar sound, or any word or words
 calculated to deceive any person into sup-
 posing that the word or words so used were that of
 your orator's pills, in or upon or concerning any
 pills, or other medicinal preparations, prepared,
 manufactured, boxed, put up, sold, exposed for sale,
 or in any way disposed of by the defendant; and
 from using the name "Beecham Pill Company" or
 any other name of like sound, tenor, or import, in,
 for, or regarding his business of any kind, or to de-
 note him, the said defendant, or any person in his
 employ or service, or in any other manner or form,
 whatsoever; and from continuing to make, prepare,
 box, put up, sell, expose for sale, or in anywise
 dispose of, pills of appearance similar to the ap-
 pearance of those pills which he now makes and
 sells, or similar in appearance to the pills pre-

37 pared or sold by your orator, and from dressing,
 selling or exposing for sale said pills in the man-
 ner in which his said pills are now dressed, sold or
 exposed for sale, in particular in the size of the
 boxes, the color and general appearance of the
 label and the character of the circular within said
 box; and from putting up, selling or exposing for
 sale any of said pills in any manner, form or method
 similar to that of the make up of the pills prepared
 and sold by your orator, or in any manner, form or
 38 method calculated in any wise to cause the defend-
 ant's pills or their boxes, labels or circulars to be
 mistaken for the pills made and sold by your orator.

And that your Honors, upon the rendering of
 the decree above prayed, may assess or cause to
 be assessed, in addition to the profits to be account-
 ed for by the defendant as aforesaid, the damages
 that your orator has sustained by reason of the
 defendant's infringement of his rights.

39 And further, that your Honors may grant a writ
 of temporary injunction issuing out of and under
 the seal of this Honorable Court, in terms as above
 prayed for by your orator, in the case of a perpetual
 injunction, said temporary writ to endure, how-
 ever, only during the pendency of this cause and
 until the final decree herein. And that your orator
 may have such other and further relief as the equity
 of the cause may require, and as to your Honors
 may seem meet;

40 Now, therefore, may it please your Honors, to
 grant unto your orator not only a writ of injunc-
 tion conformable to the prayer of this bill, but also
 a writ of subpoena of the United States of America
 directed to the said Mark Jacobs commanding him,
 on a day certain therein stated, to appear and
 answer unto this bill of complaint, and to abide
 such order and decree in the premises as to the

Court may seem proper, and according to the principles of equity and good conscience. 41

GOULD & WILKIE,
Solicitors for the Complainant.

LEARNED HAND,
Of Counsel.

UNITED STATES OF AMERICA,	} ss. :	42
Southern District of New York,		
County of New York,		

On this 5th day of February, 1906, before me personally appeared WALTER JANVIER, who, being by me duly sworn, deposes and says: That he has read the foregoing bill of complaint, and that the same is true of his own knowledge, except as to the matters therein stated on information and belief, and that as to those matters he believes it to be true. 43

Deponent further says that he is the Secretary and Treasurer of the B. F. Allen Company, a domestic corporation, which is the sole agent for the complainant Joseph Beecham herein in the United States of America; that the said Joseph Beecham is a citizen and resident of the Kingdom of Great Britain and at present not within the County of New York nor in the United States of America. 44

WALTER JANVIER.

Subscribed and sworn to before
me this 5th day of February, 1906. }

EDW. L. WATERBURY,
[SEAL.] Notary Public, No. 28,
N. Y. Co.

- 45 **Circular around the Twenty-five cent
box, attached to Bill.**

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48

Defendant's Answer.

49

CIRCUIT COURT OF THE UNITED STATES,

EASTERN DISTRICT OF NEW YORK.

JOSEPH BEECHAM,

Complainant,

against

MARK JACOBS,

Defendant.

In Equity.

50

The defendant now and at all times hereafter saving and reserving unto himself all benefit and advantage of exception which can or may be had or taken to the many errors, uncertainties and other imperfections in the said bill contained for answer thereto or to so much and parts thereof as this defendant is advised by counsel is material or necessary for him to make answer unto, answering, says: 51

This defendant has no information sufficient to form a belief as to whether or not complainant is a citizen or resident of the Kingdom of Great Britain and Ireland or that he resides at Huyton, Lancashire, England, and therefore calls for strict proof of same.

This defendant further answering said bill of complaint, admits that he is a citizen and resident of the State of New York, residing in the Town of Maspeth, Long Island, in the said State. 52

This defendant further answering said bill of complaint, says: he has no information sufficient to form a belief as to whether or not continuously or otherwise, since the year 1884 said complainant, either alone or while in partnership with his father,

53 Thomas Beecham, manufactured or sold great quantities or any quantity of medicinal or that such pills are made of uniform shape and composition or otherwise or that the pills are made for human use or in accordance with a certain secret formula which is the property of the complainant or that they are of the class known generally as proprietary or patent medicines. This defendant has no knowledge sufficient to form a belief and therefore calls for strict proof of said allegations.

54 This defendant further answering said bill of complaint, says that he has no information sufficient to form a belief as to whether or not the complainant has made any sales in immense numbers or in any numbers in any part of the world or since 1884 or that Thomas Beecham sold pills for many years prior to 1884 in the City of New York or any large City in the United States and this defendant has no information sufficient to form a belief and therefore calls for strict proof of such allegations.

55 This defendant further answering the said bill of complaint says he has no information sufficient to form a belief as to whether or not the complainant's father, Thomas Beecham, sold pills in the United States either alone or with the complainant either in partnership or otherwise, or as to whether the complainant continuously printed upon labels or pasted on wooden boxes or on cartons or cardboard boxes or upon any circulars wrapped about or within wooden boxes or upon advertisements the words "Beecham's Pills" or that the complainant still continues to print or paste said words or that such words have in all cases been used to indicate that pills were made and sold by the complainant alone or with his father, the said Thomas Beecham, in partnership. This defendant

has no information sufficient to form a belief and therefore calls for strict proof of said allegations. 57

This defendant further answering the said bill of complaint, admits that the designation "Beecham's Pills" have indeed indicated that the said pills were made and sold by Thomas Beecham and that the said words "Beecham Pills" have become very widely known to the public throughout the country and have never been known by any other name and that the name "Beecham's Pills" has been exclusively used to designate certain pills in this country. 58

The defendant further answering the said bill of complaint, admits that the pills designated as "Beecham's Pills" are spherical in form and are covered with a tasteless white coating, and which are put up in cylindrical wooden boxes and that upon the top of such boxes is pasted an orange label upon which are printed the words "Beecham's Patent Pills. Price 25 Cents, sold by the Proprietor, St. Helens, Lancashire, England," and that about the box is another label containing the words "Beecham's Pills," and a garter scroll containing the words "Beecham's Patent Pills, St. Helens, Lancashire," and that further, upon the top are repeated the words "Beecham's Pills, Saint Helens," and that around the outside of the box is wrapped a circular. The defendant does not know the number of pills contained in said boxes, but this defendant denies that around the outside of the box or boxes of pills mentioned and described in the bill of complaint is wrapped a circular, a copy of which is annexed to the copy of the complaint marked Schedule "A" and made part thereof, and alleges that around the boxes was at all times, until very recently, wrapped a circular different from 59 60

- 61 the said circular Schedule "A" annexed to the complaint herein, and that the said circular thus wrapped around contained the false statement and representation that Thomas Beecham was proprietor of the pills mentioned and described in the complaint herein and that they were manufactured in Saint Helens, England.

- 62 This defendant says that he has no knowledge or information sufficient to form a belief as to whether on the 23d day of August, 1887, or at any time, the complainant and his father, Thomas Beecham, or either of them, were located at St. Helen's, Lancashire, England, or were or had for three years been, engaged in shipping from Great Britain the pills mentioned and described in the bill of complaint to the United States of America or elsewhere, for sale therein or whether the same was so shipped in particular to the City of New York, and calls for strict proof thereof.

- 63 This defendant admits that the said Kingdom of Great Britain and Ireland was then and is now a country affording to citizens of the United States similar privileges of registering trade-marks to those afforded at that time in the United States to citizens of other countries.

- 64 This defendant says that he has no knowledge or information sufficient to form a belief as to whether on the 23rd day of August, 1887, or at any time, Thomas Beecham, either on behalf of the firm consisting of himself and the complainant or otherwise, and in accordance with the act of Congress in that case made and provided, or otherwise, upon due application therefor, duly procured the registration as a trade-mark under the said Act of Congress of the words "Beecham's Pills" and requires strict proof thereof.

This defendant says: that he has no knowledge 65
 or information sufficient to form a belief as to
 whether or not the name "Beecham's Pills" was first
 applied to any pills or to any medicinal or other
 articles by the father of the complainant, Thomas
 Beecham, more than fifty (50) years ago, or at any
 time, or at the time when he first manufactured and
 sold the same, or at any time, or as to whether the
 said Thomas Beecham continued alone or otherwise
 to manufacture and to sell said pills from that time, 66
 and to print upon all or any of the labels, circulars,
 cartons or advertisements used in connection with
 said pills the name "Beecham's Pills," until his re-
 tirement as in the bill of complaint set forth or
 otherwise, or as to whether in the year 1881 the
 complainant or the said Thomas Beecham specially
 signed articles of copartnership and entered into
 partnership in the said business, and that the said
 Thomas Beecham and the complainant, or either of
 them, continued to conduct the said or any business 67
 in partnership or otherwise, or to manufacture the
 said or any pills until the year 1895, or as to
 whether or not the year 1895, the said Thomas
 Beecham assigned to the complainant his en-
 tire or any interest and title in or to any
 of the property possessed or owned by the
 said or any partnership, or whether such or
 any assignment included all or any of his
 right title and interest to the use of the trade-mark
 "Beecham's Pills" both at common law or under 68
 the statute regarding the registration of trade-
 marks or otherwise, and requires strict proof there-
 of.

This defendant, upon information and belief, de-
 nies that since the time of the alleged assignment
 in the bill of complaint herein referred to, that the
 complainant has exclusively used the trade-mark or

69 the name "Beecham" as in the said bill of complaint set forth, or otherwise.

This defendant admits that he is the vendor of certain medicinal pills for human use, but denies that he is the manufacturer thereof and denies that upon the labels pasted upon the boxes containing said pills, without the consent of the complainant or otherwise, he now prints or threatens or intends to continue to print the words "Beecham's Pills" or that he has in general or otherwise adopted or
70 threatens or intends to continue to adopt the name "Beecham's Pills" to indicate special pills so manufactured or sold by him, and in so doing falsely and maliciously or otherwise, to represent or indicate that his said pills or any pills are in fact manufactured by the complainant, to the great or any damage or hurt of the complainant or otherwise, or that by so doing this defendant, by the use of a name substantially identical with the alleged trademark of the complainant, has reproduced, counter-
71 feited, copied and colorably imitated said trademark or diverts or fraudulently intends to divert to himself from the complainant any prospective customers or other customers, or to induce them to buy his pills as or for pills made by the complainant or that by so doing intends to injure or destroy the trade-mark of the complainant, or that in creating such trade-mark, the complainant has expended hundreds of thousands of dollars in the United
72 States alone, but this defendant admits that he sells and intends to continue to sell pills packed up in wooden boxes containing thereon the words "Beecham Pills" and stating thereon that such "Beecham Pills" were manufactured by this defendant and that he intends to continue so to do for the reason that a certain medicinal preparation containing certain ingredients being the same ingredients con-

tained in the pills described in the bill of complaint 73
 herein set forth as being manufactured and sold by
 the complainant and in the pills admitted as being
 sold by this defendant has become known in com-
 mon usage as "Beecham's Pills" and that the word
 "Beecham" in connection with such pills has be-
 come known as descriptive of the combination of
 ingredients thus contained in the said pills and has
 become a word of common use and designation.

This defendant denies that he puts up his pills in 74
 cylindrical wooden boxes of exactly the same sizes
 as the complainant's, but he admits that the pills
 are spherical in form and covered with a tasteless
 white covering, but denies that they are not distin-
 guishable from the complainant's except by a per-
 son expert in the business, or by one who has both
 pills before him. He admits that upon the top of
 the box put up by this defendant he pastes a circu-
 lar yellow label containing the words "Beecham
 (price 25 cents) Pills, manufactured and sold by
 Mark Jacobs, Maspeth, L. I., N. Y., U. S. A.," and 75
 that in addition there is a scroll of the letters
 "B. P. C." and the words "Copyright 1905 by Mark
 Jacobs." That the words "Beecham Pills" are twice
 as large as any other printing on the label. Around
 the box is a white label with the words "Beecham
 Pills" twice repeated and the words "To open box
 cut on this line. None genuine without this signa-
 ture, Mark Jacobs." That within the box is a cir-
 cular describing the merits of the pills. That the
 defendant has deposited in the Patent Office and 76
 has attempted to obtain, and has obtained,
 a registration under the copyright act of the
 above-described label, but he denies that any
 or either of the acts herein before set forth
 were or are in aid of any fraudulent imi-
 tation of the complainant's trade-mark, and he de-
 nies that in so making or putting up his pills he has

- 77 falsely, fraudulently and maliciously imitated colorably the appearance and make up of the complainant's pills, or has intended or still intends to pass the same off as and for the pills of the complainant, or falsely, fraudulently and maliciously, or otherwise, to divert from the complainant's customers who would buy or would have bought his pills, or fraudulently or otherwise indicates that the said pills are in fact and in truth made or sold by the complainant or that he does in fact, or otherwise, falsely, fraudulently or maliciously divert any customers from the complainant or procures purchases of persons desiring and intending to purchase of the complainant.
- 78

- This defendant also denies that he wrongfully, maliciously and fraudulently or otherwise, uses or intends or threatens to use in his said business or any business in the manufacturing or selling said or any pills, the name "Beecham Pill Company," to indicate or denote himself, or with the fraudulent or any other intention from diverting from the complainant prospective purchasers of his pills, or of leading them to believe that this defendant is the complainant or that in buying pills sold by him they are buying pills manufactured or sold by the complainant, or that said or any acts are to a great or any damage or at a loss to the complainant, or that by so doing or otherwise, does in fact or otherwise divert customers from the complainant or lead them to believe that he is the complainant or authorized or connected in some way with the complainant.
- 79
- 80

This defendant admits that he has filed in the office of the Clerk of the County of New York a written statement signed and acknowledged by himself, asserting his intention to do the business of making and selling medicines under the name

"Beecham Pill Company," and that such statement is in conformity with the provisions of Section 363B of the Penal Code of the State of New York, but denies that the said Penal Code does not authorize a fraudulent or any imitation of the complainant's name such as the defendant has adopted. 81

This defendant admits that he was present at the Criminal prosecution by this complainant at a City Magistrate Court of the City of New York, during October and November, 1904, of one Simon B. Minden and others for the alleged fraudulent counterfeiting of the complainant's trade-mark, but he denies that he has any knowledge or information sufficient to form a belief as to whether the said prosecution resulted in the conviction at the Court of Special Sessions in the County of New York of the said Minden and his two Clerks and of one accomplice, or of either or as to whether the excuses therein attempted to be set up by the said Minden were that this complainant had used the words "Patent" upon his pills, and had alleged that the pills were made in England, while the fact was asserted to be that the pills were not patented and the pills were made in Brooklyn, New York, and demands strict proof thereof. 82

This defendant denies that as a fictitious and fraudulent excuse for his alleged fraudulent and dishonest simulation of the complainant's name, trade-mark or make-up, or otherwise, alleges that the complainant has no right to protect his trade-mark, first, because he uses the word "Patent" on his labels; second, because he asserts that the pills are made by Thomas Beecham, when in fact they are made by the complainant; third, because he asserts that the pills are made in England, while they are in fact made in America; fourth, because the assignment of the registered 83

85 trade-mark from Thomas Beecham to the complain-
 ant has not been registered in Washington at the
 Patent Office, and he denies that any of such alleged
 excuses are untrue in fact, and he denies that there
 is no statement anywhere upon the complainant's
 labels or packages that his pills are patented, but
 he admits that the complainant's alleged pills are
 of the kind of medicines known as proprietary, but
 denies that they are known as a patent medicine or
 that such term in no sense indicates or is intended
 86 to indicate that the composition so designated is
 made under Letters Patent, or that the word when
 used to denote such medicine is not understood to
 indicate that the medicine is patented, or that such
 or any excuses are put forward by this defendant
 solely or otherwise, in the hope of extorting money
 from the complainant as the price of discontinuing
 his alleged fraudulent imitation of the complain-
 ant's name, trade-mark or make-up or otherwise,
 or that this defendant has at any time attempted to
 87 procure money from the complainant in a so-called
 settlement of his alleged or other rights in the mat-
 ter or otherwise, and this defendant alleges that in
 truth and in fact the complainant is not entitled
 to any injunction or other relief in this or any
 Court of equity or otherwise, for and on account of
 fraudulent statements and representations made by
 him to the public in representing and indicating
 upon the boxes wherein the pills alleged to be man-
 88 ufactured and sold by him are packed and upon
 circulars wrapped around such boxes that the said
 pills therein contained are covered by letters patent
 while in truth and in fact they are not so covered
 and protected by letters patent of any State, coun-
 try or Government and by fraudulently represent-
 ing that the said pills are manufactured, packed
 and sold by Thomas Beecham when in truth and in

fact they are not manufactured, packed and sold by Thomas Beecham, and by stating and representing that the said pills are manufactured and sold at St. Helens, Lancashire, England, when in truth and in fact the said pills are actually manufactured and sold at the City of New York, Borough of Brooklyn, within the United States, and in falsely stating and representing that the said pills so sold are specially packed for the United States of America, thus leading the public to believe that they are manufactured in England and exported thence to the United States of America. That the said pills are not manufactured for or used in connection with any trade between foreign nation or Indian tribes and hence cannot be protected under any registration thereof and upon information and belief this defendant alleges that the complainant did not comply with the provisions of the Act of Congress regarding the registration of trade-marks, labels or otherwise, and that hence the pills mentioned and described in the complaint as being sold by him are not protected by the alleged registration in the bill of complaint set forth. 89 90

This defendant denies that the value of the complainant's alleged trade-mark, "Beecham Pills" is greater than the sum of Two Thousand (\$2,000.00) Dollars, and further answering this defendant says: upon this information and belief that the value of any alleged trade-mark set forth in the complaint herein or otherwise owned or claimed to be owned by the complainant and any alleged losses or damages sustained by reason of any acts committed or omitted by this defendant as alleged in the plaintiff's bill of complaint herein or otherwise to the damage of the complainant does not amount to the sum of Two Thousand (\$2,000.00) Dollars, and that hence the subject of this litigation is less than 91 92

93 the sum of Two Thousand (\$2,000.00) Dollars, exclusive of interest and costs, by reason whereof this Court has not jurisdiction of the subject of this litigation or of the cause of complaint set forth in the complainant's bill of complaint herein.

Defendant further answering the said bill of complaint says: that the said complainant has violated sections 438 & 438a of the Penal Code of the State of New York, which said articles are as follows:

94 Sec. 438:

"A person, who with intent to defraud, either

95 1. Puts upon an article of merchandise, or upon a cask, bottle, stopper, vessel, case, cover wrapper, package, band, ticket, label, or other thing, containing or covering such an article or with which such an article is intended to be sold or is sold, any false description or other indication of or respecting the kind, number, quantity, weight, or measure of such article, or of any part thereof; or the place or country where it was manufactured or produced; or the quality or grade of any such article, if the quality or grade thereof is required by law to be marked, branded, or otherwise indicated on or with such article."

Sec. 438a:

96 "A person who, with intent to defraud or to enable another to defraud any person, manufactures or knowingly sells or causes to be manufactured or sold, any article marked, stamped or branded, or encased or inclosed in any box, bottle or wrapper, having thereupon any engraving or printed label, stamp, imprint, mark or trade-mark, which article is not the

manufacture, workmanship or production of the person named, indicated or denoted by such marking, stamping or branding, or by or upon such engraving, printed label, stamp, imprint, mark or trade-mark, is guilty of a misdemeanor." 97

in that the said complainant has printed on the label pasted at the top of the box containing pills and the label pasted around the box; the circular wrapped around the box and in all of his other printed matter, the fact that the said pills are manufactured and sold at St. Helens, Lancashire, England, when in truth and in fact, said pills are actually manufactured and sold in the City of New York, Borough of Brooklyn, County of Kings, State of New York, U. S. A. and further that the said printed matter contains the name of Thomas Beecham, indicating and denoting by said name, that Thomas Beecham is the manufacturer and proprietor of said pills. 98

This defendant further answering said bill of complaint says: that complainant has violated section 4901 of the Revised Statutes of the United States, which said Statute reads as follows: 99

"Every person who, in any manner, marks upon or affixes to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than one hundred dollars, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed;" 100

101 in that the said complainant has printed upon the label pasted on the top and around the box, the word "patent" indicating thereby that the article within the said box has received letters-patent from the United States of America.

This defendant further answering the said bill of complaint says; that the said complainant has in violation of the above section 4901 of the Revised Statutes of the United States, marked upon and affixed to the pills manufactured and sold by the said complainant which were and are unpatented, the word "patent" upon a label affixed and pasted on the top of the 25 cent boxes containing pills manufactured and sold by the complainant for the purpose of deceiving the public; said violation occurring within the jurisdiction of the Circuit Court of the United States, Eastern District of New York, to wit, at 137 Middleton Street, City of New York, Borough of Brooklyn, County of Kings, N. Y.

103 This defendant further answering said bill of complaint, says, that the circular annexed to the bill of complaint was changed by the complainant herein with a view to the commencement of this action and in order to cover up the misrepresentations. That upon a hearing held in the Magistrate's Court of New York City, Borough of Manhattan, on or about the 13th day of October, 1904, before Hon. P. T. Barlow, City Magistrate, and in the presence of this defendant, the complainant
104 herein produced before said City Magistrate specimens of circulars wrapped around twenty-five cent boxes and circulars enclosed in ten cent boxes, which the said complainant herein then produced as exhibits as the circulars used by him at that time. That this defendant examined the circular

wrapper aforesaid, and that the said circular wrapper produced before said City Magistrate by the complainant, did not conform to the circular annexed to the bill of complaint herein, in that instead of the words: "Beecham's Pills are prepared only and sold wholesale by the proprietor, Joseph Beecham, successor to Thomas Beecham, St. Helens, England and 365 Canal Street, New York;" printed upon such circular wrappers the said circular wrappers produced upon the aforesaid hearing, by the complainant contained the words: "Beecham's Pills are prepared only and sold wholesale by the proprietor Thomas Beecham, St. Helens, England, and 365 Canal Street, New York." And on the circulars enclosed in the said ten cent boxes as aforesaid, produced at the aforesaid hearing by the complainant herein, contain the words: "PREPARED ONLY BY THE PROPRIETOR THOMAS BEECHAM, ST. HELENS, ENGLAND; and 365 Canal Street, New York, U. S. A."

This defendant, has in his possession and is ready to produce in court, a specimen of said circular.

Without this, that there is any other matter, cause or thing in the said bill of complaint contained material or necessary for this defendant to make answer unto and not herein and hereby well and sufficiently answered, confessed, traversed, and avoided, is true, to the knowledge or belief of this defendant, all of which matters and things this defendant is ready and willing to aver, maintain, and prove as this honorable court shall direct, and humbly prays to be hence dismissed with his reasonable costs and charges in this behalf most wrongfully sustained.

WEILL & WEILL,
Solicitors for Defendant.

CHAS. GOLDZIER,
Of Counsel for Defendant.

109 UNITED STATES OF AMERICA.
 Eastern District of New York, } ss. :
 County of Queens, }

On this 2nd day of March, 1906, before me personally appeared Mark Jacobs, who being by me duly sworn, deposes and says; That he is the above-named defendant; that he has read the foregoing answer and as it concerns his own acts and deed is true of his own knowledge, except as to
 110 those matters therein stated on information and belief, and as to those matters he verily believes it to be true and so much thereof as concerns the acts and deeds of any other person or persons he believes them to be true.

MARK JACOBS.

Subscribed and sworn to before me }
 this second day of March, 1906. }

111 AUGUSTUS DE WITT, JR.,
 [SEAL] Notary Public,
 Queens Co., N. Y.

Complainant's Replication. 113
 CIRCUIT COURT OF THE UNITED STATES,
 EASTERN DISTRICT OF NEW YORK.

JOSEPH BEECHAM,
 Complainant,

vs.

MARK JACOBS,
 Defendant.

} in Equity.

114

The replication of Joseph Beecham, the Complainant, to the answer of Mark Jacobs, the Defendant.

This repliant saving and reserving unto himself now and at all times hereafter, all and all manner of benefit and advantage of exception which may be had or taken to the manifold insufficiencies of the said answer, for replication thereunto says that he will aver, maintain and prove his said Bill of Complaint to be true, certain and sufficient in law to be answered unto, and that the said answer of the said defendant is uncertain, untrue and insufficient to be replied unto by this repliant. Without this that any other matter or thing whatsoever in the said answer contained, material or effectual in the law to be replied unto, and not herein and hereby well and sufficiently replied unto, confessed or avoided, traversed or denied is true. All which matters and things this repliant has been and will be ready to aver, maintain and prove as this Honorable Court shall direct, and humbly prays as in and by his said Bill he has already prayed.

115

116

GOULD & WILKIE,
 Complainant's Solicitors.

LEARNED HAND,
 Of Counsel.

117

Testimony.

CIRCUIT COURT OF THE UNITED STATES,

EASTERN DISTRICT OF NEW YORK.

118

JOSEPH BEECHAM,
Complainant,
vs.
MARK JACOBS,
Defendant.
In Equity.

Before B.
Lincoln Bene-
dict, Esq.,
Special Ex-
aminer.

Testimony taken on behalf of complainant for final hearing, under 67th Rule in Equity, before B. L. Benedict, Special Examiner.

Brooklyn, July, 11, 1906.

119

APPEARANCES:

GOULD & WILKIE (Mr. Hand, of Counsel), for the Complainant.

CHARLES GOLDZIER, Esq., for the Defendant.

120

WALTER JANVIER, called as a witness on behalf of the complainant, being duly sworn testified as follows:

DIRECT EXAMINATION by Mr. Hand:

MR. HAND: I offer in evidence certified copy of certificate filed in the New York County Clerk's office by Joseph Beecham, that he does business under the name of Thomas Beecham.

Received in evidence, and marked Com- 121
plainant's Exhibit No. 1.

Q. Mr. Janvier, where do you live? A. 230 West
107th Street.

Q. What is your business? A. Commission mer-
chant.

Q. Are you connected with the B. F. Allen Co.?
A. Yes, sir.

Q. That is a corporation? A. Yes, sir.

Q. What position, if any, do you hold in that 122
corporation? A. Secretary and treasurer.

Q. Was there a prior partnership to the B. F.
Allen Co.? A. Yes, sir.

Q. When was the corporation formed? A. May
15, 1891.

Q. Who was in B. F. Allen & Co.? A. B. F.
Allen & Co., the original?

Q. At the time the corporation was formed? A.
Well, there was James Gaunt and William N. 123
Janvier, of Boston, and myself.

Q. You were all partners? A. At the time the
corporation was formed, we took over the busi-
ness of B. F. Allen & Co., and in the stock com-
pany the officers were James Gaunt, William N.
Janvier and myself.

Q. How long had you been a partner of B. F.
Allen & Co., prior? A. I got the agency and backed
it. My brother and B. F. Allen were partners, and
I backed the enterprise. I was not a partner, 124
although I guaranteed the whole business.

Q. When was this? A. At the time I took Beech-
am's agency.

Q. How long were you connected with B. F.
Allen & Co. before the corporation was formed?
A. From the time we took the business. I guaran-
teed it. I was not a partner.

125 Q. You were not connected with it before the firm became agent for Mr. Beecham? A. No, sir. There was no connection of anybody here before that time.

Q. When did the firm first become an agent for Thomas Beecham? A. I could not give that from memory.

Q. Have you got the first contract here? A. Yes, sir, it is dated the 21st day of June, 1888.

126 Q. Do you know the handwriting of Joseph Beecham, the complainant? A. Yes, sir.

Q. I show you this contract, which will be marked Complainant's Exhibit 2, and I ask you whether the name of Joseph Beecham there is in the handwriting of Joseph Beecham? A. It is.

MR. HAND: I offer in evidence the first contract between the firm of B. F. Allen & Co. and Thomas and Joseph Beecham.

127 Received in evidence and marked Complainant's Exhibit No. 2.

Q. Regarding that contract, there are certain pencil marks upon it. Do you know when those were made? A. When the new contract was made, the dates were crossed out to give the proper dates to the new contract.

Q. And when the contract was first signed, those marks were not upon it? A. No, sir.

128 Q. Where were the pills made when that contract was executed? A. I think they were made in Cherry Street.

Q. You think they were made in this country at that time? A. When this B. F. Allen & Co. contract was signed I think they were made in Cherry Street.

Q. New York City? A. Yes, sir. They were

made in Cherry Street—first delivery November 12, 1890. 129

Q. Then at the time this contract was made, they were not made in America? A. What is the date of that?

Q. 1888? A. They imported them for a while, and I do not know just the date.

Q. When did they cease importing the pills? A. That I could not tell you from memory.

Q. Don't you know? A. I could not tell you from memory, no. 130

Q. Do you know anything yourself about it? A. We have got memorandums at the office which would give us the date.

Q. Where was the first place that Mr. Beecham made pills in America? A. 180 Cherry Street.

Q. And they first began to make them at what time in 180 Cherry Street? A. The first delivery was November 12, 1890.

Q. Before that, he did not make them in America, did he? A. Not to my knowledge. 131

Q. Before he made them here, were the pills imported from England? A. Yes, and had been for years before I had anything to do with it.

Q. Was this contract that you speak of, ever superseded by another contract? A. Which one?

Q. The first one, 1888? A. It was superseded by B. F. Allen Co.

Q. That is a corporation? A. Yes, sir.

Q. I show you a paper. Is that the contract with B. F. Allen Co.? A. Yes, sir, made on the 15th of May, 1891. 132

Q. Did Mr. Joseph Beecham ever sign a copy of this contract? A. Yes, sir.

MR. HAND: I offer in evidence contract between Joseph Beecham and B. F. Allen

133 Co. dated May 15th, 1891.

Received in evidence, and marked Complainant's Exhibit No. 3.

Q. Have your firm or your corporation ever sold any Beecham's pills? A. Yes, sir, sold them ever since we have had the business in our hands.

Q. Beginning with the date of the first contract? A. Yes.

134 Q. These pills are sold in wooden boxes, are they not? A. Yes, sir.

Q. Of how many sizes are the boxes? A. Two.

Q. State what the price by the box is? A. 25c and 10c.

Q. How many pills has the 25c box at present? A. 40.

Q. And the 10c size? A. 12, I think.

135 Q. I show you a round label, which will be marked Exhibit 4. Has that label been used on the 25c box at any time? A. Yes, it has always been, ever since I had anything to do with the pills.

Q. That has never been changed? A. No, sir.

Q. That has been put on every 25c box of pills? A. Yes, sir.

MR. HAND: I offer label used on 25c box of pills in evidence.

Received in evidence, and marked Complainant's Exhibit No. 4.

136 Q. I show you another label. Is that used upon either of the boxes of Beecham's pills? A. Used on the 25c size, and has been ever since I handled the goods.

Q. Upon all the boxes? A. Yes, sir.

MR. HAND: I offer in evidence second label used on 25c box of pills.

Received in evidence, and marked Com- 137
plainant's Exhibit No. 5.

Q. Have you always sold these pills in America
in two sizes of boxes? A. No.

Q. Which is the older box of the two? A. 25c
size.

Q. When did you begin selling the 10c size? A.
In 1895.

Q. I show you a label, and I ask you whether 138
that is used upon the 10c size at present? A. It is.

Q. Do you remember how long that has been
used? A. No, sir.

MR. HAND: I offer in evidence label used
on 10c box of pills.

Received in evidence, and marked Com-
plainant's Exhibit No. 6.

It is stipulated between complainant and
defendant herein that the facts stated in the 139
affidavit of Walter Janvier, used upon the
application for a temporary injunction, and
verified March 9, 1906, shall stand as facts
proved upon the hearing, including the ex-
hibits annexed thereto, which shall bear the
same markings as they contained upon the
affidavit, as follows:

"Since the 14th day of July, 1905, and up to the
"present time, the complainant has wrapped around 140
"all twenty-five cent pill boxes sold by him—
"amounting to many thousands of boxes—the
"twenty-five cent circular and no other, appended
"to my affidavit of February 5, 1906. From the
"21st day of August, 1905, to the present time he
"has inserted within all ten-cent pill boxes sold by
"him—amounting to many thousands of boxes—
"the ten-cent circular and no others, appended to

141 "my said affidavit. From the 2d day of November, 1904, to the present time, he has pasted upon all ten-cent pill boxes sold by him the ten-cent label and no other, appended to my said affidavit. From the month of August, 1888, to the present time, he has pasted upon all twenty-five cent pill boxes sold by him both the twenty-five cent labels—the orange label and the three-colored label—and no others, appended to my said affidavit.

142 "That the complainant wrapped around all twenty-five cent pill boxes sold by him within each of the succeeding periods—amounting to many thousands of boxes within each period—that circular and no other, below set forth as used during that period, and hereto annexed and by this reference made a part hereof.

	<i>From</i>	<i>To</i>	<i>Circular Used During Period</i>
	"August, 1888;	December, 1893;	That marked Exhibit "A."
	"December, 1893;	September, 1899;	That marked Exhibit "B."
	"September, 1899;	July 1902;	That marked Exhibit "C."
143	"July, 1902;	December, 1902;	That marked Exhibit "D."
	"December, 1902;	July 14, 1905;	That marked Exhibit "E."

"That the complainant inserted within all ten-cent pill boxes sold by him within each of the succeeding periods—amounting to many thousands of boxes within each period—that circular, and no other below set forth as used during that period and hereto annexed and by this reference made a part hereof.

	<i>From</i>	<i>To</i>	<i>Circular Used During Period</i>
	"January, 1895;	September, 1902;	That marked Exhibit "F."
	"September, 1902;	May, 1903;	That marked Exhibit "G."
	"May, 1903;	August 21, 1905;	That marked Exhibit "H."

"That between January, 1895, and December, 1903, the complainant pasted upon all ten-cent pill boxes sold by him—amounting to many thousands

"of boxes—that label, and no other, which is 145
 "marked Exhibit 'I' hereto annexed, and by this
 "reference made a part hereof, and between Decem-
 "ber, 1903, and November, 1904, that label, and no
 "other, which is marked Exhibit 'J,' hereto an-
 "nexed, and by this reference made a part hereof.

"That the yearly average gross receipts without
 "deduction from the sales of the complainant's pills
 "between the years 1892 and 1899, both inclusive,
 "is greater than the yearly average between the 146
 "years 1900 and 1904, both inclusive. That the
 "yearly average number of twenty-five cent boxes
 "of pills sold by the complainant between 1892 and
 "1899, both inclusive, was greater than the yearly
 "average for the years 1900 to 1904, both inclusive.
 "That the ten-cent boxes of pills were not sold until
 "the year 1895, and a comparison is not possible
 "between the same periods. That the average year-
 "ly number of pills sold by the complainant be-
 "tween 1892 and 1899, both inclusive, was less by 147
 "between one and two per cent, than the average
 "yearly number of pills sold between 1900 and 1904,
 "both inclusive.

"That the gross receipts, without deduction from
 "sales, the number of pills sold, and the number of
 "boxes of pills of each size sold, for the six months
 "from September, 1905, to February, 1906, both in-
 "clusive, have been greater than for any period of
 "six months between September, 1899, to August,
 "1905, both inclusive. All the foregoing statements 148
 "in this affidavit refer only to the sales of pills
 "within the United States."

Mr. Hand offers in evidence circular as
 Exhibit 7; and it is conceded that Exhibit
 7 is a facsimile of the 25c circular appended
 to the affidavit of Walter Janvier of Feb-
 ruary 5, 1906.

149

Said circular received in evidence, and marked Complainant's Exhibit No. 7.

Mr. Hand offers in evidence circular as Exhibit No. 8; and it is conceded that Exhibit No. 8 is a facsimile of the 10c circular appended to the affidavit of Walter Janvier of February 5, 1906.

Said circular received in evidence, and marked Complainant's Exhibit No. 8.

150

It is stipulated that Exhibit No. 6 is a facsimile of the 10c label appended to the affidavit of Walter Janvier of February 5, 1906.

Q. How extensive is the sale of Beecham's pills in this country—I mean, over how extensive a territory? A. Over the entire United States.

Q. You sell almost all the largest cities? A. Yes, we sell almost every wholesale druggist in the United States, as well as nearly every department and grocery store.

151

Q. How did the sales compare in extent in 1899? A. Very much the same. We worked the whole country, and sold the principal jobbers throughout the United States.

Q. I show you an exhibit marked "W. J., 2/2-1906," which is on file in this court. Is that a typical box of 25c pills as at present made up? A. Yes, sir.

152

Mr. Hand: I offer that in evidence.

Received in evidence, and marked Complainant's Exhibit No. 9.

Q. I show you a 10c box of pills. Is that a typical box of the 10c box of pills as at present made up? A. Yes, sir.

Q. The circular from this box has been omitted.

A. It has been used as an exhibit. 153

Q. And constitutes Exhibit No. 8? A. Yes, sir.

Mr. Hand offers said 10c box of pills in evidence.

Received in evidence, and marked Complainant's Exhibit No. 10.

Q. Do you know Mr. Joseph Beecham? A. Yes, sir.

Q. Personally? A. Yes, sir. 154

Q. You know where he resides? A. Yes, sir.

Q. Where? A. His residence is at Huyton, near Liverpool. It is between his factory and Liverpool.

Q. Have you ever visited there? A. Yes, I have visited at his house.

Q. Has he a factory in England? A. Yes, sir.

Q. Where? A. At St. Helens, Lancashire.

Q. Does he make Beecham's pills there? A. Yes, sir.

Q. Have you ever been in that factory? A. Yes, sir. 155

Q. How long since? A. A year ago last May was the last time I was there. I have been in there a number of times, but the last time was a year ago last May.

Q. You have had personal knowledge of the sales of Beecham's pills in this country from the time of the first contract, have you not? A. Yes, sir.

Q. Have you had charge of those sales in this country? A. Yes, sir. 156

Q. And you have followed the extent of the sales? A. Yes, sir.

Q. Continuously? A. Yes, sir.

Q. Can you say whether the change in the statements upon the circulars within or around the pill-boxes, by which the statement that the pills are

- 157 prepared by Thomas Beecham has been changed to the statement that the pills are prepared by Joseph Beecham, successor to Thomas Beecham, has had any effect on the sales in this country?

Mr. Goldzier: Objected to as incompetent, irrelevant and immaterial, and as calling for a conclusion on the part of the witness.

- 158 A. Well, I think since Joseph Beecham, successor, the sales have been larger.

Q. Do you attribute that to the form at all?

All questions regarding the effect of the change upon the sales or business are to be taken under the same objection made to the first question.

- A. I do not think it had any bearing on it whatever. The advertising was increased and the sales increased.

Q. The fact is that the sales have been larger since the change was made? A. Yes, sir.

Q. Where are these pills made at present, Mr. Janvier? A. In Brooklyn.

Q. What share have you, or the B. F. Allen Co. in the manufacture of the pills? A. None whatever; I never was even inside the factory.

- 160 Q. Do you employ, or does your company employ, any of the persons who make the pills in Brooklyn? A. No, sir.

Q. Have you at any time? A. Never have.

Q. Who does employ them? A. Mr. Beecham's own superintendent.

Q. Who is he? A. W. J. Atherton.

Q. Will you state what you do for Mr. Beecham,

the complainant here, in regard to the sales of pills? 161
 State the course of business in detail. A. Mr. Bee-
 cham delivers at our warehouse in Canal Street, the
 pills. We sell them for him on a commission. He
 has given us the sole agency for the United States,
 and we sell them for him on a commission.

Q. You collect the money? A. We collect the 162
 money, deducting our commission and deposit the
 balance of the money weekly to his credit in the
 People's Bank, Canal Street, and our deposits are
 verified by the bank.

Q. Has there been any contract between the
 complainant and the B. F. Allen Co. since what we
 have called the second contract? A. No, sir.

Q. You have continued doing business under that
 contract since that time? A. Yes, sir.

Q. Where is your warehouse? A. 365-367 Canal
 Street, New York.

Q. There are no sales made by any one else in
 this country but you, as far as you know? A. None 163
 that I know of.

Q. When I say sales, I mean sales authorized by
 Mr. Beecham? A. That is what I mean—author-
 ized by Mr. Beecham.

Q. You know of a man, Simeon B. Minden? A.
 Yes, sir.

It is stipulated between the parties hereto
 that Simeon B. Minden and two clerks were
 prosecuted in October and November, 1904,
 on the complaint of the complainant, for
 counterfeiting the trade-mark and make-up
 of the complainant's goods, that the defend- 164
 ants in that case were arrested and brought
 before Hon. Peter T. Barlow, a city magis-
 trate of the City of New York, were held for
 trial, and were subsequently convicted of the

165 crime as charged by the Court of Special
Sessions of the County of New York, that
upon their examination and trial, the de-
fendants in such prosecution urged as a de-
fense that the complainant herein had used
the word "patent" upon the make-up of his
pills, when in fact his pills were not pat-
ented, and, further, that the complainant in-
serted in the make-up and circulars of his
166 pills that the pills were made in England,
while in fact they were made in Brooklyn,
New York, and that they further urged as a
defense that the complainant asserted that
the pills were made by Thomas Beecham,
when in fact they were not made by Thomas
Beecham but by the complainant herein.

While conceding the above facts, the de-
fendant objects to that evidence on the
ground that it is entirely incompetent, irrel-
evant and immaterial upon the issues here-
167 in.

Q. During the summer of 1905, it appears from
these circulars a change was made in the statements
formerly upon the circulars, that the pills were pre-
pared by Thomas Beecham, and the statement was
subsequently worded that the pills were prepared
by Joseph Beecham, successor to Thomas Beecham.
Will you state the reasons why that change was
168 made?

MR. GOLDBZIER: Objected to as incompe-
tent, irrelevant and immaterial, and calling
for conclusions instead of facts.

A. I think that is Mr. Beecham's business; I have
nothing to do with the manufacture of the goods.

Q. You do not know what the reasons were? Was it made on advice of counsel? 169

MR. GOLDBIER: Objected to as incompetent, irrelevant and immaterial, and calling for conclusions instead of facts.

A. Yes, it was.

Q. At that time, did you know, or had you heard of any sales by the defendant herein of any pills bearing the mark Beecham pills? A. Yes. 170

Q. When did you first hear that he sold pills? A. I could not tell you the exact date. I could tell you by my letterbook. It was a young man—

Mr. Goldzier: We do not care anything about that.

Q. You did not hear of any sales at that time? A. No, I did not hear of any sales.

Q. Had you heard of any sales of defendant's pills prior to the change made in this? A. No. 171

Q. Do you know, Mr. Janvier, the extent of the business of Mr. Beecham in America? A. Yes, sir.

Q. Is that business greater or less than \$2,000 a year in amount? A. Very much greater.

It is conceded that the value of the orator's trade-mark in the United States is greater than the sum of \$5,000.

Q. Did you ever hear of, or do you know of, any pills in this country besides the complainant's pills and the pills which were made by Minden, which are now or ever have been called Beecham's pills or gone under that name? A. No, not until this thing appeared. 172

173 Cross-examination by Mr. Goldzier:

Q. Mr. Janvier, you say that you have never been at the factory that is now established at Brooklyn?
A. I never have.

Q. Do you know who pays the rent for the building? A. Mr. Beecham.

Q. Do you know who pays the help? A. Mr. Atherton.

Q. Do you know who pays Mr. Atherton? A.
174 Mr. Beecham pays it through Mr. Atherton.

Q. Do you mean to say that Mr. Beecham pays anything personally? A. That I do not know anything about; I do not do any of the paying of the factory or help.

Q. Were you present when Mr. Beecham was examined on this subject before the police magistrate?
A. Yes, sir.

Q. Were you present when he stated that he does not pay the help of this factory? A. I do not remember what he said about that. I do not know
175 whether Mr. Beecham or Mr. Atherton pays.

Q. You have nothing to do with it? A. No, sir.

Q. And your company has nothing to do with it?
A. No, sir, aside from the fact that Mr. Atherton comes to our place, under Mr. Beecham's instructions, and gets from us whatever amount weekly he designates; and that is taken from a fund left in our charge by Mr. Beecham, and is entirely separate from the business of B. F. Allen Co.'s agency.

176 Q. Let me understand; the money that you take in, after deducting your commissions you deposit, as you stated? A. Yes, sir.

Q. You say there is another fund, out of which the factory expenses are paid? A. There is another fund, which Mr. Beecham leaves in our charge, subject to the orders of his superintendent.

Q. Where is that fund deposited? A. In the

People's Bank.

177

Q. How much does that consist of? A. Every month he makes a remittance. We notify him when the fund gets low. We do not know what his expenses are going to be, because we have nothing to do with it.

Q. You notify Mr. Beechman if the fund is overdrawn? A. No, we never have it overdrawn. When it gets low, We make him weekly reports.

Q. He sends you money from England? A. Yes, sir, he gives us a check on the People's Bank.

178

Q. It is not correct exactly when you say he sends you remittances from England? A. No; he gives us a check on the People's Bank.

Q. Then you upon his checks draw from the other fund, and deposit in the factory fund, if you may call it so? A. From what other fund?

Q. From the fund that you deposit from the sale of pills, you draw? A. No, we have no right.

Q. Upon his checks you draw? A. Certainly. So does an advertising agent, or anybody else.

179

Q. You get checks upon the fund which you deposit in Mr. Beecham's bank, and those checks you utilize to make up the fund which is used for the factory; is that so? A. Yes, sir.

Q. And then you draw checks to Mr. Atherton's order? A. No, we do not. We give him the money.

Q. You give him the money? A. Yes, sir.

Q. And he calls for it? A. Yes, sir.

Q. And in such amounts as he calls for? A. Whatever he calls for.

180

Q. You make no accounting for these moneys, except that drafts for a certain amount have been issued? A. That is all.

Q. Well, then, this money that you draw is placed on your account, in your name? A. Well, it is drawn to our order, to the order of B. F. Allen Co., the checks are, naturally.

181 Q. You said just now you draw no checks, you gave him money,—which is it? A. I say Mr. Beecham sends us a check for petty cash,—not only his factory expenses but all kinds of expenses here.

Q. And you deposit that in your own name? A. Yes, sir.

Q. And from that you pay Mr. Atherton whatever he wants? A. Yes, sir.

182 Q. Without getting any accounting from him in any way, shape or manner? A. He comes in and says how much he wants and we give it to him.

Q. You never saw any account from him? A. No, sir, he renders that to Mr. Beecham.

Q. And then he furnishes you with the pills? A. Yes, sir.

Q. Prior to the time that the pills were manufactured in this country, you say that they were imported? A. Yes, sir.

183 Q. For how many years do you know of that you had any connection with the business, were they imported? A. For a number of years. I was trying to get the agency for four or five years before I got it, and I know they were imported that long,— I do not know how much longer.

Q. After you got it how long were they imported? A. I believe after B. F. Allen Co. got it, I believe about two years. The first delivery from Cherry Street was November 12, 1890.

184 Mr. Hand: That statement is already in the record.

Q. About two years or more? A. Give me the date of the first contract, and I will tell you.

Mr. Hand: The first contract was dated June 21, 1888.

A. The first contract was dated June 21, 1888.

and the first delivery from Cherry Street was November 12, 1890. Well, then, about two years. 185

Q. Who paid the duty upon the pills during that time? A. Mr. Beecham. They were delivered in our warehouse all free of expense to us.

Q. Did Mr. Beecham pay the duty here himself?

A. Yes, sir.

Q. He was not here in the country? A. That makes no difference. He sends to his custom house broker as he does now on the advertising matter, and as do all the concerns we have anything to do with. 186

Q. The advertising matter is still imported from England? A. Some of it.

Q. And the duty upon it paid by Mr. Beecham? A. Yes, sir.

Q. The pills are imported from Brooklyn? A. You can call it that if you like,—or sent over.

Q. Sent over, and no duty is paid upon them? A. No, sir. 187

Q. And that has been going on for how many years? A. Since 1890. Not in Brooklyn all the time.

Q. During the time they were manufactured in Cherry Street, who had the factory there? A. Mr. Beecham.

Q. You had nothing to do with the factory? A. No, sir.

Q. Allen & Co., had nothing to do with the factory? A. No, sir, no more than they have since. 188

Q. Mr. Joseph Beecham personally does not supervise the manufacture of the pills in Brooklyn? A. No.

Q. Has he ever to your knowledge been in Brooklyn at the factory, supervising the manufacture of pills? A. Yes, sir.

189 Q. When? A. Every time he came here. And he did in Cherry Street. He installed both plants personally.

Q. How often has he been over here since these factories have been going on? A. I could not tell you; quite a good many.

Q. One hundred times? A. No.

Q. Fifty times? A. I cannot say how many times, but a good many.

190 Q. A good many means nothing; what do you mean by a good many? A. Well, I will make it small, I will say five times or more. I cannot tell exactly, and I would not want to say, because he has been here so frequently, I couldn't tell. Some years he has been here two or three times.

Q. He may have been here ten times? A. Yes, sir.

191 Q. Twenty-five times, will you say twenty-five times? A. No, I will not state any number of times, because it has been frequently. I will not say any number.

Q. How long has he stayed when he came over here? A. A week, sometimes two or three weeks.

Q. And that is all the personal supervision that he has given to it, so far as you know? A. Yes, that is all I know.

Q. How about Mr. Thomas Beecham, has he been over here? A. Yes, sir.

192 Q. When last? A. Well, a number of years ago; he is a very old man.

Q. About how many years ago? A. In 1893.

Q. Did he supervise the manufacture of pills when he was over here? A. He was at the factory. I do not know because I do not go to the factory.

Q. How long did he stay the last time? A. Several weeks.

Q. You do not claim that he has anything to do with that factory, so far as you know? A. I do not know anything about it; I do not know anything about their factory. 193

Q. At the time you made the change in the circulars so as to present them the way they are now, you had information that Mr. Jacobs was about to commence manufacturing these pills, isn't that so? A. No, sir, I do not know how soon. He advised with his counsel about the change of circulars. I had nothing to do with it. 194

Q. You know nothing about why the change was made? A. I have nothing whatever to do with the making of the pills, the making of the circulars, or anything of that kind.

Q. You do not know whether the change was made after some one had threatened, if you please, to manufacture these pills? A. No.

Q. You know nothing about that? A. No.

Q. You do not know whether the change was advice of counsel or not? A. Yes, I do know that. 195

Q. Were you there when the consultation of counsel was had? A. No, but counsel told me they had, and not only that, I had correspondence with Mr. Beecham about it.

Q. When were you first advised that this change was made or contemplated? A. I could not tell you the date.

Q. About how long? A. I could not tell you; that is in the affidavit.

Q. Do you know anything about a circular being sent out like this? A. Yes, sir; I cannot say word for word, but it is of that import. 196

MR. GOLDZIER offers circular in evidence.

Received, and marked Defendant's Exhibit "A."

MR. HAND objects to its admission on the ground that it is irrelevant.

197 Q. This circular was sent out by your firm, is that so? A. Yes, sir.

Q. When did you send out that circular? A. I think it was dated.

Q. It is not dated? A. I could not tell you, then, without referring to our books.

Q. Wasn't it sent out in February, 1905? Didn't you so testify? A. I cannot tell without referring to our books.

198 Q. Can you state about what year that was sent out? A. I make no statement without referring, because it is a question of date, and I cannot carry all these thousands of dates in my mind.

Q. This circular was sent out within the last two years? A. I do not know when it was sent out.

Q. Within the last three years? A. I do not know.

Q. Within the last ten years? A. Yes.

199 It is conceded that it was sent out in the spring of 1904.

Q. You have no written contract between Joseph Beecham and the Allen Co. except the contract that has been shown? A. That is all; we are working under the old contract.

Q. Who are the stockholders of this B. F. Allen Co. beside yourself?

200 MR. HAND: Objected to as incompetent, irrelevant and immaterial.

A. There is myself, my brother William N. Janvier, of Boston, Herbert Fiske, Frederick Vine—

Q. And several others, I suppose; Joseph Beecham is not a stockholder? A. No, sir.

Q. Thomas Beecham is not a stockholder? A. 201
No, sir. Joseph Justice of Chicago, I was going
to say, is a stockholder.

Q. Do you know whether Joseph Beecham gave
any license or authority to any one to manufac-
ture these pills in this country? A. No, sir.

Q. You do not know that? A. No, sir.

Q. These pills are not patented? A. No, sir.

Q. Never were patented? A. Not to my know-
ledge.

202

RE-DIRECT EXAMINATION by Mr. Hand:

Q. In your stating your accounts with Mr.
Beecham, please explain it in regard to this ac-
count of B. F. Allen Co.; your only voucher of
payment to Atherton is his receipt? A. Yes.

Q. And that is the only voucher that you have
in stating your account as to those expenditures
to Mr. Beecham? A. That is all.

203

RE-CROSS EXAMINATION by Mr. Goldzier:

Q. Mr. Janvier, is it not a fact that the wooden
boxes in which the pills are packed, are made in
the United States? A. Yes, sir.

Q. And exported from there to England? A.
Yes, sir.

Q. Such as are needed here are used here, and
such as are not are exported to England? A. Yes,
sir; I would not say that all the boxes he uses are
made here, but many of them are. The largest
turned wood box factory in the world is here.

204

Q. And how about the cartons? Where are
they made? A. They are made here.

Q. And also exported to England? A. No, sir;
I am talking about what is used here.

205 Q. The circulars, where are they made? A. At present they are made in England.

Q. Where were they made before? A. Sometimes here, and sometimes in England. There was trouble in getting paper of a certain grade.

Q. Printing done in England? A. Certainly. The circular would not be a circular without the printing.

206 Complainant offers in evidence sworn copy of assignment by Thomas Beecham of his interest in the partnership of Thomas Beecham and Joseph Beecham, to Joseph Beecham.

Received in evidence, and marked Complainant's Exhibit No. 11.

It is admitted that the defendant sold 144 boxes of pills to Mortimer Bartlett on the first day of January, 1906.

207 Complainant offers in evidence one of said boxes of pills sold by defendant.

Received in evidence, and marked Complainant's Exhibit No. 12.

It is also admitted that Complainant's Exhibit No. 12 is one of the boxes so sold, and that all of the boxes are precisely like said Exhibit No. 12.

208 It is admitted that at the time this suit was commenced and for two months preceding, the defendant displayed above the door of his shop at Maspeth, L. I., a sign containing the words, "For Constipation and Biliousness Take Beecham Pills."

Q. Are any 10c. boxes of the pills made in England at all? A. The currency is different. They make a number of sizes. I could not tell you what sizes. They are not made in the form of Exhibit 10, to my knowledge.

The complainant concedes that he has no patent in connection with the pills. 209

WALTER JANVIER.

Subscribed and sworn to before me this day of July, 1906.

B. LINCOLN BENEDICT,
Special Examiner.

210

Complainant rests.

Mr. Goldzier: I offer in evidence record from the Patent Office regarding the registration of trade-mark of Thomas Beecham, filed on August 23, 1887.

Received in evidence, and marked Defendant's Exhibit "B."

Mr. Goldzier: I offer in evidence circular contained in defendant's boxes of pills, one of which boxes was opened in evidence by the complainant and received as Complainant's Exhibit No. 12. 211

Received in evidence and marked Defendant's Exhibit "C."

Defendant rests.

212

213

Complainant's Exhibit I.

In the Matter
of
JOSEPH BEECHAM,
Doing Business under the Name
of THOMAS BEECHAM.

214

Kingdom of Great Britain and Ireland.
County of Lancaster.

} ss. :
ss. : ss. :

215

In accordance with Chapter 216 of the Laws of 1900 of the State of New York, United States of America, an act amending the Penal Code of the said State by inserting therein a new section to be known as Section 362b thereof, relating to the use of assumed names in business, I hereby certify that I am the sole member of the firm which has heretofore been engaged in business in the manufacture of patent medicines and other proprietary medical and chemical products under the firm name or style of "Thomas Beecham."

In witness whereof I have hereunto set my hand and seal this 5th day of May, 1905.

JOSEPH BEECHAM.

216

Kingdom of Great Britain and Ireland.
County of Lancaster.

} ss. :

On this 5th day of May, one thousand nine hundred and five, before me, a consul of the United States at St. Helen's, Lancashire, England personally came Joseph Beecham, to me known and known to me to be the individual described in and

who executed the foregoing instrument, and who 217
acknowledged to me that he executed the same.

EDW. HAMMILL,
[Consular Seal.] Consular Agent,
St. Helen's, England.

STATE OF NEW YORK, }
County of New York, } ss. :

I, Peter J. Dooling, Clerk of the said County 218
and Clerk of the Supreme Court of said State
for said County; do certify that I have compared
the proceeding with the original certificate of
conducting business on file in my office, and that
the same is a correct transcript therefrom, and
of the whole of such original.

In witness whereof I have hereunto subscribed
my name and affixed my official seal this 7th day
of Feb'y, 1906.

219

PETER J. DOOLING,
Clerk.

[Endorsed:]—Filed June 10th, 1905.

221

Complainant's Exhibit II.

THIS AGREEMENT made this twenty-first day of June, one thousand eight hundred and eighty-eight, between Thomas Beecham and Joseph Beecham trading as Thomas Beecham of St. Helen's, England, parties of the first part, and Benjamin F. Allen and William N. Janvier, composing the firm of B. F. Allen & Co. of the City of New York, parties of the second part;

222

WITNESSETH.—For and in consideration of the covenants and obligations herein contained and fully to be kept and performed on the part of each, the parties do hereto mutually contract and agree with each other as follows:

223

FIRST.—The parties of the first part do hereby appoint the parties of the second part their sole agents in the United States of America, for the sale of pills, manufactured by them, and do promise, and agree by shipments seasonably made, to keep the parties of the second part supplied with as full a line, and as large a quantity of such goods, as, in the judgment of the parties of the first part, the American market may demand; and they further agree to sell none of such goods to other parties in, or for shipment to, the United States.

224

SECOND.—The parties of the first part further agree to secure, furnish, and pay the rent for a suitable office and storehouse in the City of New York, for the transaction of the business to be undertaken under this agreement; to expend in advertising said goods, and the agency hereby established such sums of money as they shall deem expedient, to furnish to the parties of the second

part, such sums of money as may be necessary for the payment of duties upon consignments and for the transportation of goods on arrival, to said storehouse as they may from time to time determine, and for payment of freight on quantity orders sold throughout the United States. 225

THIRD.—The parties of the first part are to fix prices at which the said goods are to be sold in the American market, and the terms of credit to be allowed to purchasers; and are to pay to the parties of the second part for the services to be performed and the expenses to be incurred by them as hereinafter provided, a commission of ten per cent. (10%) upon the net sales of American prices. 226

FOURTH.—It is understood and agreed that the parties of the first part are to be subjected to no expense except for the rent, the advertising, the import duties, the expenses of delivery to warehouse, the payment of freight on quantity orders, the insurance and the commission hereinbefore mentioned. 227

FIFTH.—The parties of the second part hereby accept the agency hereinbefore conferred upon them, and agree to take charge of the office and warehouse of the parties of the first part; to have one member of their firm constantly at said place of business, and to keep at least two (2) persons traveling throughout the United States soliciting orders and introducing said goods, together with the necessary bookkeepers, clerks and warehousemen at the office and warehouse; to receive, properly store, be responsible for, and use their best endeavors to sell all goods consigned to them; to keep separate books of account, ledgers, cash book, 228

229 sales book, and letter book, which shall be the property of the parties of the first part, and render weekly statements of sales effected, and deposit cash received weekly in such bank as the parties of the first part shall hereafter designate and generally to perform all the duties of general agents in the sale and accounting for proceeds of the property consigned, and no further.

230 SIXTH.—The parties of the second part further agree to guarantee all sales made by them, and in case of non-payment by a purchaser for three (3) months after his term of credit has expired, they are to pay to the parties of the first part the sum so due and unpaid.

231 SEVENTH.—The parties of the second part further agree to accept in full payment for the services to be rendered by them and the expenses to be incurred by them under this agreement, a commission of ten per cent. (10%) upon the net sales made by them at American prices.

EIGHTH.—It is understood and agreed that this agreement and the agency thereby established shall continue for the term of five (5) years from the date hereof.

232 In witness whereof, the parties of these presents have hereunto set their hands and affixed their seals, at the City of New York, the day and year above written.

(Signed) JOSEPH BEECHAM,
for self and partner,
BENJ. F. ALLEN,
W. N. JANVIER.

Signed and sealed in presence
of WILLIAM V. A. POE.

State of New York, }
County of New York, } ss. :

233

On the 21st day of June, 1888, personally came before me Joseph Beecham, to me known and known to me to be one of the firm of Thomas Beecham of St. Helens, England, who executed the foregoing instrument for and in the name of his said firm and acknowledged the same to be their act and deed; also appeared before me one Benjamin F. Allen and William N. Janvier to me known and known to me to be the individuals described in, and who severally acknowledged to me that they executed the foregoing instrument as their act and deed.

234

(Signed) WILLIAM V. A. POE.
Notary Public,
New York County.

March 1, 1890.

235

On account of the dissolution of partnership between B. F. Allen and W. N. Janvier, I hereby transfer to W. R. Janvier, and W. N. Janvier, or the company to be formed and controlled by them, all the right and interest now vested in the agreement made the twenty-first day of June, 1888, between me and B. F. Allen and W. N. Janvier.

(Signed) JOSEPH BEECHAM.

236

Complainant's Exhibit III.

THIS AGREEMENT, made this 15th day of May, one thousand eight hundred and ninety one, between Thomas Beecham and Joseph Beecham, trading as Thomas Beecham, of St. Helens, England, parties of the first part, and the B. F. Allen Co., of the City of New York, party of the second part; WITNESSETH—

238 For and in consideration of the covenants and obligations herein contained and fully to be kept and performed on the part of each, the parties hereto do mutually contract and agree with each other as follows:

FIRST.—The parties of the first part do hereby appoint the party of the second part their sole agent in the United States of America, for the sale of pills, manufactured by them, and do promise
239 and agree by shipments seasonably made, to keep the party of the second part supplied with as full a line and as large a quantity of such goods as, in the judgment of the parties of the first part, the American market may demand; and they further agree to sell none of such goods to other parties in, or for shipment to, the United States.

SECOND.—The parties of the first part further agree to secure, furnish, and pay the rent for a
240 suitable office and storehouse in the City of New York, for the transaction of the business to be undertaken under this agreement; to expend in advertising said goods, and the agency hereby established such sums of money as they shall deem expedient; to furnish to the parties of the second part, such sums of money as may be necessary for the payment of duties upon consignments and for the

transportation of goods on arrival, to said store-house as they may from time to time determine, and for payment of freight on quantity orders sold throughout the United States. 241

THIRD.—The parties of the first part are to fix prices at which the said goods are to be sold in the American market, and the terms of credit to be allowed to purchasers; and are to pay to the party of the second part, for the services to be performed, and the expenses to be incurred by them as herein- 242
after provided, a commission of ten per cent. (10%) upon the net sales at American prices.

FOURTH.—It is understood and agreed that the parties of the first part are to be subject to no expense except for the rent, the advertising, the import duties, the expenses of delivery to ware- 243
house, the payment of freight on quantity orders, the insurance, and the commission hereinbefore mentioned.

FIFTH.—The party of the second part hereby accepts the agency hereinbefore conferred upon it, and agrees to take charge of the office and ware- 244
house of the parties of the first part; to have one officer of the company constantly at said place of business, and to keep at least two (2) persons traveling throughout the United States soliciting orders, and introducing said goods, together with the necessary bookkeepers, clerks, and warehouse-
men at the office and warehouse, to receive, prop-
erly store, be responsible for, and use their best
endeavors to sell all goods consigned to them; to
keep separate books of account, ledgers, cash book,
sales books and letter books, which shall be the
property of the parties of the first part, and render

245 weekly statements of sales effected, and deposit cash received weekly, in such bank as the parties of the first part shall hereinafter designate; and generally to perform all the duties of general agent in the sale and accounting for proceeds of the property consigned, and no further.

246 SIXTH.—The party of the second part further agrees to guarantee all sales made by them, and in case of non-payment by a purchaser for three months (3) after his term of credit has expired, it is to pay to the parties of the first part the sum so due and unpaid.

SEVENTH.—The party of the second part further agrees to accept in full payment for the services to be rendered by it, and the expenses to be incurred by it under this agreement, the said commission of ten per cent. (10%) upon the net sales made by them at American prices.

247 EIGHTH.—It is understood and agreed that this agreement and the agency thereby established shall continue for the term of ten (10) years from the date hereof.

248 "Provided that the party of the first part shall be at liberty to terminate this agreement and the agency thereby created at any time before the expiration of said term, in the event of the party of the second part becoming bankrupt or insolvent or entering into an arrangement with its creditors generally, or in the event of its making default in the performance of any of the obligations of this agreement or its duty as agent."

IN WITNESS WHEREOF—The parties of the first part have hereunto set their hands and affixed their seals, and the party of the second part has caused these presents to be signed by its President, and

its corporate seal to be hereunto affixed, the day 249
and year first above written.

B. F. ALLEN Co.
W. R. Janvier, Prest.

Witness as to

W. R. JANVIER,
H. FISK.

State of New York, }
City and County of New York, } ss. :

On this 18th day of May, in the year 1891, be- 250
fore me personally came Walter Janvier, to me
personally known, and known to me, to be the
president of the B. F. Allen Co., who being by me
duly sworn, did depose and say that he resided at
49 West 57th Street, N. Y. City, in the City of New
York; that he is the President of the B. F. Allen
Co.; that he knows the corporate seal of the said
B. F. Allen Co.; that the seal affixed to the fore-
going instrument is such common corporate seal, 251
and was thereto affixed by order of the Board of
Directors of said B. F. Allen Co.; and that he
signed his name thereto by like authority.

(Signed) CHRISTIAN ZABRISKIE,
Notary Public,
Kings County, N. Y.

Certificate filed in New York County.

Complainant's Exhibit IV.

252



253

Complainant's Exhibit V.

254

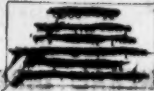
Complainant's Exhibit VI.

255

Thomas Beecham
 St Helens England
 and
 New York U S A

Directions inside the box cut here
 Beecham's Pills 10c.
 Beecham's Pills 10c.
 Beecham's Pills 10c.
 Beecham's Pills 10c.
 Beecham's Pills 10c.
 Beecham's Pills 10c.
 Beecham's Pills 10c.
 Beecham's Pills 10c.

256



BEECHAM'S PILLS

(Tasteless)

25 cents a box

THOMAS BEECHAM

St. Helens Lancashire

England

U. S. A. DEPOT

365 Canal Street

New York

BEECHAM'S PILLS have been before the public for over half-a-century, and now hold the supreme position among proprietary medicines. This, alone, is an overwhelming proof of the genuine worth of these pills, if there be any meaning in the ancient saying, "*Vox populi, vox Dei.*" For had they not a thousand-fold justified their claims upon public confidence, they could never have achieved such a splendid triumph over interested opposition and criticism throughout so long a period. Their phenomenal success is due to the fact that they *recommend themselves*, and have gained their popularity solely on their merits. Accumulated experience, all the world over, has declared them to be THE most reliable Family Medicine procurable: and whenever tried, they have been permanently adopted as the specific to be depended on for defeating those evils which usually assail health in our daily lives, and, if taken in time, they will ward off many a serious illness. Many thousands have felt constrained to inform me by letter of the benefits they have derived from the use of "BEECHAM'S PILLS": and while such testimonials have been a source of profound gratification, I have refrained from publishing them, preferring that the pills should continue to *recommend themselves*. These renowned pills are composed entirely of MEDICINAL HERBS; and are warranted free from mercury or other poisonous substance. They can harm no one, and may be given to children, or to the aged and infirm, with perfect safety. They cleanse the stomach and bowels, and purify the blood; invigorate the whole nervous system, and give tone and energy to the muscles. In the preparation of BEECHAM'S PILLS the most scrupulous care is taken, and the ingredients form the most successful combination that has ever been discovered for the complaints enumerated in this pamphlet.

THOMAS BEECHAM.

REMARKS AND GENERAL DIRECTIONS.

EVERY EFFECT HAS ITS CAUSE. The blood may be called the well-spring of Life, and when there is any disturbance at the source, the inevitable result is disease in one or many of its myriad forms. Our physical conditions depend largely on the state of the blood: every part of the body is nourished and supported by the vital fluid: and health depends not only upon the quality and quantity of blood, but upon its proper distribution, for our blood may be, and often is, distributed in the body very unequally; at one time too much is sent to one organ, and too little to another: thus, while one part of the body is weak and languid, and in a wasting or helpless state for the want of blood, another part may be oppressed, overcharged, or overstimulated to violent or abnormal action by having too much blood. In either case the health is disturbed, and life is consequently placed in danger.

The blood is sometimes rendered impure by the addition and accumulation of noxious matter: but nature has provided for us organs, by means of which impurities are separated from the blood. The lungs, the liver, and the kidneys are three most important organs for the *cleansing* purpose, and if they efficiently perform their duties, we enjoy a good state of health: but if the lungs imperfectly eliminate carbonic acid gas:—if the liver is sluggish in excreting gross or superfluous matter:—or if the kidneys are obstructed in their peculiar office of purification:—conditions of the blood are set up which render it incapable of supplying that nourishment to the tissues without which it is impossible to enjoy good health.

In giving directions for taking the Pills, which shall be applicable in all cases, under all conditions, something will have to be left to the discretion of the patients themselves. In the first place, I must urge those who take the Pills to abstain from, or use only in the strictest moderation, all alcoholic drinks, and let the food be of a plain and wholesome character; but should anyone be suffering from over-indulgence, be he ever so ill, or his head ever so bad, let him take a dose of BEECHAM'S PILLS, and he will be all right in the morning. Observe the principles of moderation both in eating and drinking, and carefully avoid overloading the stomach, from which cause many of our common ailments arise. Take exercise daily, if possible in the open air: keep the body warm and well bathed.

Persons of a strong or average constitution, but who may temporarily be suffering from any of the complaints herein mentioned, will usually find the dose to suit them to be three or four pills once a day; sometimes, however, it is necessary to repeat this dose morning and night, according to the condition of the system at the time. No harm can be done by increasing the dose where it is found insufficient as the Pills can never act injuriously. Others, who may be frequently subject to one or more of the specified ailments, should take smaller doses of the Pills occasionally, one, two, or three, generally being the ordinary dose, which may be increased at discretion by the patient. It is obviously impossible to prescribe one universal dose to suit all persons, from the fact that systems vary to such an extent that what would be a large dose for one, might not be sufficient for another. This rule, however, may be borne in mind, that on the first sign of *anything* wrong, at least two pills should be taken immediately, no matter when, but in the regular way the most benefit will be derived by taking a dose before retiring to rest.

SPECIAL INSTRUCTIONS RELATING TO CONSTIPATION.

First night, take one at bedtime. If this does not empty the bowels freely, the second night take two. If these prove insufficient, the third night take three, and so on; for a child old enough to swallow a pill, one pill is the dose. The object, in the beginning, is to empty the bowels freely. The dose to go on with is, generally, one or two pills; but a person very hard to move may require as many as eight for several nights in succession.

When a person has suffered from prolonged and neglected constipation, and the bowels are, for the first time, started into healthy action by the Pills, he may experience some disturbance of the stomach, have headache, lose appetite, or feel weak and depressed for a short time. These bad feelings pass away as soon as the bowels are thoroughly cleared; but they may last for several days, because it takes time to clear the bowels. In chronic constipation, the bowels are often so loaded that two or three free movements are not enough to thoroughly clear them. Nothing but free movements for several days in succession will effectually do so.

The nightly dose should be gradually diminished until a night can be skipped without missing the stool next morning.

The object now is to keep the bowels regular. The Pills do that, if enough and not too many are taken.

One of the most important things for everybody to learn is that constipation causes more than half the sickness in the world, especially of women; and it can all be prevented if BEECHAM'S PILLS are taken whenever nature seems to call for some assistance, and if they are perseveringly continued with until sound health is attained.

**For the Headache, Dizziness or Swimming in the Head,
Wind, Pain, and Spasms at the Stomach, Pains in the
Back, Restlessness, Insomnia, &c., &c.**

No matter how distressingly the patient is afflicted with the above complaints, a dose of Beecham's Pills will, in nine cases out of ten, give relief in twenty minutes. They can be taken at any time of the day or night, with the certainty of speedy benefit, and if they are taken at bed-time the patient will be all right the following morning, for the Pills will go direct to the cause and remove it.

What is commonly known as "the wind," frequently gives rise to some of the unpleasant symptoms here alluded to; or they may result from breathing vitiated atmosphere or inhaling noxious vapours and emanations; or unwholesome food may produce almost poisonous effects. In any such case, it is the blood which has become contaminated; and when we consider that the blood, in course of its circulation, carries the contamination to every part of the system, it is easy to understand that all the organs and tissues are liable to be disturbed in their functions, and fall into diseased conditions.

In many cases there are flying pains in the body—sometimes in the back, sometimes in the side, and at other times in the arms and legs—and these sensations are often called rheumatic pains, while in fact they are generally due to impurities caught up by the blood, and carried to every part of the body. Let anyone troubled with any or all of the symptoms here described, take the Pills, as before directed, and afterwards take two Pills morning and night for a few days, and not only will this medicine give effectual relief, but lay the solid foundation of health and strength.

All heavy and drowsy sensations which are sometimes the forerunners of direful disease, such as apoplexy, paralytic strokes, &c., should at once be met by a few large doses of these excellent searching Pills. They also produce sound and refreshing sleep; and anyone who is restless or nervous, and passes the night in strange imaginings and wakefulness, may get a good sound night's rest after taking two Pills.

**Indigestion, Want of Appetite, Fulness after Meals, Vom-
 itings, Sickness of the Stomach, Bilious or Liver Com-
 plaints, Sick Headaches, Cold Chills, Flushings of Heat,
 Lowness of Spirits, and all Nervous Affections.**

The above are a class of disorders that afflict all ages and both sexes, from youth to old age ; there are very few who do not fall victims to them some time or other ; and in a great many cases life is rendered a burden and a misery. To remove these complaints we must remove the cause. The principal cause is generally to be found in the stomach, liver and kidneys ; put these organs right and all will be well.

The action of Beecham's Pills is prompt and certain ; from two to four Pills twice a day for a short time will remove the evil, reinvigorate the system, and restore the sufferer to sound and lasting health.

**Scurvy and Scorbutic Affections, Pimples and Blotches on
 the Skin, Bad Legs, Ulcers, Wounds, &c., &c.**

The cause of all these complaints is in the blood, and it often happens that they are latent in the blood a long time before they break out on the body.

This class of disease requires that the blood be powerfully and perseveringly acted upon, in order to cleanse it from all the morbid humours which have been injuriously affecting it perhaps for many months. It is of no use to heal the sore by outward applications, for in so doing you only get rid of one trouble to make way for others much worse in a short time.

The blood must be cleansed of all these vicious humours. If two Beecham's Pills be taken twice a day for a week or two, and afterwards increased to three Pills twice a day, none need despair of a cure. If the patient will but persevere with the Pills, they will eradicate Scurvy, Erysipelas, Pimples, Blotches, and skin disorders generally ; they remove inflammation, and root out those diseases, which, *if allowed to remain*, will bring their victim to an early grave.

In all settled aches and pains, as GOUT and RHEUMATISM, a cure will be effected by taking from three to six Pills daily for a while. Their effects are astonishing—they change the whole system from pain and sickness to a state of health, and bring ease and strength to every part affected.

ADVICE TO FEMALES OF ALL AGES.

There are two very critical ages in the life of women. Females from sixteen to twenty-five years are often subject to serious variations and derangements affecting their usual monthly periods; which latter are either unduly delayed or poor and insufficient. Let such sufferers beware and remedy the evil before it is too late. Thousands are carried to the grave by Consumption, Decline, and other diseases of a fatal character, before they reach the prime of life, through carelessness in the matter referred to. There are many females in every condition of life, and particularly those dwelling in the manufacturing districts, or engaged in factories or business generally, who suffer from depression of spirits, shortness of breath, tightness in the chest, with difficulty in breathing, sometimes attended with a short, dry cough with loss of appetite, loss of memory, loss of sleep,—in fact, loss of all the proper energies of life, and very far on the high road to consumption, through a dangerous inattention to the laws which govern their sex. Women, as soon as they find any unusual delay or departure from regularity at the proper time, should assist Nature by taking two or more Beecham's Pills morning and night, and this efficient medicine will not fail to bring about the free and healthy action that is required.

If there is any pain or swelling in the legs or feet, put them in warm water for about ten minutes at bed time. Great care must be taken to keep the feet dry and warm, and to avoid putting the hands in cold water.

No female need despair of a cure, however bad or long-standing her case may be, if she will take these pills according to the directions given. One trial will convince those who do not yet know what a remarkable remedy they have at hand in Beecham's Pills.

From forty to fifty is, again, a highly critical age for a woman. It is, mostly, within this limit that what is generally known as "the change of life" occurs.

The humours which for many years have been carried off monthly, by the common course of Nature, are now liable to derange the most important functions of the body, and if allowed to remain in the system, to corrupt the blood and other vital fluids and secretions. From this cause may arise the most terrible and dangerous diseases, which very often destroy life, or else so undermine the health and break up the constitution, that the remainder of her days are rendered completely miserable.

How many females do we see daily around us, who suffer in a most distressing manner from Indigestion and loss of Appetite, Bilious and Liver Complaints, Sick Headache accompanied by lowness of spirits and great depression of the nervous system? Others again, suffering with bad legs, swellings and stiffness of the joints, rheumatism, dropsies, and a thousand other distressing complaints.

Beecham's Pills have saved the lives of thousands of women who have tried other medicines without avail, and given themselves up to despair. Let every female, as soon as she finds a change coming on, take four or five of the Pills every day for a week or two, and afterwards take them four or five days in every month, and by this means they will assist Nature to carry off all gross humours, purify the blood, strengthen and invigorate the nervous system and lay the foundation of health and strength.

Complainant's Exhibit VII.

MALADIES OF INDISCRETION.

It is very difficult to form a decision as to what should be communicated to the public on this subject, and what should be withheld. In this pamphlet it will be sufficient to offer a few general remarks and then proceed to indicate the method of cure, which is, beyond all, the question of supreme importance. Let it never be forgotten that even a slight delay in dealing with diseases of this nature may be terribly fruitful of future trouble.

Many people suppose that the consequences of these affections are confined to the *single* or *immoral*; but such is not the case. They often invade the married circle to an *alarming* extent; although, perhaps, the original disease might have been contracted in the forgotten past, but through neglect or bad treatment it has been lurking in the system for months and years, and will, sooner or later, break out into sores, bad legs, a dryness and soreness of the throat, pimples, and itchings on the breast and head. There will be frequently a dry headache, with dimness of sight, great lowness of spirits, with aches and pains in the limbs, particularly in the legs and thighs. In many cases there will be a slight scalding in the water at times, with a twitching and twinging in the urinary passage, and very often some pain in the discharge of water. It seldom happens that two people are affected alike; but in each and every one suffering from disorders which have their origin in "maladies of indiscretion" some of the above mentioned symptoms will be found.

In the distressing complaints which come under this head, BEECHAM'S PILLS will be found a medicine of great value, and one of the first factors in effecting a cure. Commencing with two or three pills every day for a week, the dose should be increased to five or six pills daily. Perseverance will ensure the most gratifying results, as they will thoroughly search out these troublesome diseases, purify and renew the blood, strengthen and invigorate the nervous system, and restore the patient to sound and perfect health. Beer, spirits, acids and salt meats are to be avoided, and the diet must be of the best and most substantial kind.

KIDNEY AND URINARY DISORDERS.

The kidneys are most important "Scavengers" of the system. It is their duty to take uric acid from the blood and to pass it on with other waste products to the bladder. If the kidneys fail to perform their work thoroughly, the uric acid undissolved accumulates in them and serious derangements follow. The blood becomes overcharged with the poison, which being passed through the system causes Gout, Rheumatism, Sciatica, Eczema, Gravel, and other painful diseases. BEECHAM'S PILLS taken at intervals, will assist the kidneys to perform their special cleansing functions, and enable the urine to take with it from the system impurities which if allowed to remain will give rise to dire results. The remarkable curative influence exercised by BEECHAM'S PILLS in cases of Bright's disease leaves no room to doubt that this medicine is of paramount importance to sufferers from affections of this nature.

BEECHAM'S COUGH PILLS.

(GREEN LABEL)

Persons suffering from Cough and kindred troubles should relieve their minds of the idea that nothing will benefit them unless it be in the form of a lozenge, or taken as liquid. Let them try *Beecham's Cough Pills*, and they will never regret it. These Pills are made from a formula differing entirely from that which guides the preparation of *Beecham's Pills (Yellow Label)*, but like them will be found reliable, and if the bowels are sluggish, doses of each kind may be taken at the same time with good effect. The *Cough Pills* do not contain opium; they do not constipate; they do not upset the stomach. On the first symptoms of a Cold or Chill, a timely dose of *Beecham's Cough Pills* will invariably ward off all dangerous features. For years many families have used no other Winter Medicine. Householders and travellers should avail themselves of this good, safe and simple remedy for Coughs in general, Asthma, Bronchial Affections, Hoarseness, Shortness of Breath, Tightness and Oppression of the Chest, Wheezing, etc. The doses may be from three to six pills morning, noon and night.

BEECHAM'S PILLS are prepared only, and Sold Wholesale by the Proprietor, JOSEPH BEECHAM, Successor to THOMAS BEECHAM, St. Helens, England, and 365, Canal Street, New York.

Sold at all Drug Stores in the United States in Boxes
at 10 cents and 25 cents each.

If you are not within reach of a druggist, a 25c. box of the pills will be sent by mail, upon receipt of price, by U. S. Agents, B. F. Allen Company, 365, Canal Street, New York.

The pills accompanying this pamphlet are specially packed for U. S. AMERICA, being covered with a quickly soluble pleasant Coating completely disguising the taste of the Pill without in any way impairing its efficacy.

ANNUAL SALE SIX MILLION BOXES.

Complainant's Exhibit VII.

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Complainant's Exhibit VIII.

BEECHAM'S PILLS.

JABRIBOND CIRCULARS

BEECHAM'S PILLS have been before the public for over half a century and now hold the supreme position among proprietary medicines. Their phenomenal success is due to the fact that they *recommend themselves*, and have gained their popularity solely on their merits. Their health-restoring and life-giving properties have obtained for them the proud position of *The Family Medicine* wherever the English language is spoken. They are made entirely from Medicinal Herbs, and do not contain mercury or other poisonous substance, and are suitable both for young and old. They cleanse the stomach, purify the blood, invigorate the nerves, and give tone and energy to the entire system.

262

REMARKS.—The blood is the well-spring of life, and the whole physical condition of the body largely depends upon it.

The blood is sometimes rendered impure by the addition and accumulation of noxious matter: But nature has provided for us organs, by means of which impurities are separated from the blood. The lungs, the liver, and the kidneys, are three most important organs for the *cleansing* purpose, and if they efficiently perform their duties, we enjoy a good state of health: but if the lungs imperfectly eliminate carbonic acid gas:—if the liver is sluggish in excreting gross or superfluous matter:—or if the kidneys are obstructed in their peculiar office of purification:—conditions of the blood are set up which render it incapable of supplying that nourishment to the tissues without which it is impossible to enjoy good health.

DIRECTIONS.

Persons of a strong or average constitution, temporarily indisposed, will usually find the dose to suit them to be three or four pills once a day: sometimes, however, it is necessary to repeat this dose morning and night, according to the condition of the system at the time. Others, who may be frequently subject to one or more of the specified ailments, should take smaller doses of the Pills occasionally, one, two, or three, generally being the ordinary dose, which may be increased at discretion by the patient. It is obviously impossible to prescribe one universal dose to suit all persons, from the fact that systems vary to such an extent that what would be a large dose for one, might not be sufficient for another. This rule, however, may be borne in mind, that on the first sign of *anything* wrong, at least two pills should be taken immediately.

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Complainant's Exhibit IX.

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This exhibit is a typical box of pills, twenty-five cent size, filed with the clerk.

Complainant's Exhibit X.

This exhibit is a typical box of pills, ten cent size, filed with the clerk. 266

Complainant's Exhibit XI.

United States Consulate, }
St. Helens, England, }

I, the undersigned, Consular Agent, of the United States of America, do certify and make known to whom these presents shall come that Henry Samuel Oppenheim, before whom the annexed affidavit of Joseph Beecham has been made and whose true signature, "H. S. Oppenheim," is subscribed thereto was at the the time of such execution a Commissioner duly authorized to administer oaths and receive declarations and to whose acts as such full faith and credit are due. 267

Given from under my hand and seal of
 { Seal of U. S. Consulate } Office at St. Helen's, England,
 the 24th day of February, and
 year one thousand nine hundred and six. 268

JOHN HAMMILL,
Consular Agent.

269 In the matter of an indenture made the 23rd day of March, 1895, between Thomas Beecham of the one part and Joseph Beecham of the other part.

I, Joseph Beecham, of St. Helens in the County of Lancaster, Patent Medicine Proprietor, make oath and say :

1.—I am the person described in the above mentioned Indenture as Joseph Beecham.

270 2.—The document now produced and shown to me and marked "A" has been carefully examined by me with the said Indenture and I say that the same is a true copy thereof with all endorsements therein.

JOSEPH BEECHAM.

Sworn at St. Helens in the County of Lancaster this twenty-fourth day of February, 1906.

271 Before me H. S. OPPENHEIM,

A Commissioner for Oaths.

This is the document marked "A" referred to in the affidavit of Joseph Beecham sworn before me this 24th day of February, 1906.

H. S. OPPENHEIM,
A Commissioner, Etc.

272 THIS INDENTURE made the twenty-third day of March, one thousand eight hundred and ninety-five between Thomas Beecham, of St. Helens in the County of Lancaster, Patent Medicine Manufacturer, of the one part, and Joseph Beecham, of the same place, Patent Medicine Manufacturer, of the other part.

WHEREAS the said Thomas Beecham and Joseph Beecham have for some time past carried on business at St. Helens aforesaid, and elsewhere in co-partnership as manufacturers and vendors of proprietary articles known as Beecham's Pills, Beecham's Patent Pills, Beecham's Cough Pills and Beecham's Toothpaste, and they also are the proprietors of a patent and of certain trade marks in connection with the said business in the United Kingdom, the British Colonies, the United States and the British Empire in India and Ceylon and elsewhere. 273 274

AND WHEREAS, the said Thomas Beecham and Joseph Beecham are interested in the said business and in all partnership assets and property held in connection therewith in equal shares, and whereas the said Thomas Beecham has determined to retire from the said business and to assign his share and interest in the said business and in all the partnership assets and property to the said Joseph Beecham in manner hereinafter appearing. 275

NOW THIS INDENTURE WITNESSETH that in consideration of the natural love and affection which the said Thomas Beecham has for his son the said Joseph Beecham, he, the said Thomas Beecham, doth hereby assign and release unto the said Joseph Beecham ALL that one undivided moiety or half part or share and all other (if any) the part share estate and interest of him, the said Thomas Beecham, of and in the Good-Will, Capital and all other assets of the said business of manufacturers and vendors of the said proprietary articles known as Beecham's Pills, Beecham's Patent Pills, Beecham's Cough Pills, and Beecham's Tooth Paste, and other articles including all patents, trade marks, stamps, engines, fixed and movable machinery, plant, trade, utensils, tools, stores, materials 276

277 for manufacture, manufactured goods, stock in trade, horses, carts, office furniture, safes, advertisement plates and hoardings chattels, effects, book debts, book credits, bills, notes, contracts, engagements and all other property and rights of or belonging or relating to the said partnership business.

To hold the said premises unto the said Joseph Beecham absolutely.

278 IN WITNESS WHEREOF the said parties to these presents have hereunto set their hands and seals the day and year first before written.

THOS. BEECHAM. (L. S.)

SIGNED, SEALED AND DELIVERED
by the said Thomas Beecham
in the presence of J. Malkin,
Solicitor, Liverpool.

279

Complainant's Exhibit XII.

This Exhibit is a typical box of the pills sold by the defendant, filed with the clerk.

Complainant's Exhibit XIII. (Being Exhibit A, annexed to Janvier's affidavit of March 9th, 1906.) 281

BEECHAM'S MAGIC COUGH PILLS.

As a remedy for Coughs in general, Asthma, Difficulty in Breathing, Shortness of Breath, Tightness and Oppression of the Chest, Wheezing, &c., these Pills stand unrivalled; and any one labouring under any of the above complaints need only try One Box, to prove that they are the best ever offered to the public for Asthmatic and Consumptive Coughs, Hoarseness and Oppression of the Chest. They speedily remove that sense of oppression and difficulty of breathing, which nightly deprives the patient of rest. They give almost instant relief and comfort to those afflicted with the above distressing, and, when neglected, dangerous complaints. Let any person troubled with any of the above complaints give BEECHAM'S COUGH PILLS a trial. Take four of six Pills morning and night, or if the cough is very troublesome, or there is much wheezing at the Chest, take four Pills three times a day, and they will act like MAGIC. The most violent Cough will in a short time be removed.

NOTICE.—Beecham's Cough Pills are a distinct Pill altogether from the other kind; and in most cases where the Cough Pills are taken, if one or two of the Patient are taken at the same time, one will very much increase the action of the other.

BEECHAM'S PILLS are prepared only, and Sold Wholesale by the Proprietor, THOMAS BEECHAM, St. Helens, Lancashire, England. Sold by all Druggists and Patent Medicine Dealers everywhere, in boxes 1s. 1½d. each.

These Pills being Specially put up for the American Market no English Revenue Stamp is required.

Complying with general request

BEECHAM'S PILLS

for the United States are covered with a QUICKLY SOLUBLE, PLEASANT COATING, completely disguising the taste of the Pill without in any way impairing its efficacy.

Beecham's Pills have the largest sale of any Patent Medicine in the World.

Price in the United States 25 Cents.

If your druggist should not have them, send 25 cents to the sole agents,

B. F. ALLEN CO., 365 CANAL ST., NEW YORK,
and a box of these wonderful pills will be mailed post-paid, to your address.

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285 **Complainant's Exhibit XIV. (Being Exhibit B, annexed to Janvier's affidavit of March 9th, 1906.)**

286

BEECHAM'S PILLS

(Tablet)

25 cents a box

THOMAS BEECHAM

St Helens Lancashire

ENGLAND

Sole Agents for the United States

B F ALLEN COMPANY

305 Canal Street

NEW YORK

Copyright 1906 by Thomas Beecham

BEECHAM'S PILLS

(Vegetable)

HOW TO TAKE THEM

First night take one at bed time. If this does not empty the bowels freely, the second night take two. If this fails, the third night take three, and so on; for a child old enough to swallow a pill, one pill is the dose.

287

The object in the beginning is to empty the bowels freely. The dose to go on with is, generally, one or two pills; but a person very hard to move may require as many as eight for several nights in succession.

When a person has been constipated for a long time, and the bowels are set going, he is liable to be a good deal disturbed in his stomach, have headache, lose appetite, be weak and depressed, for several days. These bad feelings pass away as soon as the bowels are thoroughly cleared; but they may last for several days, because it takes time to clear the bowels. In chronic constipation, the bowels are so loaded that two or three free movements are not enough to thoroughly clear them. Nothing but free movements for several days in succession will clear them.

The nightly dose should be diminished gradually until a night can be skipped without missing the stool next morning.

The object now is to keep the bowels regular. The pills do that, if enough and not too many are taken. They do more.

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WHAT THE PILLS ARE FOR

biliousness
torpid liver
jaundice
sallow skin
pimples
bilious headache
nervous headache
dull headache
swimming of the head
(browses, vertigo)

ringing in the ears
hot and throbbing head
coldness of hands and feet
hot skin
weakness
restlessness
depression of spirits
great mental depression
general debility
faintness

Complainant's Exhibit XV. (Being 289
Exhibit C, annexed to Janvier's affi-
davit of March 9th, 1906.)

BEECHAM'S COUGH PILLS. 290

(GREEN LABEL)

Beecham's Cough Pills relieve all kinds of coughs, bronchitis, asthma, hoarseness, loss of voice, dryness of the throat, tickling in the throat, by stimulating the secretions of the throat, windpipe and bronchial tubes.

They do not contain opium; they do not constipate; they do not upset the stomach.

DIRECTIONS.—Take three to six, morning noon and night. Swallow them whole—they are small and have no taste.

If the bowels are at all sluggish, open them freely with Beecham's Patent Pills 291

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 BEECHAM'S PILLS are prepared only by the Proprietor,  
 THOMAS BEECHAM, St. Helena, Lancashire, England.

If you are not within reach of a drugstore, the Cough Pills will be sent by mail, upon receipt of price, 25 cents a box, by B. F. Allen Company, 364 Canal street, New York.

~~~~~  
 The Pills accompanying this pamphlet are specially packed for the United States, being covered with a quickly soluble pleasant Coating completely disguising the taste of the Pill without in any way impairing its efficacy. 292

~~~~~  
**ANNUAL SALE 6,000,000 BOXES.**



293 **Complainant's Exhibit XVI. (Being Exhibit D, annexed to Janvier's affidavit of March 9th, 1906.)**



BEECHAM'S PILLS

(Tasteless)

25 cents a box

THOMAS BEECHAM

St. Helens Lancashire  
England

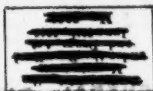
U. S. A. DEPOT  
365 Canal Street  
New York

**New and Revised Circular**

BEECHAM'S PILLS have been before the public for over half-a-century, and now hold the supreme position among proprietary medicines. This, alone, is an overwhelming proof of the genuine worth of these pills, if there be any meaning in the ancient saying, "*Vox populi, vox Dei*." For had they not a thousand-fold justified their claims upon public confidence, they could never have achieved such a splendid triumph over interested opposition and criticism throughout so long a period. Their phenomenal success is due to the fact that they recommend themselves, and have gained their popularity solely on their merits. Accumulated experience, all the world over, has declared them to be the most reliable Family Medicine procurable; and whenever tried, they have been permanently adopted as the specific to be depended on for defeating those evils which usually assail health in our daily lives, and, if taken in time, they will ward off many a serious illness. Many thousands have felt constrained to inform me by letter of the benefits they have derived from the use of "BEECHAM'S PILLS": and while such testimonials have been a source of profound gratification, I have refrained from publishing them, preferring that the pills should continue to recommend themselves. These renowned pills are composed entirely of MEDICINAL HERBS; and are warranted free from mercury or other poisonous substance. They can harm no one, and may be given to children, or to the aged and infirm, with perfect safety. They cleanse the stomach and bowels, and purify the blood; invigorate the whole nervous system, and give tone and energy to the muscles. In the preparation of BEECHAM'S PILLS the most scrupulous care is taken, and the ingredients form the most successful combination that has ever been discovered for the complaints enumerated in this pamphlet.

THOMAS BEECHAM.

**Complainant's Exhibit XVII. (Being Exhibit E, annexed to Janvier's affidavit of March 9th, 1906.)**



**BEECHAM'S PILLS**

(Tasteless)

25 cents a box

**THOMAS BEECHAM**

St. Helens Lancashire  
England

U. S. A. DEPOT  
365 Canal Street  
New York

**New and Revised Circular**

**BEECHAM'S PILLS** have been before the public for over half-a-century, and now hold the supreme position among proprietary medicines. This, alone, is an overwhelming proof of the genuine worth of these pills, if there be any meaning in the ancient saying, "*Vox populi, vox Dei.*" For had they not a thousand-fold justified their claims upon public confidence, they could never have achieved such a splendid triumph over interested opposition and criticism throughout so long a period. Their phenomenal success is due to the fact that they *recommend themselves*, and have gained their popularity solely on their merits. Accumulated experience, all the world over, has declared them to be **THE** most reliable Family Medicine procurable; and whenever tried, they have been permanently adopted as the specific to be depended on for defeating those evils which usually assail health in our daily lives, and, if taken in time, they will ward off many a serious illness. Many thousands have felt constrained to inform me by letter of the benefits they have derived from the use of "**BEECHAM'S PILLS**": and while such testimonials have been a source of profound gratification, I have refrained from publishing them, preferring that the pills should continue to *recommend themselves*. These renowned pills are composed entirely of **MEDICINAL HERBS**; and are warranted free from mercury or other poisonous substance. They can harm no one, and may be given to children, or to the aged and infirm, with perfect safety. They cleanse the stomach and bowels, and purify the blood; invigorate the whole nervous system, and give tone and energy to the muscles. In the preparation of **BEECHAM'S PILLS** the most scrupulous care is taken, and the ingredients form the most successful combination that has ever been discovered for the complaints enumerated in this pamphlet.

**THOMAS BEECHAM.**

- 301 **Complainant's Exhibit XVIII. (Being Exhibit F, annexed to Janvier's affidavit of March 9th, 1906.)**

## BEECHAM'S PILLS

(Vegetable)

### HOW TO TAKE THEM

First night take one at bed time. If this does not empty the bowels freely, the second night take two. If this fails, the third night take three, and so on; for a child old enough to swallow a pill, one pill is the dose.

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The object in the beginning is to empty the bowels freely.

The dose to go on with is, generally, one or two pills; but a person very hard to move may require as many as eight for several nights in succession.

When a person has been constipated for a long time, and the bowels are set going, he is liable to be a good deal disturbed in his stomach, have headache, lose appetite, be weak and depressed, for several days. These bad feelings pass away as soon as the bowels are thoroughly cleared; but they may last for several days, because it takes time to clear the bowels. In chronic constipation, the bowels are so loaded that two or three free movements are not enough to thoroughly clear them. Nothing but free movements for several days in succession will clear them.

The nightly dose should be diminished gradually until a night can be skipped without missing the stool next morning.

The object now is to keep the bowels regular. The pills do that, if enough and not too many are taken. They do more.

303

### WHAT THE PILLS ARE FOR

biliousness  
torpid liver  
jaundice  
sallow skin  
pimples  
bilious headache  
nervous headache  
dull headache  
swimming of the head  
dizziness (vertigo)

ringing in the ears  
hot and throbbing head  
coldness of hands and feet  
hot skin  
weakness  
listlessness  
depression of spirits  
great mental depression  
general debility  
faintness

2 304

Complainant's Exhibit XIX. (Being Exhibit G, annexed to Janvier's affidavit of March 9th, 1906.)

305

## BEECHAM'S PILLS.

(ABBREVED CIRCULAR)

BEECHAM'S PILLS have been before the public for over half a century and now hold the supreme position among proprietary medicines. Their phenomenal success is due to the fact that they command thousands, and have gained their popularity solely on their merits. Their health-restoring and life-giving properties have obtained for them the proud position of *The Family Medicine* wherever the English language is spoken. They are made entirely from Medicinal Herbs, and do not contain mercury or other poisonous substance, and are suitable both for young and old. They cleanse the stomach, purify the blood, invigorate the nerves, and give tone and energy to the entire system.

306

REMARKS.—The blood is the well-spring of life, and the whole physical condition of the body largely depends upon it.

The blood is sometimes rendered impure by the addition and accumulation of noxious matter: but nature has provided for us organs, by means of which impurities are separated from the blood. The lungs, the liver, and the kidneys, are three most important organs for the *cleansing* purpose, and if they efficiently perform their duties, we enjoy a good state of health: but if the lungs imperfectly eliminate carbonic acid gas;—if the liver is sluggish in excreting gross or superfluous matter;—or if the kidneys are obstructed in their peculiar office of purification:—conditions of the blood are set up which render it incapable of supplying that nourishment to the tissues without which it is impossible to enjoy good health.

### DIRECTIONS.

Persons of a strong or average constitution, temporarily indisposed, will usually find the dose to suit them to be three or four pills once a day: sometimes, however, it is necessary to repeat this dose morning and night, according to the condition of the system at the time. Others, who may be frequently subject to one or more of the specified ailments, should take smaller doses of the Pills occasionally, one, two, or three, generally being the ordinary dose, which may be increased at discretion by the patient. It is obviously impossible to prescribe a *universal* dose to suit all persons, from the fact that systems vary to such an extent that what would be a large dose for one, might not be sufficient for another. This rule, however, may be borne in mind, that on the first sign of *anything* wrong, at least two pills should be taken immediately.

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307

308

309 **Complainant's Exhibit XX. (Being Exhibit H, annexed to Janvier's affidavit of March 9th, 1906.)**

310

**BEECHAM'S PILLS** will cure Bilious and Nervous Disorders, Indigestion, Want of Appetite, Fulness after Meals, Vomiting, Sickness at the Stomach, Torpid Liver, Sick Headache, Cold Chills, Flushings of Heat, Lowness of Spirits, &c.

For attacks of Headache, Dizziness or Swimming in the Head, Wind, Pain and Spasms at the Stomach, Pains in the Back, Restlessness, Insomnia, &c., **Beecham's Pills** are invaluable, and will give relief almost immediately.

Scabby and Scorbatic Affections, Pimples and Blotches on the Skin, Bad Legs, Ulcers, &c., are the result of bad and impure blood. **Beecham's Pills** will speedily remove the cause by cleansing the blood of all its vicious humours. Outward application only gets rid of one trouble to make room for another.

Kidney and Urinary Disorders, Gout, Rheumatism, Sciatica, Eczema, Gravel, &c., are caused by accumulation of uric acid in the blood. **Beecham's Pills** will assist the Kidneys to dissolve this uric acid and pass it from the system in the urine.

FOR CONSTIPATION, empty the bowels freely for a few days, then keep them regulated by taking one, two, or more pills occasionally.

FOR FEMALES of all ages **Beecham's Pills** are specially suitable. Females from sixteen to twenty-five are often subject to serious derangements in their usual monthly periods, which are either unduly delayed or are poor and insufficient, and, if left unattended to, dire results follow. No medicine can be found to equal **Beecham's Pills** for assisting Nature at this important time. Two or more Pills taken night and morning will not fail to bring about the free and healthy action required.

311

From forty to fifty is a very critical age for women, as, mostly within this limit the "change of life" occurs. The humours which have been carried off monthly by the common course of nature, are now liable to lay seeds of terrible and dangerous diseases, if allowed to remain in the system. As soon as a change comes on, the Pills should be taken in sufficient doses, and they will take from the system all gross humours, purify the blood, and strengthen and invigorate the nervous system.

PREPARED ONLY BY THE PROPRIETOR—

**THOMAS BEECHAM, St. Helena, England; and 385, Canal Street, New York, U.S.A.**

Sold by all Druggists, 10 cents (12 pills), and 25 cents (40 pills) a box.

312

**Complainant's Exhibit XXI. (Being Exhibit I, annexed to Janvier's affidavit of March 9th, 1906.)** 313

Thomas Beecham  
St Helens Lancashire  
England

Directions Inside the box .....cut here  
Beecham's Pills 10c.  
Beecham's Pills 10c.  
Beecham's Pills 10c.  
Beecham's Pills 10c.  
Beecham's Pills 10c.  
Beecham's Pills 10c.  
Beecham's Pills 10c.  
Beecham's Pills 10c.

314

315

316

317 **Complainant's Exhibit XXII. (Being Exhibit J, annexed to Janvier's affidavit of March 9th, 1906.)**

318

Thomas Beecham

St Helens England

and

New York U S A

Directions inside the box  
 .....cut here

Beecham's Pills 10c.

Beecham's Pills 10c.

Beecham's Pills 10c.

Beecham's Pills 10c.

Beecham's Pills 10c.

Beecham's Pills 10c.

Beecham's Pills 10c.

Beecham's Pills 10c.

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United States Circuit Court, Eastern District of New York.

JOSEPH BEECHAM

*vs.*

MARK JACOBS.

APRIL 3, 1906.

Gould & Willie, Solicitors for Complainant.  
Charles Goldzier, Solicitor for Defendant.

THOMAS, J.:

The defendant's use of the word "Beecham" is both conscienceless and illegal, and his effort to avoid the consequences of his tortious appropriation of the word by alleging fraudulent misrepresentations to the public by the complainant has no just foundation. The defendant should be restrained until the final hearing from using the word "Beecham" in any way whatever in connection with the sale of his pills.

EDWARD B. THOMAS, U. S. J.

At a Stated Term of the Circuit Court of the United States for the Eastern District of New York, Held at the Post Office Building, in the Borough of Brooklyn, County of Kings, State of New York, on the 16th Day of November, 1906.

Present: Hon. Edward B. Thomas, District Judge holding the Court.

In Equity.

JOSEPH BEECHAM, Complainant,

*vs.*

MARK JACOBS, Defendant.

*Final Decree.*

This cause came on to be heard at this Term and was argued by counsel and thereupon upon consideration thereof it is ordered, adjudged and decreed, that the defendant, Mark Jacobs, his agents, servants, employees, workmen, attorneys, or any other person or persons, with his connivance, or at his procurement, be, and they hereby are, perpetually enjoined and restrained from using or continuing to use the word "Beecham" upon any boxes, labels, cartoons, circulars, pamphlets or other printed matter, used upon or in connection with such pills, or in connection with any pills prepared, manufactured, boxed, put up, sold, exposed for sale, or in any way disposed of by the said defendant; or from using or continuing to use such word in connection with the sale of any pills put up, sold, manufactured, dealt in or offered or exposed for sale, by him or them; and in general from in anywise using the said word "Beecham" to indicate or describe any pills manufactured, sold or exposed for sale by him; and it is further ordered, adjudged and de-



creed, that a writ of injunction be issued under the seal of this Court, perpetually forbidding and restraining the defendant in the terms of this order from any use of the said word "Beecham" as aforesaid; and it is further ordered, adjudged and decreed that the defendant, Mark Jacobs, do pay to the complainant, Joseph Beecham, his costs and disbursements to be taxed by the Clerk of this Court.

EDWARD B. THOMAS, *U. S. J.*

(Endorsed:) Final Decree.—Filed and entered November 16, 1906.

Circuit Court of the United States for the Eastern District of  
New York.

In Equity.

JOSEPH BEECHAM, Appellee,  
*against*  
MARK JACOBS, Appellant.

To the Honorable the Judges of the United States Circuit Court of  
Appeals in and for the Second Circuit:

Now comes Mark Jacobs, by Charles Goldzier, his solicitor, feeling aggrieved, and prays an appeal to the United States Court of Appeals for the Second Circuit from the final decree entered in the above entitled cause on the 16th day of November, 1906, granting an injunction against the use by the defendant, Mark Jacobs, of the word "Beecham" in connection with the manufacture or sale of pills, and with costs as thereby provided, and from each and every part thereof.

Dated New York, May 16, 1907.

CHARLES GOLDZIER,  
*Solicitor for Appellant.*

Office and Post Office address, 53-63 Park Row, Borough of Manhattan, City of New York.

The within appeal allowed.  
May 15, 1907.

THOMAS IVES CHATFIELD, *U. S. J.*

(Endorsed:) Petition.—Filed May 16, 1907.

Circuit Court of the United States, Eastern District, in the Second Circuit.

JOSEPH BEECHAM

*vs.*

MARK JACOBS.

And now comes Mark Jacobs, by Charles Goldzier, his solicitor, and says: That in the record and in the proceedings and the final decree in said cause, there is manifest error in this:

1st. In ordering, adjudging and decreeing that the writ of injunction be issued under the seal of this Court, perpetually forbidding and restraining the defendant from any use of the word "Beecham."

2d. In imposing upon the defendant the costs and disbursements of this action.

3d. In enjoining and restraining the defendant, his agents and servants from using or continuing the use of the word "Beecham" upon any boxes, labels, cartoons, circulars, pamphlets or other matter, or in connection with any pills, or from using said word in connection with the sale of any pills, or to indicate or describe any pills manufactured or exposed by the defendant.

4th. In finding and determining that the complainant has acquired a trade-mark or is entitled to the protection as a trade-mark of the word "Beecham" in connection with the sale of pills or otherwise.

5th. In finding and determining that the complainant has procured a trade-mark in or to the name "Beecham" or "Beecham's Pills," in accordance with any registration pursuant to Act of Congress or otherwise.

6th. In finding and determining that the complainant has not lost any rights to the protection of the word "Beecham" as a trade-mark or otherwise, by reason of his false representation in the manufacture and sale of the pills exposed for sale under the name of "Beecham's Pills, that the same were manufactured at St. Helens, Lancashire, England.

7th. In entertaining the complainant's bill of complaint and refusing to a dismissal thereof, despite the fact that the said bill of complaint is not verified as required by the rules of equity and practice of the United States Courts.

8th. In refusing and failing to dismiss the complainant's bill of complaint, although it was not therein alleged or proven upon the trial that the defendant's alleged infringement occurred in connection with foreign commerce or Indian trade.

9th. In failing to dismiss the complainant's bill of complaint, although it is not therein alleged and was not proven at the trial that the complainant had not given to the defendant license or authority to use the name "Beecham" in connection with the manufacture of pills by him.

10th. In failing to dismiss the bill of complaint, although the complainant failed to allege or prove that the complainant was or is entitled to the exclusive use of the name "Beecham" in connection with the manufacture of pills or otherwise.

11th. In finding and determining that the complainant is entitled to the exclusive use of the word "Beecham" in connection with the manufacture of pills or sale of the pills manufactured by him.

12th. In finding and determining that the complainant is entitled to the exclusive use of the word "Beecham" in connection with the manufacture of pills or otherwise as a trade name or trade-mark.

13th. In finding and determining that the complainant has not lost his right to the exclusive use of the word "Beecham" in connection with the manufacture of pills or otherwise, or to the protection of the said name by reason of the false statement in connection with the sale thereof that the pills manufactured by him are patented or patent pills.

14th. In finding and determining that the complainant has not lost the exclusive right to the use of the name "Beecham" in connection with the manufacture of pills or otherwise, or to the protection of the said name by reason of his falsely and fraudulently claiming of the said pills were manufactured by "Thomas Beecham."

15th. In not finding and determining that the complainant has been guilty of such fraudulent misrepresentation in advertising and selling his pills, that he is not entitled to the protection of the court of equity.

16th. In not finding that Mark Jacobs, the defendant, has the right to use the name "Beecham" in connection with his own name, or otherwise, as its use was shown upon the trial herein.

17th. In not finding that Mark Jacobs, the defendant, has not been guilty of any fraudulent conduct or of any acts constituting or making a case of unfair competition in trade.

18th. In not finding that the complainant is not entitled to the relief demanded in his bill of complaint.

19th. In not granting a decree dismissing the complainant's bill of complaint.

Wherefore, the said Mark Jacobs prays that said decree may be reversed and a decree entered in said cause, dismissing the complainant's bill of complaint herein upon the merits, or in such terms as justice and equity may require.

Dated New York, May 16, 1907.

CHAS. GOLDZIER,  
*Solicitor for Defendant.*

Office and Post Office address, 53-63 Park Row, Borough of Manhattan, City of New York.

(Endorsed:) Assignment of Errors.—Filed May 15, 1907.

## United States Circuit Court, Eastern District of New York.

JOSEPH BEECHAM, Complainant,  
*against*  
 MARK JACOBS, Defendant.

Know all men by these presents, that Mark Jacobs, of the City of New York, New York, as principal, and the American Bonding Company of Baltimore, a corporation organized under the laws of the State of Maryland, and having an office at 34 Nassau Street, Borough of Manhattan, City of New York, as surety, are held and firmly bound unto the plaintiff in this case, to wit, Joseph Beecham, in the full and just sum of two hundred and fifty dollars (\$250), to be paid to the said Joseph Beecham, his legal attorneys, successors or assigns, to which payment well and truly to be made we bind ourselves, our heirs, executors, administrators, successors and assigns, jointly and severally, firmly by these presents.

Scaled with our seals and dated the 14th day of May, 1907.

Whereas, lately at the Circuit Court of the United States for the Eastern District of New York, in a suit pending in the said Court between Joseph Beecham, plaintiff, and Mark Jacobs, defendant, a decree was rendered against the said Mark Jacobs, defendant, and the said defendant having obtained and filed an appeal in the Clerk's Office of this Court to reverse the decree in the aforesaid suit, and a citation directed to the said Joseph Beecham, citing him to be and appear at a session of the United States Circuit Court of Appeals to be holden in the City of New York, in the said Circuit, on the 15th day of June, 1907, next.

Now, therefore, the condition of the above obligation is such that if the said defendant, to wit, Mark Jacobs, shall prosecute such appeal to efficacy and answer all damages and costs if he fails to make the said appeal good, then the above obligation to be void, else to remain in full force and virtue.

Scaled and delivered in the presence of

AMERICAN BONDING COMPANY OF  
 BALTIMORE.

By HULBERT T. E. BEARDSLEY,

*Resident Vice-President,*

[SEAL.]

Attest:

PAUL W. ARNOLD,

*Resident Assistant Secretary.*

CITY AND COUNTY OF NEW YORK.

*State of New York, ss:*

On the 14th day of May, 1907, before me personally came Hulbert T. E. Beardsley, to me known, who, being by me duly sworn, did depose and say: That he resides in the City of New York, that he is the resident Vice-President of the American Bonding Company

of Baltimore, the corporation described in and which executed the within instrument; that he knew the seal of said corporation; that the seal affixed to said instrument was such corporate seal; that it was so fixed by order of the Board of Directors of said corporation, and that he signed his name thereto by like order; and that the liabilities of said company do not exceed its assets as ascertained in the manner provided by law. And the said Hulbert T. E. Beardsley further said that he was acquainted with Paul W. Arnold and knew him to be the resident Assistant Secretary of said company; that the signature of said Paul W. Arnold subscribed to the within instrument is the genuine handwriting of the said Paul W. Arnold, and was subscribed thereto by like order of the Board of Directors in the presence of him, the said Hulbert T. E. Beardsley.

EDWARD F. HEALEY,  
*Notary Public, New York County.*

(Endorsed:) Undertaking on Appeal.—The within undertaking is approved as to form and as to the sufficiency of the surety, Thomas L. Chatfield, U. S. J.—Filed May 15th, 1907.

UNITED STATES OF AMERICA,  
*Eastern District of New York, ss:*

I, B. Lincoln Benedict, Clerk of the Circuit Court of the United States for the Eastern District of New York, in the Second Judicial Circuit, do hereby certify that the foregoing is a true transcript of the pleadings, proofs, exhibits, opinion, decree and appeal papers, made up to be transmitted to the United States Circuit Court of Appeals for the Second Circuit, on appeal of the defendant, in the suit wherein Joseph Beecham is complainant and Mark Jacobs is defendant.

In witness whereof I have hereunto set my hand and the seal of this Court the 12th day of June, 1907.

[SEAL.]

B. LINCOLN BENEDICT, *Clerk.*

To Joseph Beecham, Greeting:

You are hereby cited and admonished to be and appear before a United States Circuit Court of Appeals for the Second Circuit, to be holden at the Borough of Manhattan, in the City of New York, in the State of New York, on the 13th day of June, 1907, pursuant to a petition of appeal filed in the Clerk's office of the Circuit Court of the United States for the Eastern District of New York, wherein Mark Jacobs is appellant and Joseph Beecham is appellee, to show cause, if any there be, why the decree in said suit mentioned should not be corrected, and speedy justice should not be done in that behalf.

Given under my hand, in the Borough of Brooklyn, in the City of New York, in the District and Circuit above named, this 15th day of May, in the year one thousand nine hundred and seven, and

of the Independence of these United States the one hundred and thirty-first.

THOMAS I. CHATFIELD,  
*Judge Holding the Circuit Court of the  
United States for the Eastern District  
of New York, in the Second Circuit.*

(Endorsed:) United States Circuit Court of Appeals, Second Circuit.—Eq. 4/224.—Joseph Beecham *vs.* Mark Jacobs.—Original citation.—Charles Goldzier, Solicitor for Defendant, 63 Park Row (World Building), Borough of Manhattan, New York City. Received and filed May 16, 1907.—Service of a copy of the within citation is hereby admitted.—Dated New York, May 16, 1907. Gould & Wilke, Sol'rs for Complainant.

United States Circuit Court of Appeals for the Second Circuit.

No. 105, October Term, 1907.

Argued December 11, 1907; Decided January 7, 1908.

JOSEPH BEECHAM, Complainant-Appellee,

*vs.*

MARK JACOBS, Defendant-Appellant.

Appeal from the Circuit Court of the United States for the Eastern District of New York.

Before Judges Lacombe, Coxe, and Noyes.

Appeal from a Decree of the Circuit Court, Eastern District of New York, in Favor of the Appellee, Who Was the Complainant Below.

NOYES, *Circuit Judge*:

The bill charges the infringement of the trade-mark "Beechams Pills." The proof shows that the defendant has deliberately appropriated the name "Beechams Pills." If the complainant is entitled to enforce his rights in a court of equity, the defendant should be restrained.

But it is urged that the complainant cannot be heard to complain of the defendant's misconduct because his own hands are not clean—that his packages bear such misstatements of important facts as to bar him from relief in equity. The defendant claims:

(1) That the complainant falsely states that his pills are patented.

(2) That the complainant falsely states that his pills are made in England.

It is admitted that the complainant's pills are not patented. Whether they were ever patented does not appear. On some of

his packages the complainant uses the word "patent" as a part of the name of his pills—"Beechams Patent Pills."

It thus appears that the complainant employs the word "Patent" in connection with pills which are not patented. If such use of the term amounts to a representation that the pills are manufactured under Letters Patent, the complainant, by such false assertion, is precluded from relief in equity.

*Holzappel & Co. vs. Rahtjen & Co.*, (183 U. S. 1); *Oliphant vs. Salem Flouring Mills*, (5 Sawyer 128); Fed. cases No. 10,486; *Consolidated vs. Dorflinger*, (Fed. cases No. 3,129); *Leather Cloth Co. vs. American Leather Cloth Co.* (11 H. L. Cas. 523).

But it is only in cases where such use is deceptive, that the owner of a trade-mark is deprived of a remedy. Where the use of the word in connection with an article does not amount to a representation that the article is patented, it is innocent. The best illustration of this innocent use is the case of proprietary preparations which are universally called patent medicines. So, certain enameled leather is always spoken of as patent leather. Undoubtedly in these and similar cases the word "patent" was originally attached to the article because it was the subject of the patent. But it has lost that significance and by usage has become merely a part of the name of the article.

The complainant's preparation is a patent medicine. In view of the general use of the word "patent" in this connection, we think there was nothing deceptive in incorporating it in the name—"Beechams Patent Pills." It is employed in the proprietary sense. The natural inference is that the pills are made according to Beecham's secret formula, not that they are manufactured under Letters Patent.

False statements as to the place where a complainant's goods are manufactured, may preclude him from equitable relief. *Manhattan Medicine Co. vs. Wood*, (108 U. S. 218). The defendant claims that these principles apply here. But none of the complainant's packages or circulars in use at the time of the commencement of the suit, or years before, contain any false statement as to the place of manufacture. Fairly considered, they state what is true—that the pills are prepared and sold by the complainant in St. Helens, England, and in New York. The statement that "the pills accompanying this pamphlet are specially packed for U. S. America," may possibly suggest their manufacture outside the country, but falls far short of being a false representation.

We find nothing in the case to justify the defendant's contention that the complainant, by misrepresentation, is precluded from relief against the defendant's wilful misappropriation of his trade-mark.

The decree of the Circuit Court is affirmed with costs.

*Arthur von Brisen*, for the Appellant.

*Learned Hand*, for the Appellee.

At a Stated Term of the United States Circuit Court of Appeals in and for the Second Circuit, Held at the Court Rooms, in the Post Office Building, in the City of New York, on the 17th Day of January, One Thousand Nine Hundred and Eight.

Present: Hon. E. Henry Lacombe, Hon. Alfred C. Coxe, Hon. Walter C. Noyes, Circuit Judges.

JOSEPH BEECHAM, Complainant-Appellee,

*vs.*

MARK JACOBS, Defendant-Appellant.

Appeal from the Circuit Court of the United States for the Eastern District of New York.

This cause came on to be heard on the transcript of record from the Circuit Court of the United States, for the Eastern District of New York, and was argued by counsel.

On consideration whereof, it is now hereby ordered, adjudged and decreed that the order of said Circuit Court be and it hereby is affirmed with costs.

It is further ordered that a Mandate issue to the said Circuit Court in accordance with this decree.

E. H. L.

W. C. N.

A. C. C.

Endorsed: United States Circuit Court of Appeals, Second Circuit. Joseph Beecham *vs.* Mark Jacobs. Order for Mandate. United States Circuit Court of Appeals, Second Circuit. Filed Jan. 20, 1908. William Parkin, Clerk.

Supreme Court of the United States.

In Equity.

JOSEPH BEECHAM, Appellee,

*against*

MARK JACOBS, Appellant.

To the Honorable the Justices of the Supreme Court of the United States:

Now comes Mark Jacobs, by Weill & Weill, his Solicitors, he being defendant in a certain suit entitled, Joseph Beecham, complainant, against Mark Jacobs, defendant, pending in the United States Circuit Court for the Eastern District of New York, and carried by appeal to the United States Circuit Court of Appeals, for the Second Circuit, and there decided against said defendant-appellant on or about January 20th, 1908, by a judgment and decree affirming a judgment and decree of said Circuit Court in favor of plaintiff,



and said Mark Jacobs feeling aggrieved by said determination and judgment and decree of said United States Circuit Court of Appeals for the Second Circuit, prays for the allowance of an appeal to the Supreme Court of the United States.

Dated New York, January 16th, 1909.

WEILL & WEILL,  
*Solicitors for Appellants, 63 Park Row, New York City.*

The within appeal is hereby allowed January 16th, 1909.

H. G. WARD,  
*United States Circuit Judge.*

(Endorsed:) Supreme Court of the United States. Joseph Beecham, Appellee, against Mark Jacobs, Appellant. Petition for allowance of appeal. Weill & Weill, Attorneys for Appellant, 53-63 Park Row, Borough of Manhattan, New York City. Copy of within received Jan. 16, 1909. Gould & Wilkie. United States Circuit Court of Appeals, Second Circuit. Filed Jan. 16, 1909. William Parkin, Clerk.

Supreme Court of the United States.

JOSEPH BEECHAM, Appellee,  
*against*  
MARK JACOBS, Appellant.

Now comes Mark Jacobs, by Weill & Weill, his Solicitors, and says: That in the record and in the proceedings and the final decree in said cause, there is manifest error in this:

1. In ordering, adjudging and decreeing that the writ of injunction be issued under the seal of this Court, perpetually forbidding and restraining the defendant from any use of the word "Beecham."

2. In imposing upon the defendant the costs and disbursements of this action.

3. In enjoining and restraining the defendant, his agents and servants from using or continuing the use of the word "Beecham" upon any boxes, labels, cartoons, circulars, pamphlets or other matter, or in connection with any pills, or from using said word in connection with the sale of any pills, or to indicate or describe any pills manufactured or exposed by the defendant.

4. In finding and determining that the complainant has acquired a trade-mark or is entitled to the protection as a trade-mark of the word "Beecham" in connection with the sale of pills or otherwise.

5. In finding and determining that the complainant has procured a trade-mark in or to the name "Beecham" or "Beecham's Pills," in accordance with any registration pursuant to Act of Congress or otherwise.

6. In finding and determining that the complainant has not lost any rights to the protection of the word "Beecham" as a trade-mark or otherwise, by reason of his false representation in the manufacture and sale of the pills exposed for sale under the name of "Beecham's

Pills, that the same were manufactured at St. Helens, Lancashire, England.

7. In entertaining the complainant's bill of complaint and refusing a dismissal thereof, despite the fact that the said bill of complaint is not verified as required by the rules of equity and practice of the United States Courts.

8. In refusing and failing to dismiss the complainant's bill of complaint, although it was not therein alleged or proven upon the trial that the defendant's alleged infringement occurred in connection with foreign commerce or Indian trade.

9. In failing to dismiss the complainant's bill of complaint, although it is not therein alleged and was not proven at the trial that the complainant had not given to the defendant license or authority to use the name "Beecham" in connection with the manufacture of pills by him.

10. In failing to dismiss the bill of complaint, although the complainant failed to allege or prove that the complainant was or is entitled to the exclusive use of the name "Beecham" in connection with the manufacture of pills or otherwise.

11. In finding and determining that the complainant is entitled to the exclusive use of the word "Beecham" in connection with the manufacture of pills or sale of the pills manufactured by him.

12. In finding and determining that the complainant is entitled to the exclusive use of the word "Beecham" in connection with the manufacture of pills or otherwise as a trade name or trade-mark.

13. In finding and determining that the complainant has not lost his right to the exclusive use of the word "Beecham" in connection with the manufacture of pills or otherwise, or to the protection of the said name by reason of the false statement in connection with the sale thereof that the pills manufactured by him are patented or patent pills.

14. In finding and determining that the complainant has not lost the exclusive right to the use of the name "Beecham" in connection with the manufacture of pills or otherwise, or to the protection of the said name by reason of his falsely and fraudulently claiming that said pills were manufactured by "Thomas Beecham."

15. In not finding and determining that the complainant has been guilty of such fraudulent misrepresentation in advertising and selling his pills, that he is not entitled to the protection of the court of equity.

16. In not finding that Mark Jacobs, the defendant, has the right to use the name "Beecham" in connection with his own name, or otherwise, as its use was shown upon the trial herein.

17. In not finding that Mark Jacobs, the defendant, has not been guilty of any fraudulent conduct or of any acts constituting or making a case of unfair competition in trade.

18. In not finding that the complainant is not entitled to the relief demanded in his bill of complaint.

19. In not granting a decree dismissing the complainant's bill of complaint.

20. In that the United States Circuit Court of Appeals, for the Second Circuit, affirmed the judgment and decree of the United

States Circuit Court for the Eastern District of New York, notwithstanding each and all of the foregoing assignment- of errors there urged.

21. In that the United States Circuit Court of Appeals sustained the validity of complainant's alleged trade-mark, while treating it as referring and describing merely the process under which said articles were manufactured.

22. In that said Courts did not hold that the bill of complaint herein fails to make necessary jurisdictional allegations.

Wherefore, the said Mark Jacobs prays that said decree may be reversed and a decree entered in said cause, dismissing the complainant's bill of complaint.

Dated, New York, January 16th, 1909.

WEILL & WEILL,

*Solicitors for Defendant-Appellant, 63 Park Row,*

*Borough of Manhattan, City of New York.*

(Endorsed:) Supreme Court of the United States. Joseph Beecham, Appellee, against Mark Jacobs, Appellant. Assignment of Errors. Weill & Weill, Attorneys for Appellants, 53-63 Park Row, Borough of Manhattan, New York City. Copy of within assignment of errors rec'd Jan. 16/09. Gould & Wilkie. United States Circuit Court of Appeals, Second Circuit. Filed Jan 16, 1909. William Parkin, Clerk.

United States Circuit Court of Appeals, Second Circuit.

JOSEPH BEECHAM, Appellee,

*against*

MARK JACOBS, Appellant.

Know all men by these presents, that we, Mark Jacobs, as principal, and Samuel Solomon, of the Borough — Manhattan, City of New York, as surety, are held and firmly bound unto Joseph Beecham, in the full and just sum of two hundred and fifty (\$250.00) dollars, to be paid to the said Joseph Beecham, for which payment well and truly to be made, we bind ourselves, our heirs, executors and administrators, jointly and severally by these presents.

Sealed with our seals, Dated the fifteenth day of January, 1909.

Whereas, lately at the United States Circuit Court of Appeals for the Second Circuit, on an appeal had to said court from the Circuit Court of the United States, Eastern District, an order was made and entered affirming the final decree of the said Circuit Court of the United States for the Eastern District, granting an injunction to the plaintiff-appellee, and the said Mark Jacobs having applied for and obtained the allowance of an appeal for the review of the said order in the Supreme Court of the United States, and filed a copy thereof in the Clerk's office of said Court.

Now, the condition of the above obligation is such, that if the said Mark Jacobs shall prosecute the said appeal to effect, and shall an-

swer all costs if he shall fail to make his said appeal good, then the above obligation to be void else to remain in full force and effect.

Sealed and delivered, and taken and acknowledged, this 15th day of January, 1909.

(Signed) MARK JACOBS. [L. s.]

(Signed) SAMUEL SOLOMON. [L. s.]

UNITED STATES OF AMERICA,

*Southern District of New York,*

*State of New York, County of New York, ss:*

Samuel Solomon, being duly sworn, deposes and says: That he resides at No. 44 Division Street, in the Borough of Manhattan, City of New York; that he is a resident of and freeholder within the State of New York, and is worth the sum of One Thousand Dollars, over and above all the debts which he owes or has incurred, and exclusive of property exempt by law from levy and sale under execution.

(Signed) SAMUEL SOLOMON.

Sworn to before me this 15th day of January, 1909.

[SEAL.]

ISADOR DOBROEZYNSKI,  
*Notary Public, New York County.*

UNITED STATES OF AMERICA,

*Southern District of New York,*

*State of New York, County of New York, ss:*

On this fifteenth day of January, 1909, before me personally appeared Mark Jacobs and Samuel Solomon to me known and known to me to be the individuals described in and who executed the foregoing instrument, and they severally acknowledged to me that they executed the same.

[SEAL.]

ISADOR DOBROEZYNSKI,  
*Notary Public, New York County.*

Bond approved subject to right of plaintiff to except to sufficiency.

H. G. WARD, *U. S. J.*

Jan. 16, '09.

(Endorsed:) Supreme Court of the United States. Joseph Beecham, Appellee, against Mark Jacobs, Appellant. Bond. Weill & Weill, Attorneys for Appellant, 53-63 Park Row, Borough of Manhattan, New York City. Copy of within bond rec'd Jan. 16 '09. Gould & Wilkie. United States Circuit Court of Appeals, Second Circuit. Filed Jan. 16, 1909. William Parkin, Clerk.

UNITED STATES OF AMERICA,  
*Southern District of New York, ss:*

I, William Parkin, Clerk of the United States Circuit Court of Appeals for the Second Circuit, do hereby Certify that the foregoing pages, numbered from 1 to 106 inclusive, contain a true and complete transcript of the record and proceedings had in said Court, in the case of Joseph Beecham against Mark Jacobs as the same remain of record and on file in my office.

In Testimony Whereof, I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, in the Second Circuit, this 19th day of January, in the year of our Lord One Thousand Nine Hundred and Nine and of the Independence of the said United States the One Hundred and thirty-third.

[Seal United States Circuit Court of Appeals, Second Circuit.]

WM. PARKIN, *Clerk*.

UNITED STATES OF AMERICA, *ss:*

To Joseph Beecham, Greeting:

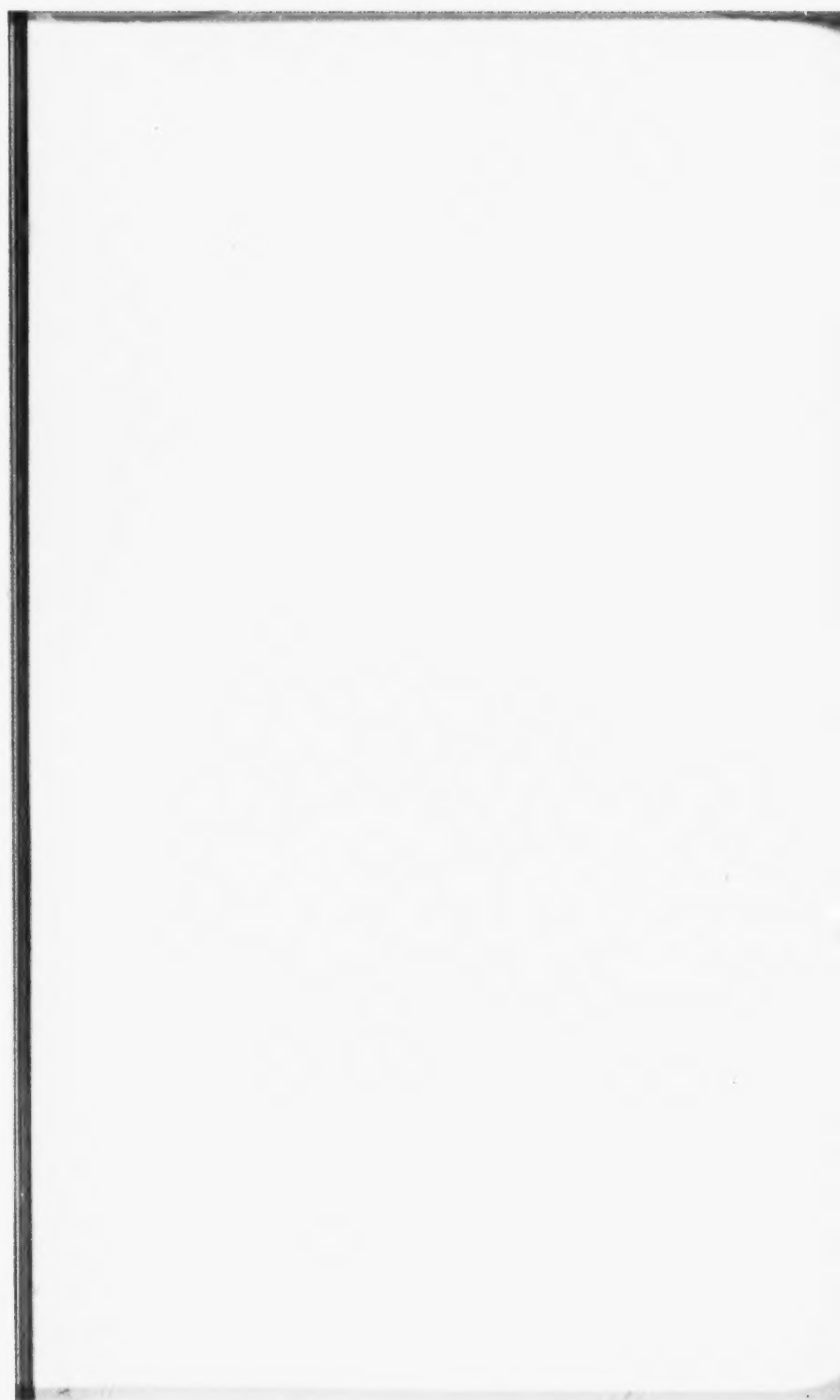
You are hereby cited and admonished to be and appear before the Supreme Court of the United States at Washington, District of Columbia, on the 15th day of February, 1909, pursuant to a petition of appeal filed in the Clerk's Office of the United States Circuit Court of Appeals, for the Second Circuit, wherein Mark Jacobs is appellant and Joseph Beecham is appellee, to show cause, if any there be, why the decree in said suit mentioned should not be corrected, and speedy justice should not be done in that behalf.

Dated New York, January 16th, 1909.

H. G. WARD,  
*United States Circuit Judge.*

[Endorsed:] Supreme Court of the United States. Joseph Beecham, Appellee, against Mark Jacobs, Appellant. Original. Citation. Weill & Weill, Attorneys for Appellant, 53-63 Park Row, Borough of Manhattan, New York City. Copy of within citation rec'd Jan. 16/09. Gould & Wilkie. United States Circuit Court of Appeals, Second Circuit. Filed Jan. 16, 1909. William Parkin, Clerk.

Endorsed on cover: File No. 21,498. U. S. circuit court of appeals, 2d circuit. Term No. 702. Mark Jacobs, appellant, *vs.* Joseph Beecham. Filed January 28th, 1909. File No. 21,498.



**FILED.**

**MAR 18 1911**

**JAMES H. McKENNEY,**  
CLERK.

**Supreme Court of the United States.**

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**OCTOBER TERM 1910, No. 139.**  
**(Formerly October Term 1908 No. 702)**

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**MARK JACOBS,**  
*Appellant (Defendant),*

**VS.**

**JOSEPH BEECHAM,**  
*Appellee (Complainant).*

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**APPEAL FROM THE UNITED STATES CIRCUIT  
COURT OF APPEALS FOR THE SECOND CIRCUIT.**

**BRIEF IN BEHALF OF APPELLANT.**

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**GEORGE F. HURD,**  
**MAX J. KOHLER,**  
**MOSES WEILL,**  
**ISAAC WEILL,**  
**CORNELIUS W. WICKERSHAM,**  
*Counsel for Appellants.*





# Supreme Court of the United States.

MARK JACOBS,  
Appellant-Defendant,

vs.

JOSEPH BEECHAM,  
Appellee-Complainant.

October Term,  
1910.  
No. 139.

## **APPELLANT'S BRIEF IN FAVOR OF THE APPEAL.**

### **Statement of Facts.**

This is an appeal from a judgment and decree of the United States Circuit Court of Appeals for the Second Circuit, affirming the final decree of the United States Circuit Court for the Eastern District of New York. The complainant (appellee) obtained an injunction in the said last named court prohibiting appellant from using the word "Beecham" in connection with certain pills manufactured and sold by him (Record, pp. 81 to 82, 87 to 89). Complainant brought suit for alleged infringement of trademark, the jurisdiction of the Circuit Court being dependent upon diversity of citizenship by reason of complainant's alienage and upon the Federal statute authorizing registration of trademarks, both of which are pleaded in the com-

plaint (Record, pp. 1, 3 and 4). The grounds upon which the injunction was granted were that appellant was illegally infringing appellee's alleged exclusive right to use the name "Beecham" in connection with pills manufactured and sold by him (Record, p. 81).

The facts disclosed by the record may be briefly summarized as follows: Appellee for many years, and his father, Thomas Beecham, before him, has been engaged in conducting the business of the manufacture from a secret formula, advertising and selling of pills for internal use, which they have termed "Beecham's" (Record, pp. 32, 34, 35, 39, 40, 43), thus establishing the designation by which, and by which only, pills made from this formula have been known to the public (Record, pp. 2, 3, 18 and 19). His trade and business have grown, and although originally conducted in England, an extensive business has been built up in the United States, where in many large communities, Beecham's Pills are well known (Record, p. 38). In 1895 complainant's father assigned his rights to complainant, who thereupon appears to have assumed sole charge (see Record, pp. 52, 67-70). The pills have for several years been sold in twenty-five and ten cents size boxes, on the labels of the former of which appears the word "patent," as a part of the name "Beecham's Patent Pills" (Record, pp. 63, 64, 34, 35). The appellee had no patent thereon, nor had he at the time of the commencement of this suit (Record, pp. 51 and 53). The pills were of a peculiar make and were advertised as effective in curing certain classes of ills.

About the year 1904, appellant having learned that the pills were not patented and the various other facts set forth above, commenced the manu-

facture and sale of similar pills. He sold the pills in boxes, on the top of which were pasted circular labels containing the words "Beecham (price 25 cents) Pills Manufactured and Sold by Mark Jacobs, Maspeth, L. I., N. Y., U. S. A." (Record, pp. 5, 19).

The attention of the Court is also called to statements in complainant's circulars and labels. Between the years 1888 and 1893, and from 1899 to 1902 complainant's circulars stated that the pills were made by *Thomas Beecham*, St. Helens, Lancashire, England (Record, pp. 71, 73 and 36). The name of Thomas Beecham was used on circulars from 1902 to 1906, and on labels in use at the time of the trial (Record, pp. 73, 74, 75, 79, 80, 36, 64, 35, and see Complainant's Exhibit VI, p. 64). One circular stated that the pills were prepared and sold by Joseph Beecham, St. Helens, England, and Canal Street, New York, and that "The pills accompanying this pamphlet are specially packed for U. S. America" (Record, p. 65). A label in use at the time of the trial sets forth that the pills are sold by "The Proprietor, St. Helens, Lancashire, England" (Record, pp. 63, 34, 3); while another contains the words "Beecham's Patent Pills, St. Helens, Lancashire," and "Beecham's Pills, Saint Helens" (Record, pp. 64, 34-5, 3). In fact the pills sold in the United States were made in Brooklyn, New York (Record, pp. 32, 33, 34, 40, 47, 48), a condition apparently existing since about 1890 (*id.*). After 1895 they were not made by *Thomas* but by *Joseph Beecham* to whom his father had assigned the business (Record, p. 52, and Complainant's Exhibit XI, Record, pp. 67-70).

More than one, and at least five, thousand dollars

is concededly involved in the present controversy (Record, pp. 8, 43).

The errors complained of by appellant are the following: that an injunction was granted, rendered final and confirmed whereby appellant was restrained from using the word Beecham in connection with any pills made by him, and from selling such pills under the label described above; that the bill of complaint was not dismissed and an injunction refused because of complainant's use of the word "patent" in "Beecham's Patent Pills" the phrase used by complainant on his boxes and circulars, and because of complainant's representations that his pills were prepared in England, when in fact made in Brooklyn, New York, and the continued use of the name, Thomas Beecham, after the assignment of 1895; that it was not found that complainant had no exclusive right to manufacture the pills or to the use of the descriptive name "Beecham," because used in connection with an unpatented article or for other reasons, and in failing to dismiss the bill of complaint therefor; that it was not found that defendant had a right to manufacture the pills and designate them as Beecham's Pills, manufactured by himself; that it was not found that the rights contended for by complainant were *publici juris*, or that complainant was not in a position to enforce those rights had he exclusively possessed them; that the decree of the Circuit Court was affirmed by the Circuit Court of Appeals; that the Circuit Court of Appeals refused to hold that, as matter of law, the rights contended for by appellee were *publici juris*, or that appellee, because of false statements on his labels and circulars, was not entitled to equitable relief; and the other errors set forth in appellant's assignment of errors (Record, pp. 90-92).

## POINT I.

**The right to use the name Beecham is publici juris, and, defendant is not guilty of unfair competition.**

The injunction restrains the appellant from using the name "Beecham" in connection with any pills sold by him. Appellant is thereby prevented from describing as "Beecham" *even pills made in accordance with the unpatented Beecham process*. The gravamen of the suit is not that appellant was selling pills marked "Beecham" which were inferior to appellee's pills, or were not made from his formula, of which there is no evidence in the record, but that the use of the name itself constituted an infringement of appellee's alleged trademark or trade right. The decree in its present form can be justified only upon the theory that the complainant was possessed of a valid trademark in the name "Beecham" which defendant was infringing, or that appellant's use of the name was such as to warrant relief on the grounds of unfair competition. We submit that neither of these grounds existed.

(a) *Appellee has no trademark.*

It is a well settled and often repeated maxim of trademark law that a trademark to be valid must be exclusive, and exclusiveness in the right of user of a generic term, such as a geographical or proper name, is impossible in the nature of things. Particularly is this so in the case of a proper name.

The large probability always, and the actuality often, exists that a number of persons bear the same name, whose right to its use cannot be denied. In addition, any person may change his name, and his common law right to adopt any other name he sees fit is well recognized. The principle upon which relief in such cases can be afforded is therefore not one of any trademark doctrine, since there can be no trademark in a proper name, but the broader grounds of unfair competition.

Canal Co. v. Clark, 13 Wall., 311;  
 Brown Chemical Co. v. Meyer, 139 U. S.,  
 540;  
 Corbin v. Gould, 133 U. S., 308;  
 LeClanche Battery Co. v. Western Elec.  
 Co., 23 Fed. Rep., 276;  
 Hopkins on Trademarks, 2nd Ed., Sections  
 53, 40.

(b) *No unfair competition has been shown.*

The law says in effect that a person may not use the name of another in a manner calculated to deceive the public with respect to the latter's business, or other rights. Relief may be granted, therefore, where defendant uses the name in connection with inferior or dissimilar goods, or employs it in such manner as to deceive the public into a belief that the goods are those of the original owner or discoverer or his assignee.

Neither of these facts existed in the case at bar. There is no evidence that defendant's pills were inferior or dissimilar to complainant's. The burden of proving such inferiority or dissimilarity, had it existed, was on complainant-appellee, and

in the absence of evidence thereon an injunction granted upon that ground would be unwarranted.

Baglin v. Cusenier Co., 164 Fed., 25 (the Chartreuse case, C. C. A., 2nd Cir.);  
 Hostetter Co. v. Comerford, 97 Fed., 585;  
 Goodyear's India Rubber, Etc., Co. v. Goodyear Rubber Co., 128 U. S., 598, 604;  
 LaMont v. Leedy, 88 Fed., 72.

In fact, the only evidence on this point disclosed by the record tends to support what was the actual state of affairs, namely, that the appellant's and appellee's pills are, to all intents and purposes, the same, and made in accordance with the same formula (Record, pages 3, 5, 15, 18 to 19, and the boxes of both parties' pills, put in evidence, Record, pages 70, 52, 53, 67, 38 to 39).

Nor can it be argued that appellant has used the name "Beecham" in any manner whatever calculated to deceive the public into a belief that the goods offered for sale by him are those of the appellee. Both pleading and proof show that the defendant sold pills designated as *Beecham Pills, manufactured by Mark Jacobs, Maspeth, L. I., N. Y., U. S. A.* (Record, pages 5, 19, and Complainant's Exhibit XII). The label used by the appellant is shown on the box filed with the Clerk of this Court and marked Complainant's Exhibit XII. The appellant's name and place of manufacture are printed in bold type and in a conspicuous position. There can be no claim that the ordinary eye would miss them, or that the name "Beecham" predominated so greatly over the other words as to reduce them to insignificance and perpetrate a practical fraud on the public.

The appellee's claim therefore must be, as it in fact is, that the use of the name "Beecham" by appellant in connection with the manufacture and sale of his pills, although not such as to induce a popular belief that appellant was the original manufacturer, and although the evidence tends to show that appellant's pills were made from appellee's formula, constituted unfair competition.

This contention disregards the rule repeatedly laid down by the courts that if a secret process is unpatented, any one may use it and enter into competition with the original discoverer.

The rule does not extend to the case of one who came by the knowledge through, or employs it by means of breach of contract or fiduciary relation, or other fraud, but there is no evidence of either of these in the case at bar. The right to use the only name descriptive of the product is co-extensive with the right to manufacture, since otherwise the product would be unmarketable except in the hands of the inventor or his assignee, and the right to manufacture practically worthless. But the argument goes still further, for if complainant's contentions are law, the owner of an unpatented secret process can, by attaching his name to the product, establish a monopoly in perpetuity. The patent and trademark laws, which were not enacted in contemplation of a common law right greatly more effective, would immediately fall into desuetude. Congress has expressly limited the period of protection to a term of years, whereas the right claimed by respondent is everlasting, and if allowed would sanction the creation of an indefinite monopoly, dependent solely on his use of a proper name. Such a doctrine fosters the establishment of new and hitherto unknown monopolies, giving



protection unwarranted by the patent laws. As said by Vice Chancellor Plumer in *Canham v. Jones*, 2 Vesey & B., 218: "If this claim of monopoly can be maintained, without any limitation of time, it is a much better right than that of a patentee." The right of the public to manufacture the product, expressly upheld by all the authorities would be thereby destroyed, despite the fact that the name is the only name descriptive of the article, and the use fair and without deceit. To grant complainant's premise is to admit the right, and at once destroy it.

The principles here involved were recently passed on by this Court in

Saxlehner vs. Wagner, 216 U. S., 375,

decided in February, 1910. The petitioner was the owner of Hungarian wells from which was produced mineral water known throughout the world as Hunyadi Janos the arbitrary name given by the petitioner's husband. Respondents made a bitter water at one time labeled "W. T. Wagner's Sons Artificial Hunyadi Janos. Ofen Bitter Water. Highly aerated," and later "W. T. Wagner's Sons Carbonated Artificial Hunyadi conforming to Fresenius Analysis of Hunyadi Janos Springs." It was held that the right to use the name was not exclusive, and that respondents could not be prevented from manufacturing the water and designating it Hunyadi—the truth as to manufacture being expressly stated in the labels. The Court said, through Mr. Justice Holmes, at page 380:

"We see no reason for disturbing the finding of the Courts below that there was no unfair competition and no fraud. The real in-

tent of the plaintiff's bill, it seems to us, is to extend the monopoly of such trademark or trade-name as she may have to a monopoly of her type of bitter water, by preventing manufacturers from telling the public in a way that will be understood what they are copying and trying to sell. But the plaintiff has no patent for the water, and the defendants have a right to reproduce it as nearly as they can. They have a right to tell the public what they are doing and to get whatever share they can in the popularity of the water by advertising that they are trying to make the same article and think that they succeed. *If they do not convey, but, on the contrary, exclude the notion that they are selling the plaintiff's goods, it is a strong proposition that when the article has a well-known name they have not the right to explain by that name what they imitate.* By doing so they are not trying to get the good will of the name, but the good will of the goods. See *Flagg Manufacturing Co. vs. Holway*, 178 Massachusetts, 83, 91; *Chadwick v. Covell* 151 Massachusetts, 190, 191. Although the application is different, the principle seems to be similar to the rule that when a patent has expired descriptive words or even an arbitrary or personal name by which it has become known may be used if sufficient precautions are taken to prevent the public from being deceived. See *Singer Manufacturing Co. v. June Manufacturing Co.*, 163 U. S., 169."

The subsequent paragraph of the opinion takes up the petitioner's claim to the ownership of a trademark, which is denied on the grounds that the expression had become geographical, and was generic as in the present case. The real issue was whether the facts disclosed a case of unfair competition; and the Court reaffirmed the principle established by several State Courts in the decisions

hereafter discussed that where no patent exists and defendant states the truth as to the manufacture of the particular goods offered for sale, so as to exclude the notion that he is selling the goods of someone else, the use is neither fraudulent nor unfair.

The doctrine announced in the Hunyadi case finds ample support in the earlier decisions of the State Courts, several of which were based on facts practically identical with those in the case at bar.

In the leading case of *Chadwick vs. Corell*, 151 Mass., 190, a claim was made to the exclusive right to manufacture certain medicines under a secret process and to call them "Dr. Spencer's Queen of Pain," the name given by the original discoverer. In deciding against the claim Mr. Justice Holmes, writing the opinion of the Court, said at page 191:

"So far as the right to manufacture and sell the medicine goes, the plaintiff's case may be disposed of in a few words. Dr. Spencer had no exclusive right to the use of his formulas. His only right was to prevent anyone from obtaining or using them through a breach of trust or contract. Anyone who came honestly to the knowledge of them could use them without Dr. Spencer's permission and against his will.  
\* \* \* The defendant got his knowledge honestly, and therefore has a right to make and sell medicines.

Having the right to make and sell medicines, the defendant has a right to signify to the public that the medicines are made according to the formulas used by Doctor Spencer."

In *Watkins vs. Landon*, 52 Minnesota, 389, it was held that the transferee of the inventor of an unpatented secret medicine called "Doctor Ward's Liniment" could acquire no exclusive right to the

name or to the manufacture of the article, the Court saying:

"This preparation *never having been patented* and \* \* \* these defendants having lawfully and fairly acquired knowledge of its composition, they have the legal right to manufacture and sell it following Ward's formula. \* \* \* *They may too by label or otherwise, publish the truth that their compound is made in accordance with Ward's formula, and this may be by formal statement to that effect or by more brief terms of similar import, such as those, which, by the decision under review, the defendants are permitted to employ, viz.: 'Doctor Ward's Liniment manufactured and sold by Landon & Burchard.'*" (Italics ours.)

And again:

"The name has thus practically come to be one *descriptive* of this preparation, and having acquired that quality the plaintiff had no right to withdraw it from further use by Sands or by any other person who might lawfully manufacture the same liniment and *appropriate it to his own exclusive use, so as to give him a practical monopoly in the sale of the preparation which he had no exclusive right to make or sell.* *Canal Co. vs. Clark*, 13 Wall., 311; *Stachelberg vs. Ponce*, 128 U. S., 686, etc." (Italics ours.)

This principle is also upheld in

*Marshall v. Pinkham*, 52 Wis., 572;;  
*Park & Sons Co. v. Hartman*, 153 Fed.  
 Rep., 24, 29, 32 to 33;  
*Singleton v. Bolton*, 3 Douglas, 293;  
*Canham v. Jones*, 2 Vesey & B., 218;

Burgess *v.* Burgess, 17 Eng. L. & E., 257;  
James *v.* James, L. R., 13 Eq. Cas., 421;

and

Massam *v.* Thorley's C. F. Co., 6 Ch. Div.,  
574.

The decision of Malins, V. C., in *Massam v. Thorley's C. F. Co.*, *supra*, is equally illuminating:

"Any person who has become acquainted with the process of manufacturing an article which is in general secret, is entitled to manufacture it; and if the name of the first manufacturer has become attached to the article, any person afterwards manufacturing is entitled to describe it by the name of such original manufacturer" \* \* \*. (Headnote.)

A similar result has been reached where the secret process or formula was originally protected by Letters Patent, but the patent has expired.

In *Singer Company v. June*, 163 U. S., 169, Mr. Justice WHITE, giving the opinion of the Court, said, at page 185:

"It is self evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. \* \* \*. It equally follows from the cessation of the monopoly and the falling of the patented device into the domain of things public, that along with the public ownership of the device there must also necessarily pass to the public the *generic designation of the thing*, which has arisen during the monopoly in consequence of the designation having been acquiesced in by the owner either tacitly by accepting the benefits of the monopoly, or expressly by his having so connected the name

with the machine as to lend countenance to the resulting dedication. \* \* \*

*"The public having the right, on the expiration of the patent, to make the patented article and to use its generic name, to restrict its use either by preventing its being placed upon the articles when manufactured or by using it in advertisements or circulars would be to admit the right and at the same time destroy it.*

"It follows, then, that the right to use the name in every form passes to the public with the dedication resulting from the expiration of the patent.

"Nor is this right covered by different principles where the name, which has become generic instead of being an arbitrary one, is the surname of the patentee or original manufacturer. It is elementary that there is a right of property in a name which the courts will protect. But this right, like the right to an arbitrary mark or any other may become public property by dedication or abandonment."  
(Italics ours.)

The only distinction between the cases where no patent ever existed, and where a patent has expired is in the method by which the right is obtained—in the one case by dedication, and in the other by the acquisition of knowledge of the secret. The resulting right is the same, as was intimated by this Court in the Hunyadi case, *supra*, at page 381.

The case of *Fowle v. Park*, 131 U. S., 88, is distinguishable, since the knowledge was there acquired in confidence and the basis of the decision was the fiduciary relationship thus established.

It is accordingly submitted that the complainant has no exclusive right to the manufacture and sale

of these pills, nor to the use of the word "Beecham" in connection therewith; that the said word being generic and the only designation of the product, is open to use by anyone who engages in the business of manufacturing and selling this commodity, care being taken to state by whom it is in fact manufactured, and that as appellee has failed to prove either that appellant has attempted or threatens to attempt to deceive the public into a belief that his goods were those of appellee, or that appellant's pills were not made from the same formula or process, the decree cannot stand. In any event, the decree should be modified so as to permit the use of the name "Beecham" by appellant in connection with the manufacture and sale of pills made from the appellee's formula. These points were duly raised below (Answer, Record, pages 18 and 19; assignment of errors, page 83, 3rd, 4th, 10th, 11th, 12th and 16th; and pages 90 to 92 *Idem.* and No. 21).

## POINT II.

**The false use of the word "patent" disentitles complainant to equitable relief.**

The complainant's boxes of the twenty-five cents size are admittedly marked as follows: "Beecham's Patent Pills, Price twenty-five cents. Sold by the Proprietor, St. Helen's, Lancashire, England." (Record, p. 4).

The complainant concedes, however, that he had no patent in connection with the pills (Record, p.

53). The following appears from the testimony (Record, p. 51, fourth and fifth questions and answers) :

“Q. These pills are not patented? A. No, sir.

Q.. Never were patented? A. Not to my knowledge.”

It is stated in the assignment of 1895 from Thomas Beecham to Joseph Beecham that the parties were the proprietors of a patent in connection with their business (Record, p. 69, fol. 274). It is therefore possible that at one time the Beechams had a patent for the pills; possibly a patent for the manner of coating them, or for some other mechanical detail. But whatever the conflict of evidence on this point, the important fact is that at the time the present action was commenced, and for some time prior thereto, complainant, Joseph Beecham, used the word “patent” in connection with his pills, although he had no patent upon or in connection with them.

It is a well settled principle of equity that he who invokes the aid of the equitable power of the Court must come into equity with clean hands. If, in the very matter of which a suitor complains, he has himself been guilty of fraud, deceit or concealment, he is not entitled to relief in a court of conscience. The principle has heretofore been applied in contentions arising out of the use of an alleged trade name. Even if the exclusive right exists for which appellee contends the record shows he has so abused it that the door of equity is no longer open to him. This, and other courts have heretofore decided that the false use of the word “patent”



in connection with a trade name is a complete defense to a suit to enjoin infringement thereof.

*Holzappel's v. Rahtjen's Co.*, 183 U. S., 1;

*Oliphant v. Salem Flouring Mills*, 5 Sawyer, 128;

*Consolidated v. Dorflinger*, Fed. Cas. No. 3, 129;

*Leather Cloth Co. v. Am. Leather Cloth Co.*, 11 H. L. Cas., 523.

The Circuit Court of Appeals recognized this. "It thus appears that the complainant employs the word "Patent" in connection with pills which are not patented. If such use of the term amounts to a representation that the pills are manufactured under Letters Patent, the complainant, by such false assertion, is precluded from relief in equity." (Record, p. 88.)

But the Court refused to apply the doctrine, holding that complainant's assertions were not misrepresentations.

In rare cases the word "patent" in certain combinations has been employed by merchants and the public in a different sense. Where, perhaps, originally used to denote that the accompanying article was protected by Letters Patent, the term has, through general usage, come to describe primarily the article itself. The best known instance is that of an enamelled leather always spoken of as patent leather. The general public has become accustomed to speak of certain shoes as patent leather shoes; using the word "patent" in a descriptive sense. But in the present case it is the word "Beecham" and not the word 'patent' which describes the particular

commodity. As 'Beecham' the pills are known to and bought by a very large number of people throughout the United States, to whom the word 'Beecham' describes a kind of pill, which, unknown by any other name, is believed effective in the cure of certain maladies. The word 'patent' adds nothing to the description—has no descriptive force. Nor is any specific article designated by the term 'patent pill'. These facts are a matter of common knowledge. Jones' Patent Leather Shoes and Smith's Patent Leather Shoes convey the same idea of the commodity; Beecham's Patent Pills and Robinson's Patent Pills do not.

Complainant contends that the case of certain patent medicines is peculiar, in that to some persons the word 'patent' implies ownership of a secret process. However much this may be so in the minds of the manufacturer and vender, it is rarely so in the minds of the public, and not shown to be so here. The venders and manufacturers sometimes believe they are entitled to use the word in a proprietary sense. The question is not what they believe, but whether or not the assertions mislead or are calculated to mislead the public. And the proper test seems to be the reasonable and probable construction which the public would be apt to place upon them.

*Worden vs. California Fig Syrup Co.*, 187  
U. S., 516.

To the reasonable man of average intelligence the word suggests that the compound is a discovery protected by Letters Patent. Probably the majority of people who have heard of or who use patent

medicines believe them to be patented. The records of the Patent Office undoubtedly show that thousands of patents were granted for medicines, and thousands for pills. These could properly be designated as patent medicines or patent pills, and so described have been sold in countless numbers. Had the truth been that the word "patent" in Beecham's Patent Pills was understood by the public in general in either the descriptive or proprietary sense, the burden of proving it was on complainant, and this he has failed to do.

See *Oliphant v. Salem Flouring Mills*, 5 Sawyer, 128, discussed hereafter.

In *Holzappel's Composition Company v. Rahtjen's American Composition Company*, 183 U. S., 1, A had an English patent on a certain kind of paint used for protecting ships' bottoms. It was of a peculiar manufacture, and known among shipping men as Rahtjen's. After the expiration of the English patent A continued to sell the paint in the United States under the same trade-mark, which had been registered and which read "Rahtjen's Patent Composition." The defendant manufactured a paint which it called "Original Rahtjen's Composition for Ship's Bottoms," and announced in its prospectus and other publications that he sold "Original Rahtjen's Composition for Ship's Bottoms." *Held*, that the complainants had proved no valid trade-mark, that no right to a trade-mark which includes the word "patent" can arise where there is no patent, that the only words which were descriptive of the composition were "Rahtjen's Composition," that that had become a symbol, and the only symbol, of the particular kind of paint, and that on the expiration of the patent it became public property and might be used by anyone. The Court said, p. 8:

"No right to a trade-mark which includes the word 'patent,' and which describes the article as 'patented' can arise when there is and has been no patent, nor is the claim a valid one for the other words used where it is based upon their use in connection with that word. A symbol or label claimed as a trade-mark, so constituted or worded as to make or contain a distinct assertion which is false, will not be recognized, nor can any right to its exclusive use be maintained. *Manhattan Medicine Company v. Wood*, 108 U. S., 218, 225; *Wrisley Co. v. Iowa Soap Co.*, 104 Fed., 548. \* \* \* (p. 9). During its whole existence the name (Rahtjen's Composition) had been given to the article, and that was the only name by which it was possible to describe it. \* \* \* Of necessity when the right to manufacture became public, the right to use the only word descriptive of the article manufactured became public also. \* \* \* (p. 10.) There was no other name for the article, and in order to obtain it a person would have to describe it by the words 'Rahtjen's Composition.' The words thus became public property descriptive of the article, and the right to manufacture it was open to all by the expiration of the English patent. \* \* \* (p. 13). We think the principle which prohibits the right to the exclusive use of a name descriptive of the article after the expiration of a patent covering its manufacture applies here."

Because of complainant's previous patent there was room for argument that the word was used in its proprietary sense. It is said in 28 Am. & Eng. Encyc. L., 356, "The word 'patent' may be used, however, in such a manner as not to convey the meaning that the article is subject to the control of a patent, but only that the design is that of a

certain patent or patentee, the patent for which may have expired." Citing *Solez Cigar Co. v. Pozo*, 16 Colo, 388; and *Ford v. Foster*, L. R., 7 Ch., 611.

But the statement must be so framed as to expressly or by clear implication convey to the ordinary reader its true meaning.

*Cheavin vs. Walker*, 5 Ch. Div., 850.

Such a statement as that in the Rahtjen's case, or here, fails to do so, and is therefore not within the principle stated. Again the word "patent" was no more descriptive than in the present case, thus differing from patent leather shoes.

In *Preservaline Manufacturing Company vs. Heller Chemical Company*, 118 Fed. Rep., 103, Judge Kohlsaat denied relief where the complainant had had a patent which had expired, and continued to describe the article as patented. The Court said:

"It therefore remains only to determine whether complainant comes within the rule of courts of equity denying relief. The reason for such rule seems to be that *any use of the terms 'patent' or 'patentee,' which will cause the public to believe that a particular article is patented must necessarily have a tendency to deter individuals from the manufacture or handling of such article.* The result of this will be to stifle competition and to extend the monopoly granted by the patent beyond the term of such grant. \* \* \* The use of fraudulent matter in any considerable part of the advertising media tinges the whole with that fraud upon which equity looks with disfavor. *The natural effect of the language used upon the five circulars attached to complainant's bill is to mislead and deceive the public, and*

*complainant cannot be heard to deny the imputation of so doing.* (Italics ours.)

Section 4901 of the Revised Statutes of the United States provides that every person who, for the purpose of deceiving the public employs "patent" or any word importing that the article is patented when such is not the fact, shall be liable for each offense to a penalty of \$100.

Sound public policy also requires that a substituted meaning of the word, and the creation of false impressions by owners of unpatented secret processes, should not be countenanced by the courts. The signification of a true use can be maintained only if designation for other purposes is condemned.

The English Courts have established a similar doctrine.

In *Cheavin v. Walker*, 5 Ch. Div., 850, the plaintiff, and one S. Cheavin had owned a patent for improvements in filters. S. Cheavin died and some years afterwards the patent expired, but plaintiff continued to manufacture and sell filters under the title "G. Cheavin's Improved Patent Gold Medal Self-Cleaning Rapid Water Filters." The defendants sold filters described "S. Cheavin's Patent Brass Metal Self-Cleaning Rapid Water Filters, improved and manufactured by Walker, Brightman & Co." The Court of Appeal, in reversing the decision of the Vice-Chancellor, who had granted an injunction said (JESSEL, M. R.):

"No doubt a man may use the word 'patent' so as to deceive no one. It may be used so as to mean that it was a patent, but is not so now. In other words, you may state in so many words or by implication that an article is

manufactured in accordance with a patent which has expired, but if you suggest that it is protected by an existing patent you cannot obtain the protection of that representation as a trademark. \* \* \* \* (To do so) would be \* \* \* extending the time for protection given by the statute. \* \* \* But further no man can claim a trademark in a falsehood. It is a falsehood to represent that the patent is still subsisting. \* \* \* I cannot see any fraudulent motive in *defendant's* labels. The defendant's label is (setting it forth as above) \* \* \* *that is to say, that the filter is manufactured according to Cheavin's expired patent by Walker, Brightman & Company. I can see no fraudulent motive in that statement.*" (Italics ours.)

As in the case at bar, complainant relied on a secret process, and defendant used the name given to the article by the discoverer of the invention, adding however, that it was manufactured by themselves. Of this situation the English Court says, "I can see no fraudulent motive in that statement." JAMES, L. J., said:

"It is impossible to allow a man to prolong his monopoly by trying to turn a description of the article into a trademark. *Whatever is mere description is open to all the world. In the present case the plaintiff's label was nothing more than a description, and he cannot, therefore, have protection for it as a trademark.* \* \* \* In my opinion nobody would suppose that it was manufactured by the plaintiff. The defendants expressly and very plainly say that it is manufactured by Walker, Brightman & Company. The truth is that the case really made by the plaintiff is not that the defendants pretend that filters are made by him, but

that they allege that they are made under Cheavin's patent, *to which the plaintiff has no right to object.*" (Italics ours.)

BAGGALLY, L. J., said:

*"An ignorant person would suppose that the article was protected by the patent—that is a sufficient ground for refusing the plaintiff relief."*

The use of the words "Patent Medicine" in connection with unpatented medicinal compounds appears to have been condemned in England in

Pharmaceutical Society v. Piper, (1893),  
L. R., 1 Q. B., 686,

where the term as used in a medicine stamp tax act was held to mean a medicine protected by Letters Patent.

See also David Fulton on Patents, Trade-Marks and Designs (London, 1902), p. 188.

There is no evidence that the appellee's product is known as a patent medicine in the sense contended for. *Whether a certain article is commonly known as or understood to be a proprietary compound, and the word "patent" as indicative of ownership or property, is a question of fact, and the record contains no evidence whatever that the plaintiff's product was so known.* The use of the word "patent" in connection with an unpatented article raises the presumption that the use is fraudulent. (See *Oliphant v. Salem Flour-*



ing *Mills Co.*, 5 Sawyer, 128.) This presumption the respondent has signally failed to rebut.

It is said in *Oliphant vs. Salem Flouring Mills*, 5 Sawyer, 128, 130.

"The word 'patent' upon an article is *prima facie* an assertion that it has some peculiar value or merit sufficient to induce the Government, upon a thorough examination of the subject, to give the inventor the exclusive right to make and vend the same. The impression which the fact ordinarily makes upon the mind is that the article marked 'patent' is in some respects more useful or desirable than articles of the same general kind or use which are not so marked.

"If, then, a person marks an unpatented article with the word 'patent', the public are thereby liable to be deceived as to the character and value of the article. The act is a species of counterfeiting. This being so, the presumption is, until the contrary appears, that the mark was placed upon the article with the intention to deceive \* \* \* (p. 131). From this it appears that the law applies to all unpatented articles, *whether patentable or not*, for the plain reason that the public should not be prevented from exercising their undoubted right to use unpatented articles by the false and maybe corrupt assertion of anyone, that they are patented." (Italics ours.)

It is said in *Consolidated vs. Dorflinger*, 6 Fed. cas., p. 340, Case No. 3129:

"Another objection to the complainants' bill, \* \* \* is, that *no title* can be successfully asserted in a trade-mark which is of a tendency to mislead or deceive the public. This objection may avail a defendant, notwithstanding what would other-

*wise be imputable to him as misconduct. The doctrine is, that the complainant must come into a court of equity with clean hands (4 de Gex, J. & S., 149). \* \* \* The direct application of the objections appears when we consider that the alleged trade-mark in question tends rationally to induce a belief that the subject of it is a securely patented invention*  
\* \* \*

In this case (referring to Leather Cloth Co. vs. American Leather Cloth Co., 11 H. L. C., 523), Lord Kingsdown said:

"If a trade-mark represents an article as protected by a patent, when in fact it is not so protected, it seems to me that such a statement *prima facie* amounts to a misrepresentation of an important fact, *which would disentitle the owner of the trade-mark to relief in a court of equity against any one who pirated it.*" (Italics ours.)

In the last mentioned case Lord Kingsdown also said:

"I cannot think that it can make any difference whether the protection never existed or has ceased to exist."

It appears that complainant has been guilty of deceiving the public, and that he now attempts to wash the stain of unconscionable conduct from his hands by a denial of misrepresentation. The case is unlike that of patent leather shoes, because the word "patent" as used by him is not descriptive. He cannot shield himself by claiming a so-called patent medicine, for there is no such specific article as a 'patent pill'—the term is general; and to the majority of the public the word immediately suggests manufacture under Letters

Patent—the common understanding in the case of patent medicines. For this reason, and because of lack of proof his so-called proprietary argument is unfounded. Finally he fails entirely in *proving* any public understanding opposed to the natural import of his words. Complainant should therefore be precluded from equitable relief.

### POINT III.

**The misrepresentation of manufacture in England, and the continued use of the name Thomas Beecham disentitle complainant to equitable relief.**

(1).

On the same principle of coming into equity with clean hands, a complainant who has deceived the public by a false statement in regards to the place of manufacture of his commodity is not entitled to relief in equity.

*Manhattan Medicine Co. v. Wood*, 108 U. S., 218.

In that case the Court said, p. 222:

“A court of equity will extend no aid to sustain a claim to a trademark of an article which is put forth with a misrepresentation to the public as to the manufacturer of the article and as to the place where it is manufactured, both of which particulars were originally cir-

cumstances to guide the purchaser of the medicine."

See also the words of this Court, speaking by Mr. Justice Shiras, in *Worden v. California Fig Syrup Co.*, *supra*, at page 528, of which the following seems peculiarly applicable here; "that where any symbol or label claimed as a trade mark is so constructed or worded as to make or contain a distinct assertion which is false, no property can be claimed on it, or in other words, the right to the exclusive use of it cannot be maintained."

The labels used by the appellee on the boxes in which his pills were sold at the time of the trial, and long used by him, bear the following statements: "Beechams Patent Pills, price 25 cents, sold by the Proprietor, St. Helens, Lancashire, England," and the words "Beecham's Patent Pills, St. Helens, Lancashire," and "Beecham's Pills, Saint Helens." In fact the pills are, and for many years have been made in Brooklyn, New York. The statement in appellee's circular, made a part of the bill of complaint by reference (Record, p. 3), that "The pills accompanying this pamphlet are specially packed for U. S. America," was held by the Circuit Court of Appeals to be not such a misrepresentation as would disentitle complainant to relief in equity, on the grounds that it merely *suggested* manufacture outside the United States (Record, p. 88). But the statement can have no other meaning. A person "specially packs" goods for delivery at some place at a distance from the place of making. In addition the pills were sold under *labels*, which, without stating in express words, that the pills are made in England,

contain simply the significant phrase "Beecham's Patent Pills, St. Helens, Lancashire," and the statement that they are sold by the proprietor, St. Helens, England. Equity will not be done, if a manufacturer is allowed to convey by direct implication what is prohibited if expressed. A court of equity regards the substance and not the form. To the ordinary buyer the labels convey the intelligence that the pills are made in England. If a person makes goods in America, is it truthful to state on the labels "Smith's goods, England," and in a circular that the goods are specially packed for U. S. America? We submit that "Beecham's Patent Pills, England," and "Beecham's Patent Pills, St. Helens, Lancashire," are untrue statements calculated to mislead the public, and constitute misrepresentations which disentitle complainant to the relief prayed.

In *Palmer vs. Harris*, 60 Penn., 156, plaintiff sued for infringement of a trade mark used in connection with the sale of cigars, the label consisting of a golden crown and the words "Fabrica de Tabacos de las Majores Vegas, de la Vuelta Abajo, Calle del Agua, No. 75, Habana," and the word "Habana," and below all and outside the border in very small letters a brief statement of entry in the office of the Clerk of the Southern District of New York. In fact the cigars were manufactured and sold in the City of New York. The Court held that the complainant's false statements precluded him from equitable relief, Sharswood, J., saying (p. 160):

"The party who attempts to deceive the public by the use of a trade mark, which contains on its face a falsehood as to the place where

"his goods are manufactured, in order to have  
 "the benefit of the reputation which said goods  
 "have acquired in the market, is guilty of the  
 "same fraud of which he complains in the de-  
 "fendant. He certainly can have no claim to  
 "the extraordinary interposition of a tribunal  
 "constituted to administer equity, for the pur-  
 "pose of securing to himself the profits aris-  
 "ing from his fraudulent act."

The notice of an entry as a copyright was held to make no difference because it was printed in such very small type as to escape ordinary observation, and in any event was not inconsistent with manufacture in Cuba.

As to the plaintiffs claim that the fact of the words being in Spanish neutralized the effect of the statements, the Court said, (p. 161) :

"It is contended further that the falsehood  
 "is in a foreign language, of which it is to be  
 "presumed that the plaintiff's customers are  
 "ignorant. *Yet there is certainly enough to*  
*"convey to everyone who can read that the*  
*"cigars are from Havana. \* \* \** it is not  
 "necessary that any one person has been ac-  
 "tually deceived or defrauded; it is enough  
 "that it is a misrepresentation, calculated to  
 "have that effect on the unwary and unsus-  
 "picious."

The decree refusing an injunction was affirmed, and the appeal dismissed.

In the same way there is certainly enough in Joseph Beecham's labels to convey to everyone who can read that the pills are still made in England, where the business was solely conducted until about 1890, particularly in view of the express statements on circulars used for years thereafter that the pills were prepared in that country.

So the sale of oysters under the title of "Anglo-Portugal," when in fact they did not come from Portugal, was held a false representation, although the commodity was none the less good for that reason.

Re Saunton & Co., Cox's Manuel, case 625.

Browne on Trademarks, (2d. Ed.), Sec. 71, p. 78.

In *Solez Cigar Co. v. Pozo & Suarez*, 16 Colo, 388, the Court in dismissing a bill based on defendant's infringement, held that where the word "Havana" was used in connection with cigars of which the filler only was Havana or Cuban tobacco, the user committed a fraud on the public.

P. 394. "On the trial of the case the Court denied the injunction, and placed the decision on the principal that, to entitle a complainant to the protection afforded by the exercise of equitable powers, the device which served to inform the public must be honest, *not only in its suggestions of place of manufacture*, and persons producing but in the statements of the composition and material of the product. The rule was accurately stated, and the only question is as to the applicability of the doctrine \* \* \*. (p. 397). The plaintiff admitted that the cigars sold under that brand were made of Havana filler, seed binder and Sumatra wrappers. Nothing but the filler came legitimately within the definition of Havana tobacco \* \* \*. It is evident that custom would not permit the trade to be deceived. Strict honesty was observed in all dealings with wholesale purchasers, but little attention was given to the opinions of the purchasing public. They were neither expected to know nor was

it desirable that they should learn \* \* \*  
Such a course is in contravention of the principles observed by courts of equity in the administration of this branch of the law."

In *Allen B. Wrisley v. Iowa Soap Company*, 104 Fed. R., 548, it was held that a complainant using the name of "Old Country Soap" on a soap manufactured in the United States for the purpose of inducing persons who come to this country from Europe to believe such soap was made in the old country is not entitled to protection in the use of such name as a trade name. The Court said, page 551:

"I have no doubt whatever that the purpose of the plaintiff is to make people in a German community believe that its soap is manufactured in Germany, or, at least from a recipe coming from that country, and in an English community that it is soap manufactured in England or at least from a recipe coming from England; and so on in all other communities having a foreign population. One of plaintiff's advertisements used in the argument by the consent of the parties tends to show that such is plaintiff's purpose, and yet the fact is that plaintiff's soap is made in Chicago, Ill., and is manufactured by an Illinois corporation as successor of Mr. Wrisley, an American citizen. The long and short of this matter is that complainant comes into Court upon proof that tends to show that it is practicing a deception, and has been for years."

See also *Kenny vs. Gillet*, 70 Md., 574.

*Prince M. Co. vs. Prince's Metallic Paint Co.*, 135 N. Y., 24.



Hobbs vs. Francais, 19 How. Pr. (N. Y.),  
567.

Millrae Co. vs. Taylor, 37 Pac., 235,  
(Cal.).

Coleman Co. vs. Dannenberg Co., 103 Ga.,  
784.

Raymond vs. Royal Baking Powder Co.,  
85 Fed., 231.

(2).

Complainant's failure to state in his labels the change of manufacture after the assignment from Thomas Beecham is another element of his inequitable conduct.

In 1895 Thomas Beecham assigned his interest in the business to Joseph Beecham. Nevertheless the name of Thomas Beecham appeared on labels and circulars used thereafter, appearing at the head of a circular used at the time the present action was commenced (Record, pp. 65, 37, 35). A label used on the *ten cent size* boxes at the time of the trial reads "Thomas Beecham, St. Helens, England, and New York, U. S. A.," and is without any mention of *Joseph Beecham* or the assignment (Record, pp. 35, 64, Complainant's Exhibit VI).

Despite the statement on the last page of the circulars, which most people would fail to read, the public is told in effect that these are *Thomas Beecham's* pills. The statement on the ten cent label is a direct allegation to that effect. The case falls within the principal that failure to state a change of ownership, and continued sale of the commodity under the name of the assignor constitutes a false representation to the public, to which equity

will refuse to render assistance. The basis of the rule is the Court's desire to prohibit the extraordinary remedy of injunction to those who have acted unconscionably, and to protect the public from the effect of untrue commercial statements. The continued use of the name of Thomas Beecham by complainant should, therefore, disentitle him to the relief sought.

Paul on Trademarks, Sec. 318, p. 543.

Stachelberg vs. Ponce, 23 Fed. R., 430,  
(affirmed on other grounds, 128 U. S.,  
686).

Symonds vs. Jones, 82 Me., 302, 315.

Hegeman & Co. vs. Hegeman, 8 Daly (N.  
Y.), 1, 22.

Royal Baking Powder Co. vs. Raymond,  
70 Fed., 376, affd. 85 Fed., 231.

See also

Seigert vs. Abbott, 61 Md., 276.

Alaska Packer's Assn. vs. Alaska Imp.  
Co., 60 Fed., 103, (even where labels  
corrected after suit brought).

In *Stachelberg vs. Ponce*, *supra*, where complainants claimed the exclusive right to the use of a trademark, the complainant Stachelberg had obtained the right from one Asher Bijur by assignment, and immediately substituted his name and initials on the trademark for those of the assignor. The Court denied relief because of complainant's failure to state that he was the assignee of the original proprietor, saying (p. 431):

"Now, in order that the public may not be deceived, it is essential that an assignee or purchaser of the original proprietor should indi-

cate in the use of the trademark that he is assignee or purchaser,—*Sherwood vs. Andrews*, 5 Amer. Law Reg. (N. S.), 588,—otherwise the public are misled into purchasing the goods of another manufacturer or vendor as those of the original proprietor. If these complainants have any right of action against the defendant, it is upon the ground that, by copying the trademark 'La Normandi' in substance, he is misleading the public by false representations into the purchase of his cigars as those made by A. Bijur, the original proprietor of the trademark. *Canal Co. vs. Clark*, *supra*. And so these complainants, in failing to give notice that they are the purchasers and assignees of the trademark from A. Bijur, are practicing the same deception towards the public which they charge against the defendant. The fact that the name 'M. Stachelberg' is attached to the trademark can no more relieve the complainants of the charge of misrepresentation as to the public than the use of the name 'E. Ponce' or 'E. P.' can relieve the defendant of such a charge. It is the use of the fanciful words 'La Normandi,' or words of substantial similarity, that is calculated to mislead. The Supreme Court, in *Manhattan Medicine Co. vs. Wood*, *supra*, declare that the object of a trademark being to indicate by its meaning and association the origin or ownership of the article, it would seem that when a right to its use is transferred to others, either by act of the original manufacturer or by operation of law, the fact of transfer should be stated in connection with its use, otherwise a deception would be practiced upon the public, and the very fraud accomplished, to prevent which courts of equity interfere to protect the exclusive right of the original manufacturer.

Under the rule laid down in *Manhattan Medicine Co. vs. Wood*, the complainants have no standing in a court of equity, and the bill must be dismissed."

#### POINT IV.

**The Court has jurisdiction of the case at bar under Section 6 of the Act of March 3rd 1891.**

On the argument of a motion to dismiss or affirm, heretofore made in this Court, it was argued for appellee that this Court was without jurisdiction to hear the present appeal, because diversity of citizenship was the only ground of Federal jurisdiction. The motion was not granted, and it therefore seems unnecessary to reopen the argument, but in anticipation of further objection by the appellee, we desire to point out in brief the defects in his contention, and the reasons for the undoubted jurisdiction of this Court.

The bill of complaint charges primarily an infringement of complainant's alleged trademark "Beecham's Pills" (Record, pp. 2 to 6), in that defendant sold certain pills similar to those manufactured by complainant, describing them as "Beecham pills, manufactured and sold by Mark Jacobs, Maspeth, L. I., N. Y., U. S. A." (Record, p. 5). Diversity of citizenship is also alleged by averring complainant's alienage because of citizenship and residence in England, and defendant's New York residence and citizenship (Record, p. 1). The bill of complaint contains allegations of an alleged right under, and defendant's violation of, the

Federal Trademark Act, by reason of complainant's registration on August 23rd, 1887, of said alleged trademark under the Act of Congress in addition to his alleged common law rights.

The Sixth Paragraph of the bill of complaint alleges that the complainant and his father were doing business in England on August 23rd, 1887, and had been engaged for three years previously in shipping the aforesaid pills from Great Britain to the United States, and that Great Britain was then a country affording to citizens of the United States "similar privileges of registering trademarks to those afforded at that time in the United States to citizens of other countries" (Record, p. 3).

Paragraph Seventh of the bill of complaint reads as follows:

"Seventh. That on said 23rd day of August, 1887, the said Thomas Beecham, on behalf of the firm, consisting of himself and your orator, and in accordance with the Act of Congress in that case made and provided, upon due application therefore, duly procured the registration as a trademark under the said Act of the words 'Beecham's Pills.'"

At the time of the registration in 1887, the Act of March 3rd, 1881, entitled "An Act to Authorize the Registration of Trademarks and Protect the Same" (21 Statute, 502, Chap. 138) was in force. This was the statute considered in

Warner v. Searle & Hereth Co., 191 U. S.,  
195,

and was of course the "Act of Congress" referred to in the Seventh Paragraph of the bill of complaint in this case.

The allegations of Paragraph Sixth follow the language of Section 1 of said Act of March 3rd, 1881. The Act gives the Federal Courts jurisdiction without regard to the citizenship of the parties.

U. S. *v.* Duell, 17 App. Cas. (D. C.), 471, 478; 28 Am. & Eng., 434-5.

Section 7 gives a right of action in equity for infringement of a trademark registered under the Act, and a cause of action was clearly intended to be set forth in the bill of complaint herein *under this Act*, as well as one under general equitable principles.

Further indication of this may be obtained from the allegation in the Eighth Paragraph of the bill of complaint, which reads:

"That during the year 1895 the said Thomas Beecham assigned to your orator his entire interest and title in and to all the property possessed or owned by the said partnership, including all his right, title and interest to the use of the said trademark 'Beecham's Pills' both at common law and *under the aforesaid Statute*" (Record, p. 4).

The bill clearly relied upon a trademark both at common law and under the Act of 1881, and it is obvious that the allegations as to Federal registration were inserted for that purpose, and would have had no significance as marking the date of the beginning of claimant's claim of user, which began many decades previously. In all subsequent paragraphs of the bill a violation by defendant is charged of the alleged trademark, which complainant claimed at common law and under the Act of Congress.

The case of *Warner vs. Searle & Hereth Company* (*supra*), seems, therefore, conclusive of the jurisdiction of this Court to review on appeal the determination of the Circuit Court of Appeals. In that case, a citizen of Pennsylvania sued an Illinois corporation and others in the Circuit Court for the Northern District of Illinois, alleging that he was the sole and exclusive owner of a certain trademark termed "Pancreo-pepsine" upon bottles and packages containing a certain medicinal preparation sold throughout the United States and in foreign countries; that he had registered the trademark in the Patent Office and obtained his certificate. Infringement by the defendant was complained of, and an injunction granted. The Circuit Court of Appeals reversed the decree of the Circuit Court, and from that decree an appeal was taken to this Court. It was argued that the Court was without jurisdiction on the face of the pleadings, and that the mere recital in a bill of complaint of the registration of a trademark was insufficient, especially as the trademark was on its face invalid. The Court held, however, *that the mere allegation of registration of a trademark was sufficient to give the Court jurisdiction as a cause arising under the laws of the United States.* The words of Chief Justice Fuller are particularly in point here:

"In the present case, diverse citizenship, and requisite amount, existed, and the Circuit Court, therefore, had jurisdiction, but it is argued that the jurisdiction depended entirely upon diversity of citizenship, and hence that the decision of the Circuit Court of Appeals was final. *We think, however, that as infringement of a trademark registered under the Act was charged, the averments of the bill, though quite defective, were sufficient to invoke the*

*jurisdiction also on the ground that the case arose under a law of the United States, and will not, therefore, dismiss the appeal."*  
(191 U. S., 195).

The averments of the bill in the Warner case with respect to the registration of the trademark were almost absolutely identical in character with those in the present case. They are set forth in the "Statement of the Case" as follows (Record, p. 195) :

"That on November 26th, 1882, complainant registered said trademark in the Patent Office, and obtained a certificate of registration according to law, a copy of which certificate and accompanying statement and declaration was attached."

The decision in the Warner case is well supported by the decisions in

Union Pacific Railroad Co. *vs.* Harris, 158 U. S., 326, 327-8.

Sonnentheil *vs.* Moerlein Co., 172 U. S., 401, 404-5.

Henningsen *vs.* U. S. Fidelity & Guaranty Co., 208 U. S., 404.

Howard *vs.* U. S., 184 U. S., 676, 680-1.

Northern Pacific Railroad Co. *vs.* Soderberg, 188 U. S., 526, 528.

The case of *Howard vs. U. S.*, *supra*, was a suit on the bond of a Clerk of Court taken by a United States Circuit Court in conformity with the United States Statutes. The Court said, p. 681:

"It was therefore a suit arising under the laws of the United States, of which the Circuit



Court (concurrently with the Courts of the State) was entitled to take original cognizance, even if the parties had been citizens of the same State."

Appellee's contention is that the Warner case is not in point because the bill in the present case does not adequately set forth all requisite matter under the Trademark Act. This was the very point considered in the Warner case, and there held to be immaterial. In other words, the Warner case holds that so long as the bill of complaint charges infringement of a trademark registered under the Trademark Act, that is sufficient to give this Court jurisdiction on the appeal.

Appellee may also contend that the Trademark Act is invalid despite the prevailing opinion to the contrary. (Paul on Trademarks, Sec. 332; See So. Carolina vs. Seymour, 153 U. S., 353; Hennessy vs. Braunschweiler, 89 Fed., 664; L. H. Harris Drug Co. vs. Stucky, 46 Fed., 624; Congressional Record, Vol. 10, Part 2, p. 1514; compare International Text Book Co. vs. Pigg, 217 U. S., 91).

But it is difficult to see either how the question can be raised here or what effect it has on the present controversy. It was not raised in the courts below, and it is well settled that the constitutionality of a statute will not be considered unless the question is squarely presented and necessary to the decision.

*Ex parte* Randolph, 2 Brock, 447.

State vs. Corson, 67 N. J. L., 178.

Cf. Turpin vs. Lemon, 187 U. S., 51, 60-61.

In both the Warner case, *supra*, (191 U. S., 195), and in *Saelchner vs. Wagner*, 216 U. S., 375, the only grounds of Federal jurisdiction were diverse citizenship and registration under the Trademark Act of 1881, and in both cases this Court exercised its jurisdiction, heard the appeals, and decided on the merits.

An elaborate argument was attempted in a former brief based on the complainant's alleged failure to offer proof in support of the allegation as to registration, and that the registration papers concededly offered by defendant and received in evidence without objection (Record, p. 53) were not printed in the records in the Circuit Court or Circuit Court of Appeals. The answer to this is that a long line of decisions of this Court have established that the *allegations of the complaint* govern in determining the grounds on which the jurisdiction of this Court under Section 6 of the Act of March 3rd, 1891, arises, and that subsequent pleadings and proceedings cannot enlarge or restrict the same.

*Borgmeyer vs. Idler*, 159 U. S., 408.

*Ex parte Jones*, 164 U. S., 691.

Failure to print the exhibit is quite immaterial as it was sufficiently described in the record, which unmistakably refers to it at page 53:

"Mr. Goldzier: I offer in evidence record from the Patent Office regarding the registration of trademark of Thomas Beecham, filed on August 23rd, 1887.

Received in evidence and marked Defendant's Exhibit B."

It is of course well settled that exhibits need not

be printed in full which are adequately described in the record.

Revised Statutes, 698.

Nashua Corporation *vs.* Boston Corporation, 61 Fed. Rep., 237.

Union Pacific Railroad Company *vs.* Stewart, 95 U. S., 279.

Ball Co. *vs.* Kraetzer, 150 U. S., 111, 118.

If appellee desired a more ample transcript or summary of the certificate his remedy was to apply for a *Certiorari* under Rule 14. By failing to do this he acquiesced in the sufficiency of this summary.

Questions under the trademark registration Act are raised by the complaint, by the appellant's answer and assignments of error both in the lower Court (Record, p. 83, Nos. 5 and 8) and here (Record, pp. 90 to 91, Nos. 5 and 8). This Court, therefore, has jurisdiction to determine the questions raised by this appeal.

It also appears from the record that *defendant* registered a trademark, so far as he had anything to register, and that therefore his rights under the Trademark Act are also involved (Record, pp. 6 and 19). In this respect the case at bar presents a further ground for maintaining the jurisdiction of this Court.

If the question of jurisdiction should be regarded as requiring serious consideration, despite the Warner decision, attention is called to appellant's brief on the motion to dismiss or affirm wherein it is prayed (p. 29) that a writ of *certiorari* issue, as in *Farrel vs. O'Brien*, 199 U. S., 89, and the return on appeal stand as the return on *certiorari*.

**POINT V.**

**The judgment and decree of the Circuit Court of Appeals should be reversed, the injunction vacated and the bill of complaint dismissed, with costs to the appellant both here and in the Courts below.**

It is respectfully submitted that, as the use of the name Beecham is *publici juris*, because generic, and used in connection with an unpatented process, and as there is no unfair competition, since defendant conspicuously stated his name as manufacturer; and as complainant does not come into equity with clean hands, because of his false use of the word "patent," and false statement of the place of manufacture, and use of the name Thomas Beecham, he is not entitled to relief, and the injunction should not have been granted.

Respectfully submitted,

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MAX J. KOHLER,  
MOSES WEILL,  
ISAAC WEILL,  
CORNELIUS W. WICKERSHAM,  
Of Counsel for Appellant.

# Supreme Court of the United States

OCTOBER TERM, 1910.

No. 129.

MARK JACOBS,

*Appellant.*

vs.

JOSEPH BRECHAM,

*Appellee.*

## BRIEF FOR APPELLEE.

JOHN L. WILKIE,

Attorney for the Appellee.

1 WALL STREET,

NEW YORK CITY.

# Supreme Court of the United States.

MARK JACOBS,  
Appellant,  
(Defendant below),

AGAINST

JOSEPH BEECHAM,  
Appellee,  
(Complainant below).

October Term,  
1910.  
No. 139.

## **Brief for Complainant-Appellee.**

This is an appeal from a decree of the United States Circuit Court of Appeals in and for the Second Circuit, affirming a decree of the Circuit Court of the United States for the Eastern District of New York in favor of the complainant Joseph Beecham. The action is brought to restrain the appellant from using the word "Beecham" on any boxes of pills manufactured or sold by him, and from colorably imitating the complainant's "make up" in connection with any pill business carried on by him (fols. 34-8).

### *Facts.*

The appellee is and for many years has been the manufacturer of certain medicinal pills which

have always been and are sold under the name of "Beecham's Pills." The appellant is engaged in the business of marketing certain medicinal pills for human use, which he designates as "Beecham Pills" and, as against the appellee, the appellant asserts the right to so mark or designate his goods. The appellee now uses and always has used the phrase "Beecham's Patent Pills" in several places upon his labels and advertising matter although his pills are not patented (fol. 209). He has likewise advertised upon all pill boxes and circulars the name of his principal place of business, St. Helens, Lancashire, England. Since 1890 the appellee's pills sold in America have been made in Brooklyn or New York (fols. 129-30), although the appellee's main factory is and always has been in England (fols. 131, 154). That is his residence and his place of business (fol. 154).

The appellant asserts the right as against the appellee to designate or mark his goods as he does by virtue of the four following claims:

First: That the appellee falsely asserts that his pills are patented when they are not.

Second: That the appellee falsely asserts that his pills are made in England when they are not.

Third: That the appellee falsely asserts that his pills are made by "Thomas Beecham" when they are not.

Fourth: That the owner of a secret process, unpatented, cannot acquire any monopoly to the right of the process or the use of the name he designates the article by, except as against one standing in a fiduciary relationship to him, and that no valid trade-mark can be acquired in such a descriptive name.

*Preliminary Objection.*

Preliminarily, the appellee refers the learned Court to his motion to dismiss this appeal, which, by order of the court, has been set down for argument in connection with the main appeal. If said motion be granted, then obviously any consideration of the matters hereinafter discussed is unnecessary.

**POINT I.**

**The appellee has not represented that his pills are manufactured under letters patent.**

There are two packages of pills prepared by the appellee known in the record as the ten cent and the twenty-five cent sizes; and in neither the circulars nor labels of the ten cent size does there occur or has there occurred the word "patent" at any time. On the twenty-five cent size the word occurs several times. Upon the circular orange labels on the tops of the boxes of the latter size are printed the words "Beecham's Patent Pills." Upon the circular labels around the boxes appear the words "Beecham's Patent Pills," in a scroll or garter printed thereon. Upon the circulars wrapped around the twenty-five cent boxes the word does not at present appear, but it has appeared in times past in the case of one circular (Exhibit XIII fols. 281-4) which was used in connection with the twenty-five cent boxes between August, 1888, and December, 1893 (fol. 142).



The appellant relies principally upon the case of *Holzappel's Co. v. Rahtjen's Co.*, 183 U. S. 1, where it was held that the name "Rahtjen's Patent Composition" as applied to an unpatented ship paint, was a misrepresentation of fact which prevented the owner from obtaining relief in a court of equity. In that case, the commodity to which the word was applied was paint, in this, pills. In addition, it appeared that the paint had been manufactured under an expired patent so that the term as used in the name concededly indicated and was intended to indicate the existence of letters patent. The question in each case turns on the likelihood of deceit from the use of the word "patent." Granting that to call an unpatented paint "Patent Composition" is deceptive, is it deceptive to employ the term in connection with an unpatented pill? If common usage has applied the word "patent" to a class of unpatented articles—medicines—so uniformly as not in the least to indicate to the public that they are patented in fact but on the contrary to indicate merely that they are secret or proprietary medicines, the rule of the "*Holzappel*" case is not applicable, and the description is not misleading.

The other cases cited by the appellant only corroborate the rule laid down in the "*Holzappel*" case which is to the effect that if one asserts that his goods are made under letters patent when they are not so made in fact, he cannot enjoin an infringement of his trade-mark or trade-name. As so stated we do not contest the rule. We do contest its application to the case at bar.

There have been many cases in the courts in which it has been held that the word "patent"

was not intended to indicate and did not in fact indicate that the article to which it was applied was in fact patented.

In *Cahn v. Gottschalk*, 14 *Daly*, 542, the plaintiff had registered his label under the Copyright Act. He applied it to whiskey and upon the label put the words "Pat. Aug. 13, 1872." The Court held that these words when applied to whiskey could not suggest the actual issuance of a patent but indicated rather the registry of the label and that their use in such a manner was, therefore, innocent.

In *Cochrane v. McNish*, 1896 *Appeal Cases* 225, the Privy Council held that the plaintiff who was the well known manufacturer of club soda should not be disbarred from relief against an infringer because he put upon his labels "Manufactured in Ireland by Her Majesty's Royal Letters Patent." It was held that as the plaintiff manufactured his soda with patented machinery and as soda could not be patented, there was and could have been no intent to deceive.

In *Marshall v. Ross*, *Law Rep. 8 Eq.* 651, the plaintiff called his thread "patent thread." It appeared that the name had come to be indicative of a certain quality of thread throughout the trade and the Court held that it was like patent leather and merely a trade name. A similar case is *Stewart v. Smithson*, 1 *Hilton* 119.

In *Leather Cloth Co. v. American Leather Cloth Co.*, 11 *House of Lords* 523, Lord Kingsdon gives as an instance of the innocent use of the word "patent" in a trade-mark the case of "patent leather."

In *Insurance Oil Tank Co. v. Scott*, 33 *La. Annual* 946, the plaintiff had a trade-mark to which

he attached the words "Trade-Mark Insurance Oil Pat. Jan. 5, 1875". The Court held that the word "patented" applied simply to the trade-mark which had been registered and that its use was therefore innocent. In the course of its opinion the Court said that the word "patented" was frequently used as a substitute for the words "registered as a trade-mark" or for the word "copyright," and quoted from Judge Cooley, who says "trade-marks may be patented."

That the word "patent" is frequently used in combinations not intended to indicate that the article has been in fact patented is evidenced by the following citations from various standard English dictionaries.

The *Century Dictionary*, page 4325, gives instances of such use of the word: "patent alum", "patent barley", "patent drier", "patent hammer", "patent inside", "patent outside", "patent metal", "patent yellow". As a definition of the words "patent medicine" it gives the following: "A drug which is patented or *the name of which is patented*, but usually and less properly, any drug, the manufacture or sale of which is restricted in any way, whether by patent of substance, name, label or the like, or by *secrecy as to the nature and method of preparation*."

(The appellant has quoted parts of the foregoing in support of his contention and seizes with avidity the phrase "less properly" as an argument against the propriety of the appellee's use of the term. The implied criticism seems to affect the etymological propriety of the use and not its honesty. We are certainly not here concerned with the purity of Mr. Beecham's English, but with his business honesty.)

In *Murray's Oxford Dictionary*, Vol. VII, page 549, under the title Patent I, 3, b., the following definition is given: "Fig. (figurative) and transf. (transferred) to which one has a proprietary claim; also *special for its purpose*; sovereign; superlative."

The *Encyclopaedic Dictionary*, Vol. 10, page 409, under the word Patent A (3) has the definition: "Appropriated by letters patent; patented; secured or protected by letters patent as an exclusive privilege; *restricted from general use as patent medicines.*"

*Stormonth's Dictionary*, page 712, gives the following: "Patent Medicine, *medicine the composition of which is a secret* and the right of sale limited by Government sanction to the proprietor."

(If the words "limited by Government sanction to the proprietor" are intended to mean anything more than that the name is protected by trademark, they are contradictory for, of course, nothing can be patented the composition of which remains a secret. The definition, therefore, cannot mean that the sanction which limits the right of sale is the sanction of a formal patent.)

In *Brewer's Etymological and Pronouncing Dictionary of Difficult Words* occurs the definition: "Patent Medicine, medicine bearing a Government stamp."

In many statutes in this country the word "patent" as applied to medicines is used as interchangeable with "proprietary", and such use of the word has, therefore, obtained a legislative sanction. The citations are so numerous that they can at best be merely classified.

In the following statutes the phrase "patent or proprietary" medicines occurs in provisions regulating their preparation and sale:

*U. S. Revised Statutes, Sec. 3436;*  
*Arkansas Digest of Statutes, Sec. 5283;*  
*Dakota Territory Rev. St., Secs. 228, 229;*  
*Hawaii Territory Rev. St., Sec. 1095;*  
*Illinois Rev. St., Chapter 91, Sec. 30;*  
*Indiana Rev. St., Sec. 5000 i;*  
*Maine Rev. St., Chapter 30, Sec. 13;*  
*Michigan Rev. Laws, Sec. 5312;*  
*New Jersey Public Laws, 1895, p. 365, Sec. 8;*  
*North Dakota Rev. St., Sec. 7281;*  
*Ohio Rev. St., Sec. 4405;*  
*Tennessee Code, Sec. 3635;*  
*Vermont Rev. St., Sec. 4663;*  
*Washington Codes and Statutes, Sec. 2877;*  
*Wyoming Rev. St., Sec. 2222.*

In the following three statutes the phrase is "proprietary and patent medicines."

*Colorado Rev. St., Sec. 4909;*  
*Florida Rev. St., Sec. 814;*  
*Oregon Codes and Statutes, Sec. 3811.*

In *Massachusetts Rev. St., Chap. 76, Sec. 23*, and *Utah Rev. St., Sec. 1725*, the phrase is "patent and proprietary medicines"; in *Kentucky Rev. St., Sec. 2631*, "proprietary or patent medicines;" in

*Delaware, Chap. 36, Vol. 18, Sec. 1*, "patent, quack, or proprietary articles;" in *South Carolina Civil Code, Sec. 1126*, although the text of the section refers to "medicines already prepared," the reference note at the side is only in the words "patent medicines."

In *Louisiana Laws of 1888, Act. 66, p. 74, Sec. 3*, and in *Pennsylvania Public Laws, 189, Sec. 6 (1887, May 24)*, the phrase is "proprietary remedies, popularly known as patent medicines." In *Rhode Island Rev. St., Chapter 152, Sec. 8*, the phrase is "proprietary medicines, popularly called patent medicines." In *South Dakota Political Code, Sec. 281*, the druggist is held responsible except (among other things) for "those articles or preparations known as patent or proprietary medicines." In *West Virginia Code, Chap. 150, Sec. 7*, the phrase is "those known as 'patent medicines.' "

These words have been construed also by a court in the case of *State v. Donaldson, 41 Minn., 74*, the opinion in this case using the phrases "patent medicine" and "patent or proprietary medicines," to indicate the same goods. On page 83 the court says:

"Whether the term 'patent and proprietary medicines' is to be understood in its strict and technical sense, as limited to those in the preparation of which there is an exclusive right of property in some proprietor patentee, or whether it is used in a popular or more extended sense, as including all preparations prepared and sold throughout the country in original packages, as patent medicines are, is a question we are not called upon to determine, because the answer admits that

'Beef, Iron and Wine' is not a patent medicine, and that its uses are exclusively medicinal."

Similar instances may be found in the case of *Nordyke & Marmon Co. v. Kehler*, 155 Mo. 643, at page 653, where the court construed a contract which spoke of "patent flour" as follows:

"It seems that every flouring mill separates its product into two or more grades. Into the first grade it puts its best quality, which is called its 'patent flour' and is the best product obtained by that mill from wheat handled by it. What is left of that wheat goes into inferior grades of flour."

See, also *Palmer v. McCormick*, 30 Fed Rep. 82, for the use of the words "patent inside."

That the appellee has always intended to use the word "patent" in the patent or proprietary sense, his own pamphlets conclusively show. Thus, on the last page of the pamphlet used until December, 1893 (fol. 142, Exhibit XIII fols. 281-4), are the following expressions: "Sold by all Drug-gists and *Patent Medicine* Dealers everywhere"; and again on the same page, "Beecham's Pills have the largest sale of any *Patent Medicine* in the World." On the first page of all the twenty-five cent circulars from September, 1899, to the present time (fols. 140, 148, 142-3, Exhibits XV fols. 289-92, XVI fols. 293-6, XVII fols. 297-300 and VII fols. 257-60) have been used the words: "Beecham's Pills have been before the public for over half a century and now hold the supreme position among *proprietary medicines*." The ten cent circulars since September, 1902 (fol. 144,

Exhibits XIX fols. 305-8, and XX fols. 309-12) bear the same sentence.

Thus the very circulars show what the words "Patent Pills" meant and it is only perverse ingenuity to impose upon them a construction not only in violation of their own context, but not justified by common usage.

The appellant has in the lower courts attempted to make a point out of the use of the word "patent" in the assignment of the business made by Thomas Beecham to the appellee, and uses as an indication that the pills were once made under a patent, the fact that the Beechams describe themselves in the assignment of 1895 (fol. 273) as "proprietors of a patent and of certain trade-marks." The appellant's contention evidently is that the words of the assignment show that the Beechams used the word "patent" on their label as equivalent to letters patent. To this there are two answers: (1) that it is an entirely gratuitous assumption to infer that, assuming the Beechams to have owned letters patent for something, the patent must have been for the manufacture of these pills; and (2), that it is quite as legitimate an inference that they meant by the word "patent", as used in the assignment, "a secret and proprietary process" as that they meant, in the label, that the pills were made under letters patent. If so, it is only an added evidence that the word was used in perfect innocence upon the label. The appellant made no effort on the hearing to learn what the word meant in the assignment or to what property it referred and the whole argument seems to be an afterthought, conceived after judgment was rendered against the appellant and founded upon the use of a word which had up until that time been ignored by everyone.



**POINT II.**

**The appellee has not been guilty of any false representations either as to the place of manufacture of his product or the person by whom the same is manufactured.**

*A—As to the place of manufacture.*

In support of his claim that the appellee fraudulently asserts that the pills are made in England when they are not, the appellant relies upon three statements.

The first is taken from a circular (Exhibit XIII fols. 281-4) which was used between August, 1888, and December, 1893 (fols. 142-3). Until November, 1890, the pills were made in England (fols. 129-31) and until then there was no possibility of error. Nor was there anything misleading thereafter in the statement that the pills were "specially put up for the American market" and that "no English Revenue Stamp is needed." Even if it were misleading, it has been abandoned for seventeen years and cannot be made the basis of successful piracy of the name "Beecham." The discontinuance of a mis-statement when made before suit brought relieves the complainant of the effect of the rule.

*Moxie Nerve & Food Co. v. Modox Co.*, 153 Fed. Rep. 487.

*Johnson & Johnson v. Seabury &*

*Johnson* (N. J.) 67 Atl. Rep. 36;

*Symonds v. Jones*, 82 Me. 302.

The next supposed mis-statement is from the same circular that the pills "are prepared only and sold wholesale by the proprietor, Thomas Beecham, St. Helens, Lancashire, England." This form of circular continued until December, 1893 (fol. 142). The same phrase was afterwards used between September, 1899, and July, 1902 (fol. 142, Exhibit XV fols. 289-92) and has not been used since that time. From July, 1902, to August 21st, 1905, the words were "Beecham's Pills are prepared only and sold wholesale by the proprietor, Thomas Beecham, St. Helens, England, and 365 Canal St., New York" (Exhibits XVI fols. 293-6, XVII fols. 297-300 and XX fols. 303-12). Between September, 1902, and May, 1903, in the ten cent circulars, the words were "Prepared only by the proprietor, Thomas Beecham, St. Helens, Lancashire, England, U. S. A., Depot 365 Canal St., New York" (fol. 144, Exhibit XIX fols. 305-8). Since July 14th, 1905, on the twenty-five cent circulars and since August 21st, 1905, on the ten cent circulars the words have been "Prepared only by the proprietor, Joseph Beecham, successor to Thomas Beecham. St. Helens, England; and 365 Canal Street, New York, U. S. A." (Exhibits VII fols. 257-60 and VIII fols. 261-3; fols. 139-40, 148-9). The only reasonable meaning of the words in question is that the pills are prepared and sold by the proprietor who does his business and is to be found at St. Helens, Lancashire, England, and whose principal address is there. This is borne out by the fact that the New York address was added, which was the mere warehouse of the United States agent (fols. 161-2). It was obviously with the same intention that the English address was originally put on. It cannot be reasonably construed as meaning that he prepared

all his pills at St. Helens. Would the appellant assert that it meant that the pills were sold at St. Helens and that any sales made elsewhere caused the statement to be false? Must he not so contend to be consistent, since there is no distinction in the statement between the preparation of the pills and the sale? The appellant's construction is forced and gratuitous. Even if it were not, however, all of the forms used since 1902 are necessarily unobjectionable and under the authorities already cited the appellant cannot rake up the past to find in a long discontinued user, evidence of untrue statements (See "*Moxie*" case and others, page 12, *supra*).

The last alleged misstatement is one which is used at the present time (fols. 139-40, 148, Exhibit VII fols. 257-60), and has been used since September, 1899 (fol. 142, Exhibits XV, XVI and XVII fols. 289-300). It is substantially the same as the statement in Exhibit XIII already quoted and is as follows: "The pills accompanying this pamphlet are specially packed for U. S. America, being covered with a quickly soluble pleasant coating, completely disguising the taste of the pill," etc. This was used while the pills were both packed and made in the United States. The question is, whether there is a definitely misleading statement that the pills, although *packed for* the United States are *made in* England. It cannot be urged that there is any express statement anywhere that is untrue, because the pills are packed *for* the United States and *in* the United States, and they are made here also. There is also no question here of trying to give the impression falsely that the pills are specially packed when there is nothing special about them. There is no

proof that the pills have not a special coating. To the contrary, they have. Therefore, the whole question is whether or not the clause is false, not by virtue of what it says, but of what it suggests.

The case of *Wrisley Co. v. Iowa Soap Co.*, 104 *Fed. Rep.*, 548, which is largely relied on by the appellant, went upon the theory, not that there was necessarily a suggestion in the name "Old Country Soap" that the soap was made in another country, but that either it was made there or was made after a foreign recipe. Besides, the complainant had made other misleading statements in his circulars. But in any event, the term there used was susceptible of no interpretation—if it was to have any meaning at all—except that the soap was either made in the "Old Country" or was made after a recipe from the "Old Country." The words here do not call for the interpretation that the pills are made in England, although packed for the United States. They are equally true wherever the pills are made.

In *Tarrant & Co. v. Johann Hoff*, 76 *Fed. Rep.* 959, almost the precise question was raised and answered, the Court saying at page 961:

"Nor do we find that complainant is disentitled to relief in equity by reason of any false representations in its own labels as to the place of origin of the extract itself. Some of the statements they contain, survivals from the older labels, are not now strictly accurate, notably the words 'Moritz Fisher, Sole Agent for U. S. of America,' but they are immaterial. The labels certainly contain no statement that the extract is made in Germany, while the record shows that complainant has

been to no considerable expense to advertise this new industry of manufacturing the Johann Hoff's Malt Extract in this country."

That case was stronger for the defendant than the case at bar, because the statement that "Moritz Fisher" was "sole Agent for U. S. of America" was actually false, while every word of the appellee's circular is literally and strictly accurate.

In *Clark Thread Co. v. Armitage*, 74 Fed. Rep., 936, where certain labels had been used after the time when they ceased to be true, the Court held that the owner would still be protected.

See also Judge Thayer's Decision in *Société Anonyme, etc., de Fecamp vs. Western Distilling Co.*, 43 Fed. Rep. 416.

In *Siebert v. Gandolfi*, 149 Fed. Rep. 100, the Court held that trivial mis-statements in the circulars would be disregarded.

See also *Gluckman v. Strauch*, 99 App. Div. 361, *aff'd*. 186 N. Y. 560, where the complainants had said they were the manufacturers of certain cigarette paper when the fact was that they did not make it but that it was made exclusively for them at Paris.

*B—As to the person by whom the pills are manufactured.*

In his assignment of errors to this learned Court, the appellant urges as one of the grounds for reversal, the failure of the lower Court to dismiss the bill because of certain alleged false statements by the appellee, that his pills were made by "Thomas Beecham" (Assignment 14, pg. 91).

This claim which is somewhat akin to that just considered is also made in the answer (fols. 83-4). Although this point was neither argued nor briefed in the lower court and had apparently been abandoned until its reappearance in the assignment of errors to this court, its reappearance suggests the possibility that such a claim will be argued on this appeal, and this possibility suggests its brief consideration.

The case of *Manhattan Medicine Company v. Wood*, 108 U. S. 218, is the leading case on the question of fraudulent representations as to the place of manufacture and the person of the manufacturer, and the rule with respect to this question cannot be more concisely stated than in the language of Mr. Justice Field, when he said at page 223:

“If one affix to goods of his own manufacture signs or marks which indicate that they are the manufacture of others, he is deceiving the public and attempting to pass upon them goods as possessing a quality and merit which another’s skill has given to similar articles, and which his own manufacture does not possess in the estimation of purchasers. To put forth a statement, therefore, in the form of a circular or label attached to an article, that it is manufactured in a particular place by a person whose manufacture there had acquired a great reputation, when, in fact, it is manufactured by a different person at a different place, is a fraud upon the public which no court of equity will countenance.”

This rule which is founded in honesty and good sense the appellee does not criticise nor seek to

contest. It is submitted, however, that it has no application to the facts in the case at bar which may be briefly stated as follows:

For a number of years prior to 1895 the appellee, Joseph Beecham and his father, Thomas Beecham, were engaged as partners in the business of manufacturing medicinal pills among other things. The firm name under which they did business or traded was "*Thomas Beecham of St. Helens, England*" (fols. 221, 237, 272-3), and the trade-marks and trade-names which they used were owned by them jointly as such partners (fols. 273-4). "Beecham's Patent Pills" were among the pills which they thus manufactured (fol. 273) and the circular enclosed with the boxes of such pills bore the statement "Beecham's Pills are prepared only and Sold Wholesale by the Proprietor, Thomas Beecham, St. Helens, Lancashire, England" (Exhibit XIII fols. 281-4). In March, 1895, the elder Beecham being well along in years and desirous of retiring from active business executed a deed to his son Joseph of all his share in the business (Exhibit XI fols. 267-78) and thereafter the business was continued by Joseph as the sole survivor of the partnership, in the same manner and under the same firm name, to wit: "*Thomas Beecham of St. Helens, England*" (Exhibit I fols. 214-8) as of course he had a perfect right to do. For a number of years after 1895 down until the summer of 1905, *the year before this action was instituted*, statements were contained in the circulars enclosed with both the twenty-five and ten cent sizes substantially to the effect that the pills were prepared and sold "by the Proprietor, Thomas Beecham, St. Helens, Lancashire, England" in some cases the New

York address being given also (Exhibits XV fols. 289-92, XVI fols. 293-6, XVII fols. 297-300, XIX fols. 305-8 and XX fols. 309-11; fols. 142-4). These statements were quite obviously mere survivals from the statements contained in the circulars prior to the transfer from Thomas to Joseph of 1895. In the summer of 1905 a change was made and since that time the circulars have contained the statement that the pills are prepared and sold "by the Proprietor, Joseph Beecham, successor to Thomas Beecham, St. Helens, England, and 365 Canal Street, New York" (Exhibits VII fols. 257-60 and VIII fols. 261-3; fols. 139-41). This latter statement is the one that was contained in the circulars at the time this action was commenced.

It is the statement contained in the circulars between 1895 (the date of the deed from Thomas to Joseph) and the summer of 1905 which the appellant has alleged and may now contend establishes the false statement of the appellee, which within the purview of the rule laid down in the case of *Manhattan Medicine Company v. Wood*, *supra*, should preclude him from obtaining relief in a court of equity.

The mere statement of such a claim would seem to demonstrate its absurdity. Aside from the objection that the discontinuance in good faith before suit of the statement criticised by the appellant, relieves the appellee from the operation of such a rule (See "*Morie*" case and others, page 12, *supra*), it is submitted that the statement was strictly accurate in point of fact and that its use by the appellee was beyond any question entirely innocent and without any intent to deceive.

The real manufacturer of "Beecham's Patent



Pills" and the real proprietor of the trade name used in connection therewith has never been the person of Thomas Beecham as distinguished from Joseph, or any other person, but has always been and is "Thomas Beecham of St. Helens, England" a partnership formerly composed of both Thomas and Joseph to which the latter succeeded as sole surviving partner. The appellee is lawfully continuing the business under the old name, as he has done since 1895, and the statement that the pills were manufactured and sold "by the proprietor Thomas Beecham, St. Helens, England" was strictly speaking as accurate in point of fact after the transfer of 1895 as it was before. It certainly can not be regarded as a misrepresentation or a fraudulent statement as the appellant has contended. Could it be successfully claimed that the statement that the proprietor was "Thomas Beecham, St. Helens, England," as used prior to 1895 was a misrepresentation or a fraudulent statement simply because Thomas Beecham was not the sole person trading under that name, but was associated with his son Joseph as a partner? Yet, in point of fact and law such a claim does not differ from the claim now being considered.

Let us assume that instead of a partnership there had been an incorporated company under the name of "Thomas Beecham of St. Helens, England," which by gift or purchase or some appropriate proceeding had acquired the proprietary right to the use of the name "Beecham" in connection with the manufacture of "Beecham's Patent Pills." The right of such a company to state in its circulars that the pills were manufactured and sold "by the proprietor, Thomas

Beecham of St. Helens, England," would continue despite the severance of Thomas Beecham's connection with the company or the transfer of his interest therein to his son Joseph. Yet, in principle, such a case does not differ from the one at bar for in each case the real manufacturer of the pills and the real proprietor of the trade name used in connection therewith is neither Thomas Beecham nor Joseph Beecham but "Thomas Beecham of St. Helens, England."

It may be that to the average person the statement now used more aptly describes the precise situation of the appellee, but, granting for the sake of argument that to such an extent the old statement may be said to be somewhat inaccurate, it is at the most a trifling inaccuracy which has no bearing upon the equities in this case. Such inaccuracies are apt, if not bound, to occur in a business of any magnitude or complexity and extending over a series of years such as that conducted by the appellee, and their occurrence is neither surprising nor censurable. It certainly affords no justification or excuse for a wanton and deliberate piracy of the appellee's good will and trade name in the manner attempted by this appellant.

There is nothing significant in the change made in 1905 nor can any inference unfavorable to the appellee be drawn from his having made such change. Only a few months before, and after his discovering that his goods and trade-marks were being criminally counterfeited, he had caused the arrest and conviction for these crimes of one Minden and his associates. The accused sought to avoid the consequences of their acts by a claim of fraud on the part of the appel-

lee, and one of the defenses interposed was that he had been guilty of false representations in stating that his pills were made by "Thomas Beecham" (fols. 163-6). The defense was overruled and the appellee might very properly have regarded this as judicial approbation of the statements contained in his circulars and continued them without any change. The mere suggestion of fraud or misrepresentation was enough however to cause him to act, and to make such changes in his circulars as would preclude the possibility of even a claim of mis-statement in the future.

It was after making such changes that the appellant herein commenced his piracy of the trade name and this suit was brought. Surely under such circumstances, and with the entire prior history of the Thomas Beecham firm it is impossible to reconcile such conduct with an intent to deceive or mislead the public or to make capital or profit out of fraud and deception.

What the law forbids is some unequivocal misrepresentation as to the place of origin or the person of the manufacturer from which it clearly appears that the complainant was trying to deceive and was apt to deceive the public. The sentences of the circulars here questioned are obviously perfectly innocent, the mere "survivals from older labels" (Exhibit XIII fols. 281-4), and it is submitted that the appellant's whole contention is trivial.

## POINT III.

**The appellee is not barred from relief because his pills happen to be made under a secret process or formula.**

Although the precise question seems never to have been passed upon by this Court, there is good authority supporting the broad general proposition of law asserted by the appellant that the owner of a secret process, unpatented, may not enjoin another from manufacturing goods under that process and marketing them under the name used to describe them by the original manufacturer, and by which they have come to be known to the public, provided the latter comes to his knowledge of the process in good faith.

*Chadwick v. Corell*, 151 Mass., 190;

*Watkins v. London*, 52 Minn., 389;

*Marshall v. Pinkham*, 52 Wis., 572;

*Park & Sons Co. v. Hartman*, 153

*Fed. Rep.*, 24;

*Baglin v. Cusenier Co.*, 141 *Fed.*

*Rep.* 497; 164 *Fed Rep.*, 25;

*Canham v. Jones*, 2 V. & B., 218;

*James v. James*, L. R. 13 Eq., 421;

*Condry v. Mitchell*, 37 *Law Times N.*

*S.*, 766; 268;

*Tabor v. Hoffman*, 118 N. Y., 30.

This point was not argued nor briefed in the lower courts but is raised in the appellant's brief in opposition to the motion to dismiss this appeal, and will no doubt be urged upon the argument of the main appeal itself. The appellee's answer to

such an argument is that it has no application whatsoever to the case at bar.

The appellee's pills are known as "Beecham's Pills." The appellant sells his pills as "Beecham Pills," although his name is not Beecham but Jacobs. It is alleged in the bill of complaint that the appellee's pills are manufactured "in accordance with a certain secret formula" (fol. 5). As against the appellee the appellant is therefore entitled to regard this as an established fact and indeed he so alleges in his answer (fols. 72-3). The record is entirely barren, however, of any evidence tending to show that the appellant's pills are manufactured under the "secret formula" used by the appellee, or any other secret formula. True, the answer contains an allegation to that effect (fols. 72-3) but no evidence was introduced in support of this allegation, which standing alone, of course, proves nothing. The only possible question is, where does the burden of proof lie as to the similarity or dissimilarity of the appellant's secret process (if, indeed, he has any secret process at all) and that of the appellee? Must the latter prove affirmatively, in order to succeed, inasmuch as he manufactures his pills under a secret formula, that the appellant's pills are not manufactured under that formula, or must the latter assume the burden of proof in this regard and justify his admitted piracy of the appellee's trade name by showing that the formulae followed by both are similar and that he came to a knowledge of the same in good faith? It is admitted that the latter rule is the correct one and the only one that in equity can be applied to a case like this.

The appellee's right to relief does not depend in any way upon the fact of his goods being manufactured under a secret process. That is surplusage, so far as this case is concerned. His right to relief depends simply upon the fact of the appellant's manufacturing and selling goods similar to his and calling them by his trade name. Assuming, under the foregoing cases, that the appellant might justify his conduct by showing that he used the same formula as the appellee, having acquired his knowledge thereof in good faith, and that the name used by the latter had come to designate in the public mind goods made under this formula, it is submitted that this is purely a matter of defense, the burden of proof with respect to which rests with the defendant and not with the complainant.

It surely is not incumbent on a complainant as a part of his case to prove the negative of every defense which ingenuity may conceive or suggest, yet such a rule must be adopted if the Court is to sustain the appellant's contention. The appellant would surely not be heard to contend that if an answer contained allegations of alleged fraud on the part of a complainant such as, if true, prevented him from obtaining relief in a court of equity, and no evidence were introduced tending to substantiate those allegations, the complainant could not succeed because he had not affirmatively disproved them as a part of his case. Yet that is the principle of law for which the appellant is really contending, for the claim as to alleged similarity of formulae, etc., is as much a matter of defense as a claim of alleged fraud on the complainant's part.

There is no less a right on the part of a manufacturer of goods made under a secret process or formula to protection of his trade name than on the part of an ordinary manufacturer of goods. Granting, in the former case, that a third party may, within the purview of the rule laid down in the foregoing cases, justify his use of the name under certain particular circumstances, yet, if such a justification exists, the burden is upon the person asserting it to prove it rather than upon the person against whom it is asserted to disprove it in the first instance.

The rule is not that the owner of a valuable trade name cannot enjoin the manufacturer of similar goods under the same name unless he can show that such goods are manufactured under a secret process other than that used by himself, but rather that he can enjoin such use of his trade name unless the person attempting to use the same can justify his attempted use by showing similarity of secret process and good faith in the acquisition of knowledge as to the same.

Let us assume that the allegation as to the complainant's secret formula had been omitted from the bill of complaint and that the defendant had alleged by way of defense similarity of formulae and good faith on his part, and had introduced evidence to prove merely that the complainant's goods were manufactured under a secret formula without any evidence tending to show that the defendant's goods were manufactured under the same formula. In such a case it surely could not be contended successfully that the complainant would not be entitled to succeed, yet in its last analysis that is exactly the situation here presented, the proof as to the fact of the com-

plainant's manufacture under a secret formula being supplied by the bill of complaint rather than by the testimony of witnesses.

The case of *Baglin, et al., v. Cusenier Co.*, 164 Fed. Rep. 25, has been cited by the appellant as an authority to the effect that in a case such as the one at bar the burden of proof is on the complainant to show *prima facie* dissimilarity of secret process rather than on the defendant to show similarity. In that case the complainants claimed the right to the trade name "Chartreuse" and certain trade-marks, and claimed to be the owners of a certain secret process or formula under which the liqueur known as "Chartreuse" was manufactured. They sought to enjoin the defendant from using either the trade name or the trade marks and from representing that its liqueur was manufactured under the same secret formula as that used by the complainants. The Court held that the complainants were the owners of the *trade marks* in question and enjoined the defendant's use of the same. It held further that the *trade name* "Chartreuse" was something distinct and separate from the secret formula under which the liqueur was manufactured, and that, although ownership of the formula rested with the complainants, the defendant was the owner of the trade name and could not be enjoined, therefore, in its use thereof. It appeared that in the bill of complaint certain persons were charged with having made a spurious article, falsely representing that it was made pursuant to the famous recipe of the complainant's and it was alleged that the defendant had imported large quantities of this spurious article and sold the same in America. In addition to attempting



to enjoin the defendant's use of the aforesaid trade-marks and trade name, the complainant sought to enjoin the defendant's sale of goods bearing such representations as to the similarity of process. The Court held in this connection, independent of any consideration as to the ownership of the trade marks and trade name, that the gravamen of such a cause of action was the falsity of the representations as to similarity, and that the burden of proof rested with the complainant in respect thereto. Such a ruling, it is submitted, is in no wise applicable to the case at bar, where the gravamen of the action is not similarity of process but similarity of trade names. In the one case similarity is a matter of affirmative proof since the complainant's right to relief depends entirely upon it. In the other it is entirely a matter of defense.

Every principle of equity seems to compel the adoption of the rule which the appellee urges, to wit, that the burden of proof is upon the defendant in a case such as this, rather than upon the complainant. To hold otherwise is to practically rob the owner of a secret formula of any hope of continued secrecy, for if the rule for which the appellant contends be followed, no owner of a secret process can obtain any equitable relief, even to the extent of enjoining an obvious piracy of his trade name without giving to the world at large information as to his secret process. It needs no argument to show to this learned Court the abuses which would follow from the adoption of such a rule. If, in such a case, the defendant is acting in good faith and has in good faith acquired knowledge of the complainant's process or formula, he can with little difficulty and with no

possibility of harm to himself or his business, prove that the process used by him is the same as that used by the complainant.

There is not a scintilla of evidence that the defendant's pills are manufactured under any established formula whatsoever, much less under the secret formula used by the complainant. Upon the record the defendant stands convicted of a wanton piracy of the complainant's trade name, which is without any explanation whatsoever other than the defendant's greed and lack of business honesty. The argument just considered, which was not made in either of the lower courts, seems to have been conceived by the defendant in extremity, and it is difficult to believe that its application to the case at bar is seriously urged.

#### **POINT IV.**

##### **The General Merits of the Case.**

The appellant has done more than attempt the common trade piracy of another man's name; his effort can hardly be other than to extort a price under fear of general destruction to the appellee's exclusive right. The reasons for asserting this are as follows:

In the year 1904, the appellee discovered that one Minden, a druggist in New York, was putting upon the market a counterfeit of his pills. He commenced criminal proceedings in the Magistrates' Court in the City of New York, which continued through the months of October and Novem-

ber, 1904 (fols. 163-4), and which resulted in the defendants being held for trial, and upon such trial in the Court of Special Sessions of the County of New York, Minden and his confederates were convicted of counterfeiting both the trade mark and the make up itself of appellee's goods (fols. 164-5). For some reason, which the appellant nowhere seeks to explain, he was present during the hearings in Minden's case (fol. 81) and apparently in connection with the conspiracy there disclosed or as a development from it filed a statement required under the Penal Code of New York (fol. 80) stating that he intended to do business as "The Beecham Pill Company." The ingenuity of Minden's counsel had devised three defenses (fols. 165-6) all based upon the theory that Beecham could not succeed, because of alleged misstatements in his labels or circulars. These defenses were, first, that he had said he had a patent, having none (fol. 164); second, that he had said the pills were made in England, when they were not (fol. 164), and third, that he had said that they were made by Thomas Beecham, when they were made by Joseph Beecham (fol. 165). In that case these defenses were not successful, but the case was criminal where the contention was of doubtful value anyway.

But this appellant had been present at these hearings and so had heard the defenses made. He, therefore, knew what were the supposed lines of weakness of the complainant's position. During the year 1905 he began to make his pills, which have a precise similarity in appearance to the appellee's pills and to sell them in boxes of the same size as the appellee's boxes. One sale of a gross of boxes was made on January 1, 1906 (fol. 206).

The labels which he uses are, however, not the same as the appellee's. Although the color and size is nearly like that of the appellee's the lettering is different, for they bear conspicuously, his own name and address, a circumstance which with a delightful lack of humor, the appellant urges as indicative of his own superior trade honesty.

Probably Minden's conviction actuated the effort to put on a show of fair dealing, by setting forth his own name, as manufacturer. The name, "Beecham's Pills", he openly pirated, however, and used it also upon signs (fols. 207-8) as well as labels. He had likewise made a successful effort to register his label in the Copyright Office (fol. 76).

Upon detection and the bringing of this action this appellant presented precisely the same excuses which he learned from or in association with Minden (fols. 87-9), and upon the strength of which the whole enterprise was obviously based, and these are now the excuses which he urges in this case except that in the courts below he had abandoned the claim that the pills are falsely represented to be made by Thomas Beecham (fols. 88-9).

In ordinary cases of trade piracy the defendant profits by the complainant's trade; it is to his purpose to have that trade increase, for he is its parasite. Consequently, it is not his object at the outset, or, until brought to book, to attack or destroy the complainant's business. But here the whole undertaking was conceived with the possible destruction of the complainant's trademark in view, since if the appellant succeeds anyone may freely use the name "Beecham." Moreover, there was no attempt at concealment once

he had become established but he went on thereafter with every attempt at publicity. If an infringer couples his own name with a stolen *trade-mark*, his purpose may still be to profit at the expense of his competitor's business, because the effect of the mark is not destroyed by the use of the infringer's name, the sales by hypothesis being made by virtue of the mark. But when, as here, the infringer publicly and ostentatiously couples his own name with a *trade-name*, he cannot seriously suppose that he will acquire any appreciable part of the honest market which trades in the product of the person whose name he steals, because in such a case the goods are sold by virtue of the name of their supposed maker, and yet it openly appears that the real maker is not the person whose name the infringer uses. It seems clear, therefore, in this case that there was either no *bona fide*—so to speak—effort by the appellant actually to make profit for himself by his theft of the name "Beecham", or else that he expected to trade on the ignorance or guilt of possible buyers.

But, in either event, the appellee's business was none the less imperiled, because the undisturbed existence of "Jacob's Beecham Pills" was public notice to any one interested that the name was public property. While, therefore, the appellant invited attack, he had little or nothing to gain, and the appellee had very much to lose, if the appellant were successful. The scheme has then no sufficient explanation in an effort at trade piracy; it can only be understood to be a very deliberate and well-planned effort to extort something from the appellee as the price of withdrawal. Whether the appellant has been alone in it

or whether he was or is connected with Minden, in whose trial he was certainly interested, cannot be known, but the appellee insists that the only reasonable inference from the record is that he is being subjected to a persistent effort at extortion, in the hope that he may be either frightened into payment, or, in the event of defeat, compelled to adjust with the appellant the price for no further publicity.

We submit that the whole thing is thus contained in a nutshell, and that it is the only reasonable inference from the facts in the record. Thomas, J., understood the situation admirably well when he said in deciding the case upon the application for an injunction *pendente lite* (fol. 322) "The defendant's use of the word 'Beecham' is both conscienceless and illegal, and his effort to avoid the consequence of his tortious appropriation of the word by alleging fraudulent misrepresentation to the public by the complainant has no just foundation."

#### **POINT V.**

**The decree should be affirmed.**

Dated, New York City, March 11th, 1911.

Respectfully submitted,

JOHN L. WILKIE,  
Counsel for Appellee,  
2 Wall Street.  
New York City.

IN THE SUPREME COURT OF THE UNITED  
STATES.

OCTOBER TERM, 1908.

Number 702.

MARK JACOBS,  
Appellant,

AGAINST

JOSEPH BEECHAM,  
Appellee.

Comes now the Appellee herein by Charles W. Gould, his counsel, appearing in that behalf, and moves the Court to dismiss the appeal in the above cause for want of jurisdiction, because the decree from which the said appeal purports to have been taken is the decree of the Circuit Court of Appeals for the Second Circuit, in a cause in which the jurisdiction of the Court below depended solely on diversity of citizenship and did not involve the Constitution or any law of the United States.

And the said appellee by his counsel as aforesaid also moves the Court in the alternative to affirm the said decree from which the said appeal purports to be taken on the ground that the question on which the jurisdiction depends is so frivolous as not to need further argument.

CHARLES W. GOULD,  
Counsel for Appellee,  
for the purpose of these motions.

IN THE SUPREME COURT OF THE UNITED  
STATES,

OCTOBER TERM, 1908,

Number 702.

MARK JACOBS,  
Appellant,

AGAINST

JOSEPH BEECHAM,  
Appellee.

To MAX J. KOHLER, Esq., Counsel for Appellant.

Please take notice that on the 5th day of April, 1909, at the opening of Court or as soon thereafter as counsel can be heard, the motions of which the foregoing are copies, will be submitted to the Supreme Court of the United States for the decision of the Court thereon.

Annexed hereto is a copy of the brief of argument to be submitted with the said motions in support thereof.

March 13th, 1909.

CHARLES W. GOULD,  
Counsel for Appellee,  
for the purpose of this motion.



IN THE SUPREME COURT OF THE  
UNITED STATES,

October Term, 1908,

Number 702.

MARK JACOBS,  
Appellant,

AGAINST

JOSEPH BEECHAM,  
Appellee.

**Facts.**

The appeal is from a decree of the Circuit Court of Appeals for the Second Circuit, affirming a decision of the Circuit Court for the Eastern District of New York. The suit was to forbid the defendant from using the words "Beecham's Pills" on any boxes of pills manufactured or sold by him, and from colourably imitating the complainant's "make-up," (fols. 35-38).

The defendant claims jurisdiction in this Court for this appeal solely because of the sixth and seventh articles of the bill (fols. 11-13). In these it is alleged that the complainant and his father with whom he was then in partnership, for three years prior to the 23rd day of August, 1887, had been engaged in shipping his pills from Great Britain to this country, and that on the said 23rd day of August, 1887, the complainant's father, Thomas Beecham, on behalf of himself and the complainant, procured a registration of the words

"Beecham's Pills" as a trade-mark, under the Act of Congress.

This allegation was controverted in the answer, (fols. 63-64), and the complainant abandoned it and failed to put in any proof upon the subject. At the close of the complainant's testimony taken before the Special Examiner, the defendant offered in evidence the record of registration of the trade-mark "Beecham's Pills," from the patent office (fol. 210), but this record was never printed upon the final hearing in the Circuit Court or in the transcript to the Circuit Court of Appeals, and it does not appear in the transcript before this Court, as it could not.

The bill contains no allegation that the defendant's user of the mark was in foreign commerce or in commerce with the Indian tribes, and the eighth and twenty-second exceptions in the bill of exceptions (pages 91 and 92), are directed to this very defect as a reason calling for reversal.

The bill does, however, contain the proper allegations of diverse citizenship (fol. 4), and of the amount in controversy (fol. 32), so that a claim of jurisdiction upon that ground appears in the transcript.

The question of jurisdiction is at once raised, therefore, in the fact that the bill does not contain the necessary allegations to invoke the jurisdiction of the Circuit Court under the Act of Congress regulating trade-marks, but does contain adequate allegations of diverse citizenship. The appellant bases his appeal upon the rule in *Warner v. Searles & Hereth Co.*, 191 U. S., 195, that this Court will not dismiss the appeal when any allegation of a registration of the trade-mark appears in the bill. The appellee bases his motion to dismiss upon distinguishing the cause at bar from *Warner v. Searles & Hereth Co.*, *supra*, because al-

though registration was alleged in the bill, no proof of the registration appears in the transcript, and he bases his motion in the alternative to affirm upon the ground that even if the proper course be not to dismiss the appeal, still the question upon which jurisdiction depends is so frivolous as not to need further argument, under the Sixth Rule, subdivision five, of this Court.

This brief will first show that this Court can have no jurisdiction to review any question in the cause, and will then take up whether that question can be raised upon these motions.

## I.

### **This Court has no jurisdiction to review the determination of the Circuit Court of Appeals.**

That the jurisdiction of the Courts below depended solely upon diverse citizenship appears from two considerations; first, that the bill contained no allegations that the defendant used the mark in foreign commerce or commerce with the Indian Tribes; and second, that there was no proof either at the hearing before the Circuit Court, or upon the appeal to the Circuit Court of Appeals, of the registration of the mark, since that registration was not a part of the printed testimony before the Circuit Court, or of the transcript to the Circuit Court of Appeals.

By failing to print his testimony the defendant prevented the Circuit Court and the Circuit Court of Appeals from examining the record of registration. Without some scrutiny of that

document, they could not have based their jurisdiction upon the Act of Congress, since the unsupported allegation of registration in the bill would not serve, not being admitted in the answer (fol. 64). Therefore, it is clear that the Courts below could not have properly assumed jurisdiction under the Act, because the bill, if alone considered, was fatally defective in its allegations; and because the proofs, if they be considered, were defective in the same respects as the bill, and in addition in that fact by virtue of the allegation of which alone the bill may be said to invoke jurisdiction under the Act of Congress. Nor could the Courts below have waived the failure to prove registration, relying on the estoppel of the allegation in the bill, because no jurisdiction can arise from estoppel.

Therefore, it is clear that as matter of substance the Courts below had no jurisdiction under the Act. This is, of course, a different question from whether the bill invoked jurisdiction under the Act of Congress in such sense that a motion to dismiss will not lie. At present the question considered is simply whether this Court can have any substantial jurisdiction in the cause, not whether the appeal will be dismissed.

The absence of jurisdiction under the Act of Congress might require an inquiry into the transcript to see whether the decree should not be reversed for lack of jurisdiction, were it not that the transcript shows that the jurisdiction of the Circuit Court was justified by the allegation and proof of diverse citizenship. The allegations in the bill of diverse citizenship and of the amount in controversy, were regular, (fols. 4, 32), and the proof was sufficient, partly by admission in the answer, (fol. 51), partly by proof taken before the commissioner, (fols. 153, 154), and partly by

stipulation, (fol. 171). Moreover, the bill of exceptions does not contain any exception to the jurisdiction of the court on the ground of diverse citizenship, (pages 91 & 92).

The cause was therefore one in which the Circuit Court could have had no jurisdiction under the Act of Congress, and did have jurisdiction by reason of diverse citizenship. Therefore, even had the Circuit Court misconceived the basis of its jurisdiction, which was not the fact, it would not on that account have been actually without jurisdiction and this Court cannot reverse the decree on the ground that it was granted *non coram judice*.

This being true, this Court has nothing to review, being without appellate jurisdiction in a cause involving only diverse citizenship, and the only question which can remain is whether that defect can be raised by these motions, or must await a full hearing and argument.

## II.

**The defect of jurisdiction may be raised by motions to dismiss, or to affirm.**

If the Circuit Court of Appeals had jurisdiction *only* through diversity of citizenship, it is well settled that this Court will dismiss the appeal.

Colorado Central Mining Co. *v.* Turek,  
150 U. S., 138.

This case has been followed so often, that no other authorities are necessary, but to dismiss the appeal it is doubtless necessary that the jurisdic-

tion should depend *solely* upon diversity of citizenship.

Northern Pacific Railway Co. v. Soderberg, 188 U. S., 526.

In Warner v. Searles & Hereth Co., 191 U. S., 195, this Court declined to dismiss an appeal in which the bill failed to allege that the defendant had used the mark in foreign commerce or commerce with the Indian tribes. The Court did however, affirm the decree, though not on a motion such as this. That was a case in which, there was proof of registration under the Act of Congress, which proof is missing here. It was not held in that case that the mere allegation of registration in the bill, unsupported by any proof whatever upon the hearing, would have been enough to invoke successfully the jurisdiction of this Court.

But even if the question be determined only upon the allegations of the bill, they do not go far enough to show that the complainant meant to invoke the jurisdiction of the Circuit Court by reason of the Act of Congress. It is true that the bill alleges registration of the mark (fols. 11-13), but that allegation was important as marking the date of the beginning of the complainant's claim of user and was by no means necessarily a claim of jurisdiction under the Act. Nowhere else in the bill is the registration referred to and nowhere in the bill does it claim jurisdiction under the Act. Moreover, in no part of the record is it suggested that the jurisdiction of the Court depended upon a registration of the mark. We insist, therefore, that the mere allegation of registration without any indication that it was the basis of the jurisdiction invoked, is not even the kind of allegation contemplated in Warner v. Searles & Hereth Co.,

*supra*, as being sufficient to defeat a motion to dismiss, though concededly it is substantially insufficient to give this Court anything to review.

Be that as it may, it is indifferent to the determination of these motions whether the appeal be dismissed, or the decree affirmed, provided that the Court can at once see upon scrutiny of the transcript that there is no question open for it to review in the cause. In such a case the question on which jurisdiction depends is so frivolous as not to need further argument, and a motion to affirm is proper under the Sixth Supreme Court Rule, subdivision five. Such is the fact here, if the analysis be correct under Point I, and such is the basis of this motion.

If the precedent still be the law that for a motion to affirm, there must be color for a motion to dismiss,

Whitney *v.* Cook, 99 U. S., 107,  
School District *v.* Hall, 106 U. S., 429,  
The Alaska, 130 U. S., 201,

still in this case there is such color, as we have already shown. On the other hand, the more recent authorities seem to have abandoned the rule that there must be some color for dismissal.

Chanute City *v.* Trader, 132 U. S., 210,  
Belmont Bridge *v.* Wheeling Bridge, 138  
U. S., 287.  
Blythe *v.* Hinkley, 180 U. S., 313,  
Equitable Life Assurance Society *v.*  
Brown, 187 U. S., 308.

We therefore respectfully submit that one of either motions be granted, and that the Court either dismiss the appeal on the ground that this cause is distinguishable from Warner *v.*

Searles & Hereth Co., *supra*; or that it affirm the decree upon the ground that the question of jurisdiction is frivolous.

March 13th, 1909.

Respectfully submitted,

CHARLES W. GOULD,

Counsel for Appellee,

Joseph Beecham.



APR 8 1909

JAMES H. McKENNEY,

# Supreme Court of the United States

MARK JACOBS,  
*Appellant-Defendant,*

*against*

JOSEPH BEECHAM,  
*Complainant-Respondent.*

OCTOBER TERM, 1908

No. ~~843~~

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## Appellant's Brief in Opposition to Motion to Dismiss or Affirm.

MAX J. KOHLER,  
*Of Counsel for Appellant-Defendant.*



# SUPREME COURT OF THE UNITED STATES.

MARK JACOBS,  
Appellant-Defendant,

*against*

JOSEPH BEECHAM,  
Complainant-Respondent,

October Term,  
1908,  
No. 702.

## **Appellant's Brief in Opposition to Motion to Dismiss or Affirm.**

This cause is here on appeal to review the judgment and decree of the United States Circuit Court of Appeals for the Second Circuit, affirming the final decree of the United States Circuit Court for the Eastern District, enjoining defendant-appellant from employing the word "Beecham" in any way in connection with pills sold by defendant (Transcript of Record, pp. 81-2). Complainant sued defendant for alleged infringement of trade-mark, the jurisdiction of the Circuit Court being dependent both upon diversity of citizenship, by reason of complainant's alienage, and upon the federal statute authorizing registration of certain trade-marks, both of which are pleaded in the bill of complaint (Transcript of Record, pp. 1, 3-4). As the determination of the Circuit Court of Appeals was made in a cause in which juris-

diction was not "dependent entirely upon the opposite parties to the suit or controversy being aliens and citizens of the United States or citizens of different States," nor other enumerated ground of exclusive jurisdiction, defendant seasonably sued out this appeal under Section 6 of the Act of March 3rd, 1891, to review the judgment of the Circuit Court of Appeals (Transcript, pp. 89-90). Complainant-respondent now challenges the jurisdiction of this Court by motion to dismiss, coupling with the motion, a motion to affirm. More than \$1000. is concededly involved (Record, pp. 8, 43).

## I.

### **This Court clearly has jurisdiction of this cause under Section 6 of the Act of March 3rd, 1891.**

The bill of complaint charges an infringement of complainant's alleged trade-mark "Beecham's Pills" (Record, pp. 2-4), defendant being charged with describing the articles sold by defendant as "Beecham Pills, manufactured and sold by Mark Jacobs, Maspeth, L. I., N. Y., U. S. A." (Record, p. 5). Besides alleging complainant's alienage by reason of citizenship and residence in England and defendant's New York residence and citizenship (Record, p. 1), the Bill of Complaint contains allegations of an alleged right under, and defendant's violation of, the Federal Trade Mark Act by reason of complainant's registration on August 23rd, 1887, of said trade-mark under the Act

of Congress; this, in addition to his alleged common law rights. Paragraph Seventh of the Bill of Complaint reads as follows:

*“Seventh.—That on said 23rd day of August, 1887, the said Thomas Beecham, on behalf of the firm, consisting of himself and your orator, and in accordance with the Act of Congress in that case made and provided, upon due application therefore duly procured the registration as a trade-mark under the said Act of the words ‘Beecham’s Pills.’ ”*

In the preceding paragraph sixth of the bill of complaint, allegations are made as to complainant and his father being located in England on August 23rd, 1887, and having been engaged for three years previously in shipping the aforesaid pills from Great Britain to the United States, and as to Great Britain being then a country affording to citizens of the United States

*“similar privileges of registering trade-marks to those afforded at that time in the United States to citizens of other countries.”*

At this date of registration, in 1887, the Act of March 3rd, 1881, entitled “An Act to authorize the registration of trade-marks and protect the same” (21 Stat. 502, ch. 138) was in force, being the statute considered by this Court in

*Warner v. Searle & Hereth Co.*, 191  
U. S., 195;

and this is, of course, the “Act of Congress” referred to in paragraph seventh of this bill of complaint, and the allegations of paragraph 6 follow the language of Section 1 of said Act of March

3rd, 1881. Section 7 of that Act, copied in full in the opinion in the Warner case, gives a right of action in equity for infringement of a trade-mark registered under this act, and a cause of action under this Act was clearly intended to be set forth in the bill of complaint herein, as well as one under general equitable principles.

This is further indicated by the allegation in paragraph Eighth of the bill of the assignment from Thomas Beecham to complainant in 1895 of

“his entire interest and title in and to all the property possessed or owned by the said partnership, including all his right, title and interest to the use of *the said trade-mark ‘Beecham’s Pills’ both at common law and under the aforesaid statute*” (Record, p. 4).

In all the subsequent paragraphs of the bill a violation by defendant is charged in plaintiff’s trade-mark, which, as just seen, complainant claimed at common law and under this Act of March 3rd, 1881. The bill clearly relied upon a trade-mark both at common law and under the Act of 1881, and it is obvious that the allegations as to federal registration were inserted for that purpose and would have had no significance “as marking the date of the beginning of complainants’ claim of user,” which began many decades previously.

The decision of this Court in

Warner *vs.* Searle & Hereth Co.,  
*supra*,

clearly and unmistakably establishes the jurisdiction of this Court in such a case, to review the

determination of the Circuit Court of Appeals, despite the inadequacy of the attempt to set up a cause of action under the trade-mark act, in the bill, the cause being one in which jurisdiction was not "dependent entirely upon the opposite parties to the suit being aliens and citizens," but being invoked in part under the Act of March 3rd, 1881, as to Trade-Marks. It is absolutely controlling here. In *Warner vs. Searle & Hereth Co., supra*, Chief Justice Fuller, in delivering the opinion of the Court, said (pp. 205-206):

"In the present case, diverse citizenship and requisite amount existed, and the Circuit Court, therefore, had jurisdiction, but it is argued that the jurisdiction depended entirely on diversity of citizenship, and hence that the decision of the Circuit Court of Appeals was final. *We think, however, that as infringement of a trade-mark registered under the act was charged, the averments of the bill, though quite defective, were sufficient to invoke the jurisdiction also on the ground that the case arose under a law of the United States, and will not therefore dismiss the appeal.*"

The allegations of the bill with respect to registration of the trade-mark in the Warner case were almost absolutely identical in character with those here involved, and cannot be distinguished. They are set forth in the "Statement of the Case," prepared by the Chief Justice, as follows:

"(p. 195) That on December 26th, 1882, complainant registered said trade-mark in the Patent Office, and obtained a certificate of registration according to law, a copy of which certificate and accompanying statement and declaration was attached."

It does not appear necessary to do more than to refer to this recent determination as fatal to the motion to dismiss this appeal. The Warner case decision was in line with the decisions in

Union Pacific R. R. Co. *vs.* Harris,  
158 U. S., 326, 327-8;

Sonnentheil *vs.* Morelen Co., 172 U.  
S., 401, 404-5;

Howard *vs.* United States, 184 U. S.,  
676, 680-1;

No. Pac. Ry. Co. *vs.* Soderberg, 188  
U. S., 526, 528.

Respondent seeks to distinguish the Warner case on specified grounds which are wholly untenable. He urges that a cause of action is not pleaded under the Trade-Mark Act, because the bill does not *adequately* set forth all requisite matter under that Act, a point conceded also in the Warner case, but there held to be immaterial.

An elaborate argument is also attempted (Brief, p. 5 *et seq.*), to the effect that the Trade-Mark Act Registration was not relied upon, because complainant did not offer proof in support thereof, and that the registration papers concededly offered by defendant and received in evidence without objections (Record, p. 53) were not printed in the records in the Circuit Court or Circuit Court of Appeals. Respondent overlooks the well-settled line of decisions handed down by this Court, however, that the allegations of the *complaint* govern, in determining the grounds on which the jurisdiction of this Court under Section 6 of the Act of March 3rd, 1891, arises, and subsequent pleadings and proceedings cannot enlarge or curtail the same (Borgmeyer *vs.* Idler, 159 U. S. 408,



Ex. p. Jones, 164 U. S., 691). As to the non-printing of this Exhibit B, that is quite immaterial, as the exhibit was sufficiently described in the Record, after being received in evidence, without objections. The Record unmistakably refers to it as follows (page 53):

“*Mr. Goldzier.*—I offer in evidence record from the Patent Office regarding the registration of trade-mark of Thomas Beecham, filed on August 23rd, 1887. Received in evidence and marked Defendant’s Exhibit B.”

The bill of complaint, moreover, avers the registration (p. 4). Besides, the exhibit was in fact handed up to the Court on the argument of the appeal in the United States Circuit Court of Appeals by Mr. Von Briesen, counsel for appellant, and, if desired, can still be secured in the ordinary way by respondent by *certiorari* for diminution of the record, or stipulation (*Morgan vs. Curtenius*, 19 Howard 8, Rule XIV). The ordinary rule, of course, governs, that exhibits need not be printed in full which are adequately described in the Record (*Rev. St.* 698; *Nashua Corp. vs. Boston Corp.* 61 F. R. 237 (C. C. A.), *Union Pac. R. Co. vs. Stewart*, 95 U. S. 279; *Ball Co. vs. Kraetzer*, 150 U. S. 111, 118).

On the other hand, appellant’s Answer and Assignments of Error, both in the lower Court (Record, p. 83, Nos. 5 and 8) and here (Record, pp. 90-1, Nos. 5, 8), raise questions under the Trade-Mark Registration Act. The motion to dismiss for want of jurisdiction should be denied.

## POINT II.

**The motion to affirm should be denied, because made without color of right, and because important and serious questions of law are presented by this Record.**

1. In the face of the decision of this Court in the Warner case, the motion to dismiss is, it is submitted, not even arguable, and hence the motion to affirm is made without color of right, and should not be entertained.

Rule VI, par. 5.

Whitney *vs.* Cook, 99 U. S., 607;

School District *vs.* Hall, 106 U. S.,  
429;

Davis *vs.* Corbin, 113 U. S., 687.

## II.

On the merits, which are before this Court for consideration on the motion to dismiss the appeal,—as the whole case is, of course, before the Court, under Section 6 of the Act of March 3rd, 1891, if it has jurisdiction of the appeal (Union Pac. Ry. Co. *vs.* Harris (*supra*), Sonnenheil *vs.* Moerlein Co. (*supra*), Howard *vs.* U. S. (*supra*), and the unmistakable language of the last paragraph of Section 6 of the Act of March 3rd, 1891, granting right to “*review of the case*” in such classes of cases; compare Burton *vs.* U. S., 196 U. S., 282; Williamson *vs.* U. S., 207 U. S., 425)—it will suffice to refer to three important assignments of error presented by this case:

1. Complainant concededly deals in a proprietary medicine, known by the name "Beecham's Patent Pills," and any one not standing in a fiduciary relation to complainant has a right to make these pills without his consent, upon discovering the secret process pursuant to which they are made, and to designate them by the name by which they are known, provided care is taken to indicate that they were made by such third person, which was specifically done here. Such name is descriptive merely, and cannot become a valid trade-mark. The Circuit Court of Appeals based its decision herein specifically on the fact that the article here involved is such "proprietary medicine," made under the Beecham unpatented process.

2. Complainant was not entitled to equitable relief, because it did not come into equity with clean hands, having falsely and fraudulently represented these pills to be patented, when they are not so in fact.

3. Complainant also falsely represented his pills as being manufactured in England, when in fact they are being made in New York.

Before taking up these questions for consideration, a somewhat fuller consideration of the facts is in order. Complainant himself in his bill of complaint avers:

"That these pills are made for human use in accordance with a certain secret formula, which is the property of your orator, and that they are of the class known generally as proprietary or patent medicines" (Record, p. 2).

Also (Record, pp. 2-3):

"That the said pills have become very widely known to the public throughout this

country by the name of 'Beecham's Pills,' and have never been known by any other. That the name 'Beecham's Pills' has, moreover, been used exclusively to designate such pills in this country."

Also (Record, p. 8):

"Your orator asserts that his pills are of the kind of medicine known as proprietary, or patent, medicine, which terms in no sense indicate, or are intended to indicate, that the composition so designated is made under Letters Patent, and he further asserts that the word when used to denote such a medicine is not understood to indicate that the medicine is patented."

Complainant further alleges (Record, p. 4):

"That the said name 'Beecham's Pills' was the first applied to any pills or to any medicinal or other article by your orator's father, Thomas Beecham, more than fifty (50) years ago, at the time when he first manufactured and sold the same."

Complainant himself, in his bill of complaint (page 3), sets forth that he labels his pills "Beecham's Patent Pills, St. Helens' Lancashire," and Exhibit A of the complaint, received in evidence as Complainant's Exhibits IV and V, and printed in the record (pp. 63-64), shows expressly that complainant describes his pills as "Patent" and associates the words "St. Helens, Lancashire, England," with them, together with the words "Sold by the Proprietor," and that the accompanying circular, Exhibit 7 (Record, pp. 37, 65), describes "St. Helens, Lancashire, England," as said proprietor's address, and "365 Canal

Street, New York," as merely a "U. S. A. Depot." The same circular, at the end thereof further falsely represents British manufacture in the phrase:

"The pills accompanying this pamphlet are expressly packed for U. S. America," obviously lending further support to the false representation that they are made in England.

In Exhibit III (Record, p. 71) it is further averred for the same purpose: "These Pills being Specially put up for the American Market, no English Revenue Stamp is required."

On the trial, complainant in fact in terms (Record, p. 53) conceded "that he has no patent in connection with the pills."

His own witness testified that they are made in America, and that they ceased importing them as far back as 1888 (Record, pp. 33, 40, 52).

Complainant's own circulars show that he has been claiming this monopoly of sale under his secret process for over fifty years, far exceeding the duration of any possible patent (see pages 65, 66), and this suit is an effort to secure judicial sanction for this unauthorized, self-created monopoly *as a property right*.

It will be observed that the bill of complaint itself sets forth that defendant labels his pills unmistakably so as to show that he himself, and not Beecham, manufactures and sells them, his description being (Record, p. 5):

"Beecham (price 25 cents) Pills, manufactured and sold by Mark Jacobs, Maspeth, L. I., N. Y., U. S. A." It is submitted under authoritative decision that defendant clearly has a right to manufacture these pills, despite complainant's attempted monopoly in his secret process, and that

this right under the authorities carries with it a right to describe them under the name by which they are known. Moreover, despite allegations in the bill of complaint as to unfair competition, which were not proved, the final decree here appealed from enjoined defendant simply from using the name "Beecham" (Record, pp. 81-2), so that this appeal involves purely and simply the question whether the name of an unpatented medicine made under an alleged secret process may not be employed by a rival, manufacturing the same article; defendant's right to manufacture the article, apart from naming it, was not denied by the Court. Defendant has been enjoined absolutely from calling these pills by their name. In dealing with complainant's representation of his pills in describing them by the name "Beecham's Patent Pills," the Circuit Court of Appeals uses language also clearly sustaining defendant's right upon this view of the case to use the words "Beecham's Pills" in the following passage (Record, p. 86):

"The natural inference is that the pills are made according to Beecham's secret formula."

In addition, the further points arise as to whether complainant is entitled to equitable relief, despite his false and fraudulent representations as to the articles being patented, and as to manufacture in England. The Assignment of Errors raise also other serious questions (Record, pp. 90-92).

## POINT III.

**The owner of a secret process, unpatented, cannot acquire any monopoly in the right to the process or the use of the name he designates the article by, except as against one standing in a fiduciary relationship to him, and no valid trade-mark can be acquired in such a descriptive name.**

Strangely enough, the important question of the right of the proprietor of an unpatented secret process to a monopoly in the process itself, or in the name by which he calls the article, seems never before this to have been before this Court for determination, though authoritative decisions in our State Courts and in England deny the right on sound principles of law. The leading case on the subject is reported as

*Chadwick vs. Covell*, 151 Mass., 190,

Mr. Justice Holmes delivering the opinion of the Court in denial of the rights asserted. To the same effect are

*Watkins vs. London*, 52 Minn., 389;  
*Marshall vs. Pinkham*, 52 Wisc., 572;  
*Hartman vs. Park & Sons Co.*, 153  
 F. R., 24, 29, 33 (C. C. A.);  
*Conham vs. Jones*, 2 Veasey &  
 Beames, 218 ("Velno's Vegetable  
 Syrup");

James *vs.* James, L. R., 13 Eq., 421  
 ("Lt. James' Horse Blister");  
 Condry *vs.* Mitchell, 37 Law Times,  
 N. S., 766, 268 ("Condry's Fluid");  
 Tabor *vs.* Hoffman, 118 N. Y., 30, 36;  
 Baglin *vs.* Cusenier Co., 141 F. R.,  
 497, 164 F. R., 25 (C. C. A.),  
 ("Chartreuse").

In Chadwick *vs.* Covell (*supra*), Mr. Justice Holmes, in denying an exclusive claim to manufacture certain medicines made under a secret process and to call them by the name given to them by the original discoverer, "Dr. Spencer's Queen of Pain," said:

"So far as the right to manufacture and sell the medicine goes, the plaintiff's case may be disposed of in a few words. Dr. Spencer had no exclusive right to the use of his formulas. His only right was to prevent any one from obtaining or using them through a breach of trust or contract. *Any one who came honestly to the knowledge of them could use them, without Dr. Spencer's permission and against his will. Having the right to make and sell the medicines, the defendant has the right to signify to the public that the medicines are made according to the formulas used by Dr. Spencer. \* \* \** The only significance of Dr. Spencer's marks at the present time, by whomsoever used, is to indicate a class of goods which any one who knows how to do it may lawfully manufacture. \* \* \*

We are of opinion that, assuming that there was a gift to the plaintiff otherwise valid, of Dr. Spencer's trade-marks, it did not give her the right to prevent the defendant from using the same words and devices."



Justice Holmes, in the course of his opinion, further said:

“Unless, therefore, it should be held that a trade-mark may be erected into a new species of property, capable of lasting as long as the world does and certain goods are manufactured, and of being transferred for value or by gift from person to person, irrespective of good will, special right to make the goods, place of manufacture or fraud of any kind upon the public, the plaintiff cannot prevail.”

In *Watkins vs. London, supra*, the Supreme Court of Minnesota expressed similar views, holding that the transferee of the inventor of a secret medicinal preparation, not patented, called “Dr. Ward’s Liniment,” could acquire no monopoly to the right to manufacture the article, where there was no breach of confidence or good faith, nor acquire a sole right to the name. Said the Court:

“This preparation never having been patented, and Sands, and through him, these defendants, having lawfully and fairly acquired knowledge of its composition, they have the legal right to manufacture and sell it, following Ward’s formula. \* \* \* They may, too, by label or otherwise, publish the truth that their compound is made in accordance with Ward’s formula; that this may be by a formal statement to that effect, or by more brief terms of similar import, such as those which, by the decision under review, the defendants are permitted to employ, viz., ‘*Dr. Ward’s Liniment, Manufactured and Sold by London & Burchard.*’ ”

After commenting upon the extensive manufacture and sale of the article under the name of “Dr. Ward’s Liniment,” and “to the popular as-

sociation of that name with the remedy," the Court added:

*"The name had thus practically come to be one DESCRIPTIVE of this preparation and having acquired that quality, the plaintiff had no right to withdraw it from further use by Sands or by any other person who might lawfully manufacture the same liniment, and appropriate it to his own exclusive use, so as to give him a practical monopoly in the sale of the preparation which he had no exclusive right to make or sell. Canal Co. vs. Clark, 13 Wall., 311; Stachelberg vs. Ponce, 128 U. S., 686; VanBeil vs. Prescott, 82 N. Y., 630; Marshall vs. Pinkham, 52 Wisc., 572."*

In *Marshall vs. Pinkham*, *supra*, the Supreme Court of Wisconsin made the same ruling, after an exhaustive review of the authorities, as to "Marshall's Rheumatic Liniment," holding that there was no monopoly in the secret process, and the name could not be protected as a trade-mark therefore.

Nothing in any way inconsistent with these and the other authorities cited was held by this Court in

*Fowle vs. Park*, 131 U. S., 88,

where use of a secret patent formula was enjoined on the part of one who acquired knowledge of it in confidence, the fiduciary relationship being the ground of the determination. The principle of that decision is well stated and reconciled with *Chadwick vs. Covell* by the Circuit Court of Appeals for the Sixth Circuit in

*Park & Sons Co. vs. Hartman*, 153 F. R., 24, at 29, 32-3,

where the cases are summarized as follows:

“A trade secret or medical formula protects its owner only against those who acquire it under a confidential obligation to guard against disclosure, and as we have already seen, one is free, not only to use the process or formula, if discovered by skill and investigation without breach of trust, *but to make and sell the thing or preparation as made by the process or formula of the original discoverer, if that be the truth.*”

In *Baglin vs. Cusenier Co.*, 164 Fed. Rep., 25 at 28, involving Chartreuse, the Circuit Court of Appeals for the Second Circuit just held that the burden is on complainant in such a case, to show that defendant's article is not substantially like his own. There is no evidence whatever to that effect here.

Already in *Chadwick vs. Covell*, *supra*, the analogy was recognized of the right claimed to turn the name of a proprietary medicine made pursuant to an unpatented secret process, into a trade-mark, to the *cases of attempted use as a trade-mark of the name of an expired patent*. Since then, this Court has of course authoritatively determined that, after expiration of a patent, the patentee cannot retain exclusive right to his name as a trade-mark in describing the article, patent to which has expired.

*Singer Co. vs. June Co.*, 163 U. S.,  
169.

See also

*Merriam Co. vs. Ogilvie*, 153 F. R.,  
638,

as to an expired copyright. It is submitted that these decisions are directly controlling here, complainant here even claiming a right in perpetuity, already enjoyed over fifty years, and not merely to preserve a monopoly for the life of a patent.

It is accordingly submitted that no valid trade-mark can be acquired in the name of this unpatented "proprietary medicine," and that the proof shows that the name "Beecham's Pills" has become *descriptive* of these pills merely, which in fact, according to the bill itself and inspection, had no other trade or popular name even. These points were duly raised below (Answer, pp. 18-19; Assignment of Errors, p. 83, Third, Fourth, Tenth, Eleventh, Twelfth and Sixteenth; and pages 90-2, *Idem.*, and No. 21).

#### POINT IV.

**Complainant's false assertion on his labels and circulars that his pills are patented disentitles him to equitable relief.**

The following authorities seem to cover the situation:

Consolidated *v.* Dorflinger, 6 Fed. Cas. No. 3129:

"Another objection to the complainants' bill does not admit in reason of the same answer. This objection is, that no title can be successfully asserted in a trade-mark which

is of a tendency to mislead or deceive the public. This objection may avail a defendant, notwithstanding what would otherwise be imputable to him as misconduct. The doctrine is, that the complainant must come into a court of equity with clean hands (4 De Gex. J. & S., 149). \* \* \* *The direct application of the objection appears when we consider that the alleged trade-mark in question tends rationally to induce a belief that the subject of it is a securely patented invention to Mason.* \* \* \* Thus Vice-Chancellor Wood, afterwards Lord Hatherley, in 1853, intimated an opinion that the trade-mark would be invalid where no patent had ever existed (*Flavel v. Harrison*, 10 Hare, 467). \* \* \*

But such doubt or hesitations were removed in England by the case of *Leather Cloth Co. v. American Leather Cloth Co.* (in the House of Lords in 1865), 11 H. L., Case 523, affirming a decree made by Lord Chancellor Westbury in 1863. 4 De Gex. J. & S., 137. In this case Lord Kingsdown said:

‘If a trade-mark represents an article as protected by a patent, when in fact it is not so protected, it seems to me that such a statement *prima facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the trade-mark to relief in a court of equity against any one who pirated it.

The question here presented was also directly considered by this Court in

*Holzapfels Co. v. Rathjens Co.*, 183  
U. S., p. 1,

where it was held (page 8):

“We are of opinion that no valid trade-mark was proved on the part of the Rahtjens

in connection with the paint sent by them from Germany to their agents in the United States prior to 1873, when they procured a patent in England for their composition. It appears from the record that from 1870 to 1879, or late in 1878, the paint was manufactured in Germany by Rahtjen and sent to the United States in casks or packages marked 'Rahtjens Patent Composition Paint.'

Prior to November, 1873, the article was not patented anywhere, and *a description of it as a patented article had no basis in fact, and was a false statement tending to deceive a purchaser of the article. No right to a trade-mark which includes the word 'Patent' and which describes the article as 'Patented' can arise when there is and has been no patent; nor is the claim a valid one for the other words used, where it is based upon their use in connection with that word. A symbol or label claimed as a trade-mark, so constituted or worded as to make or contain a distinct assertion which is false will not be recognized, nor can any right to its exclusive use be maintained."*

In *Singer Mfg. Co. v. June Mfg. Co.* 163 U. S., 169, 188, this Court approvingly quotes *Fairbanks v. Jacobus*, 14 Blatchford, 337, as follows:

"Certainly, if the words 'Fairbanks' patent' do not mean to assert the existence of a patent securing the scales but only that they are made in conformity with and embody the invention of, the expired 'Fairbanks' patent,' they are free to all the world."

In *Oliphant vs. Salem Flouring Mills*, 5 Sawyer, 128, at page 130, the Court said, by Deady, J.:

"The word 'Patent' upon an article is *prima facie* an assertion that it has some

peculiar value or merit sufficient to induce the Government, upon a thorough examination of the subject, to give the inventor the exclusive right to make and vend the same. The impression which the fact ordinarily makes upon the mind is that the article marked 'patent' is in some respects more useful or desirable than articles of the same general kind or use which are not so marked. If, then, a person marks an unpatented article with the word 'patent,' the public are thereby liable to be deceived as to the character and value of the article. The act is a species of counterfeiting. This being so, the presumption is, until the contrary appears, that the mark was placed upon the article with the intention to deceive. The falsehood is a badge of fraud. \* \* \* From this it appears that the law applies to all unpatented articles, whether patentable or not, for the plain reason that *the public should not be prevented from exercising their undoubted right to use unpatented articles by the false, and maybe corrupt assertion of anyone, that they are patented.*"

In *Preservaline Mfg. Co. vs. Heller Chemical Co.*, 118 Fed. Rep., 103, Judge Kohlsaas even denied relief where complaint actually had had a patent, which had expired, but continued to describe the article as patented. After reviewing several instructive English cases, the Court said:

"It therefore remains only to determine whether complainant comes within the rule of courts of equity denying relief. The reason for such rule seems to be that *any use of the terms 'patent' or 'patentee' which will cause the public to believe that a particular article is patented must necessarily have a tendency to deter individuals from the manufacture or handling of such article.* The re-

sult of this will be to stifle competition, and to extend the monopoly granted by the patent beyond the term of such grant. It is my opinion that the skilful use of these terms upon circulars and advertising matter generally would, as a rule, have a greater tendency to impress the public with such belief than would their use directly upon a package or trade-mark. *It is the result, not the manner of accomplishing it, which should be looked to.* If complainant had used the word 'patented' upon all its printed matter and circulars, therefore, in such a manner as would be calculated to convey the idea that the article 'Preservaline' was protected by an existing patent, this case would come squarely within the rule above laid down. Does the fact that complainant does so only in connection with a part of such advertising matter change the situation? I do not think that this is the law. The use of fraudulent matter in any considerable part of the advertising media tinges the whole with that fraud upon which equity looks with disfavor. *The natural effect of the language used upon the five circulars attached to complainant's bill is to mislead and deceive the public, and complainant cannot be heard to deny the intention of so doing."*

In the recent decision of this Court in *Worden vs. California Fig Syrup Co.*, 187 U. S., 517, the reasonable and probable construction which the public would be apt to place upon the description was made the test to determine whether it was a false representation disentiing complainant to equitable relief, particularly as to quack medicines, and specious efforts to twist the words from their reasonable significance were discounted.



But the complainant anticipated in the bill that the point just referred to will be raised and states, on page 8, as follows:

“Your orator asserts that his pills are of the kind of medicine known as proprietary or patent medicine, which terms in no sense indicate, or are intended to indicate, that the composition so designated is made under letters patent.”

And he further asserts that the word when used to denote such medicine is not understood to indicate that the medicine is patented!

Complainants who try to make us assume that the words “Beecham’s Patent Pills” distinctly convey to the reader that the pills are not patented, and that the pills are merely a species of so-called proprietary medicine, forgets that the law of this country, with its eye distinctly on this kind of a proposition, has made it a penal act for anyone to mark any article with the word “patent” or “patented” when in fact there is no patent on it, and that the law deals with the probable result of their representation, and not merely their intent, as seen. Nor does complainant call his pills “Patent Medicine,” but he has coined a new deceptive collocation, “Patent Pills,” not understood by any one in this secondary significance of unpatented “patent medicine.”

It is provided by Section 4901 of the United States Revised Statutes as follows:

“Every person who, in any manner, marks upon or affixes to any unpatented article the word ‘*patent*,’ or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every

such offense, to a penalty of not less than one hundred dollars, with costs."

The Century Dictionary has the following under "Patent Medicine": "A drug which is patented, or the name of which is patented, but usually and *less properly* any drug the manufacture and sale of which are restricted in any way."

The alleged restrictions are themselves illegal (Bobbs-Merrill Co. *vs.* Straus, 210 U. S., 339).

It seems to be the complainant's theory that, in spite of the decisions of the Courts hereinbefore referred to, they can nevertheless restrain this defendant in equity from following the decision in the Singer case, which is to the effect that after the expiration of the patent anyone may make the same article, provided he puts his own name as manufacturer clearly upon the same, and that this Court should take the term "Beecham's Patent Pills" to mean that they are Beecham's Pills, for which there is no patent, and never was.

In the case of Oliphant *vs.* Salem Flouring Mills Co. (18 Fed. Cas., p. 647, Case No. 10486), brought under Section 4901 of the Revised Statutes, the Court states, in substance, that if a person marks an unpatented article with the word "patent," the presumption is, until the contrary appears, that the mark was placed on the article with the intention to deceive. In its decision of that case, the Court, commenting on the fact that the term was applied to an article of flour (the complainant's contention evidently being that their patent flour did not mean that the flour had been patented), held that

"it is easy to conceive in the light of numberless patents for special preparations of

see no Am.  
J. Olson,  
W. A. 473.

farinaceous food, of flour being so prepared, either by means of peculiar machinery or some mixture with the grain and some chemical ingredient, as to be patentable,"

and then continues:

*"It is fair to presume that this flour was marked 'patent' for some purpose."*

The words "patent medicine" were originally, at least, unquestionably intended to express the fact that the medicine was in fact "patented," and no *alleged secondary use of the term to indicate that the article is in fact unpatented should, in view of the probable false impression created, violative of public policy, be sanctioned by the courts.*

In addition to this, we call attention to the assignment from Thomas Beecham to Joseph, which, on page 69, states that as partners these two gentlemen had been "manufacturers and vendors of proprietary articles known as 'Beecham's Pills,' 'Beecham's Patent Pills,' 'Beecham's Cough Pills,' etc. What, then, is the signification of the term "Patent" in the second series of articles thus enumerated, when we contrast it with the first?

The Patent Office records for a hundred years show that thousands of patents were granted by this Government for medicines; such, properly, are patent medicines and were properly marked and sold as patented; these records also show that thousands of patents were granted by this Government for pills; such, properly, are patent pills, and were properly marked and sold as patented. And so what inference must be drawn

from the contradistinction between "Beecham's Pills" and "Beecham's Patent Pills"?

Clearly, complainant studiously sought to convey, and succeeded in conveying, the impression that his pills are patented. It is submitted that a false representation is here involved, disentitling complainant to equitable relief.

### POINT V.

**Complainant's false representation that his pills were made in England disentitles him to equitable relief.**

Complainant's misrepresentations as to the country or place where its goods are made and from whence they are imported are completely within the purview of *Manhattan Medicine Co. vs. Wood*, 108 U. S., 218, 222:

"\* \* \* It is sufficient for the disposition of the case that the misrepresentation has been continued by the complainant. *A court of equity will extend no aid to sustain a claim to a trade-mark of an article which is put forth with a misrepresentation to the public as to the manufacturer of the article, and as to the place where it is manufactured, both of which particulars were originally circumstances to guide the purchaser of the medicine.* \* \* \*"

"It is not honest to state that a medicine is manufactured by Moses Atwood, of Georgetown, Massachusetts, when it is manufactured by the Manhattan Medicine Company in the City of New York."

"\* \* \* To put forth a statement, therefore, in the form of a circular or label at-

*tached to an article that it is manufactured in a particular place, by a person whose manufacture there had acquired a great reputation, when, in fact, it is manufactured by a different person at a different place, is a fraud upon the public which no court of equity will countenance."*

This Court then approvingly quotes from the decision of Lord Chancellor Westbury, in *Leather Cloth Co. vs. Am. Leather Cloth Co.*, as follows (108 U. S., 224):

"When the owner of a trade-mark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not in his trade-mark, or in the business connected with it, be himself guilty of any false or *misleading* representation; for if the plaintiff makes any material false statements in connection with the property he seeks to protect, he loses, and very justly, his right to claim the assistance of a court of equity. Where a symbol or label, claimed as a trade-mark, is so constructed or worded as to make or contain a distinct assertion which is false, I think no property can be claimed in it, or, in other words, the right to the exclusive use of it cannot be maintained."

The Court then continues (p. 225):

"The soundness of the doctrines declared by the Lord Chancellor has been recognized in numerous cases. Indeed, it is but an application of the common maxim that he who seeks equity must present himself in court with clean hands. If his case discloses fraud or deception or misrepresentation on his part, relief there will be denied. \* \* \* The

decree of the Court below dismissing the bill must therefore be affirmed, and it is so ordered."

In *Wrisley Co. vs. Iowa Soap Co.*, 104 F. R., 551, McPherson, D. J., said, with regard to a soap sold as "Old Country Soap":

"I have no doubt whatever that the purpose of plaintiff is to make the people in a German community believe that its soap is manufactured in Germany, or at least from a recipe coming from that country; and in an English community that it is a soap manufactured in England \* \* \* and yet the fact is that plaintiff's soap is made in Chicago, Ill., and is manufactured by an Illinois corporation as successor of Mr. Wrisley, an American citizen.

The long and short of this matter is that complainant comes into court upon proof that tends to show that it is practicing a deception, and has been for years. On defendant's box and on defendant's wrappers and on defendant's soap the fact is made known that the soap is manufactured at Burlington, Iowa, and the very name indicates that the soap is American soap.

Plaintiff does not come into court with the right to maintain its action in thus practicing this deception."

## POINT VI.

It is respectfully submitted that the motions to dismiss and affirm should be denied. But if by any possibility, the motion to dismiss should be

regarded as requiring serious consideration, despite the Warner decision, it is prayed that a writ of *certiorari* issue, as in *Farrell vs. O'Brien*, 199 U. S., 89, and the return on appeal stand as the return on *certiorari*.

Respectfully submitted,

MAX J. KOHLER,  
Of Counsel for Appellant.

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Counsel for Appellants.

## JACOBS v. BEECHAM.

APPEAL FROM THE CIRCUIT COURT OF APPEALS FOR THE  
SECOND CIRCUIT.

No. 139. Argued April 21, 24, 1911.—Decided May 15, 1911.

*Corruptio optimi pessima.* Sound general principles should not be turned to support a conclusion manifestly improper.

Even if the burden of proof is on one manufacturing a named article under a secret formula to prove that one selling an article by the same name is not manufacturing under that formula, there is a *prima facie* presumption of difference, which protects the owner without requiring him to give up the secret.

The burden is on a defendant who uses plaintiff's trade-name to justify the using thereof.

Where the name of the originator has not left him to travel with the goods the name remains with the manufacturer, as an expression of source and not of character.

The word "Beecham's" as used in connection with pills manufactured by the party of that name is not generic as to the article manufactured but individual as to the producer; and one calling his product by the same name is guilty of unfair trade even if he states that he, and not Beecham, makes them.

The word "patent" as used in connection with medicines does not mean that the article is patented but that it is proprietary; and there is no fraud on the public in using the word in that sense although the article has not been patented.

The proprietor of a valuable article will not be deprived of protection against unfair trade because of certain trivial misstatements as to place of manufacture and Christian name of manufacturer when both statements were true at one time and it does not appear that the public have been improperly misled.

159 Fed. Rep. 129, affirmed.

THE facts are stated in the opinion.

*Mr. George F. Hurd* and *Mr. Cornelius W. Wickersham* (by leave of the court), with whom *Mr. Max J. Kohler*,



*Mr. Moses Weill* and *Mr. Isaac Weill* were on the brief, for appellants:

The right to use the name of Beecham is *publici juris*, and defendant is not guilty of unfair competition. Appellee has no trade-mark. There can be no trade-mark in a proper name. *Canal Co. v. Clark*, 13 Wall. 311; *Brown Chemical Co. v. Meyer*, 139 U. S. 540; *Corbin v. Gould*, 133 U. S. 308; *LeClanche Battery Co. v. Western Elec. Co.*, 23 Fed. Rep. 276; *Hopkins on Trade-marks*, 2d ed., §§ 40, 53.

No unfair competition has been shown. There is no evidence that defendant's pills were inferior or dissimilar to complainant's. The burden of proving such inferiority or dissimilarity, had it existed, was on complainant-appellee, and in the absence of evidence thereon an injunction granted upon that ground would be unwarranted. *Baglin v. Cusenier Co.*, 164 Fed. Rep. 25 (the *Chartreuse* case); *Hostetter Co. v. Comerford*, 97 Fed. Rep. 585; *Goodyear's &c. Co. v. Goodyear Rubber Co.*, 128 U. S. 598, 604; *LaMont v. Leedy*, 88 Fed. Rep. 72.

Appellant has not used the name "Beecham" in any manner whatever calculated to deceive the public into a belief that the goods offered for sale by him are those of the appellee. He sold pills designated as Beecham Pills, manufactured by Mark Jacobs, Maspeth, L. I., N. Y., U. S. A.

If a secret process is unpatented anyone may use it and enter into competition with the original discoverer. *Canham v. Jones*, 2 Vesey & B. 218; *Saxlehner v. Wagner*, 216 U. S. 375; *Chadwick v. Covell*, 151 Massachusetts, 190; *Watkins v. Landon*, 52 Minnesota, 389.

This principle is also upheld in *Marshall v. Pinkham*, 52 Wisconsin, 572; *Park & Sons Co. v. Hartman*, 153 Fed. Rep. 24, 29, 32, 33; *Singleton v. Bolton*, 3 Douglas, 293; *Canham v. Jones*, 2 Vesey & B. 218; *Burgess v. Burgess*, 17 Eng. L. & E. 257; *James v. James*, L. R. 13 Eq. Cas. 421; *Massam v. Thorley's C. F. Co.*, 6 Ch. Div. 574; and

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see where the secret process or formula was originally protected by letters patent, but the patent has expired, *Singer Company v. June*, 163 U. S. 169, 185.

The only distinction between the cases where no patent ever existed and where a patent has expired, is in the method by which the right is obtained—in the one case by dedication, and in the other by the acquisition of knowledge of the secret. The resulting right is the same, as was intimated by this court in the *Hunyadi Case*, 216 U. S. 381. *Fowle v. Park*, 131 U. S. 88, is distinguishable.

Complainant has no exclusive right to the manufacture and sale of these pills, nor to the use of the word "Beecham" in connection therewith; that word being generic and the only designation of the product, is open to use by anyone who actually engages in the business of manufacturing and selling this commodity, care being taken to state by whom it is in fact manufactured. The false use of the word "patent" disentitles complainant to equitable relief. *Holzappel's v. Rahtjen's Co.*, 183 U. S. 1; *Oliphant v. Salem Flouring Mills*, 5 Sawyer, 128; *Consolidated v. Dorflinger*, Fed. Cas. No. 3129; *Leather Cloth Co. v. Am. Leather Cloth Co.*, 11 H. L. Cas. 523; *Worden v. California Fig Syrup Co.*, 187 U. S. 516.

Cases cited in 28 Am. & Eng. Ency. of Law, 356, and *Solez Cigar Co. v. Pozo*, 16 Colorado, 388; *Ford v. Foster*, L. R. 7 Ch. Div. 611, relate only to where there was a patent which had expired; but see *Cheavin v. Walker*, 5 Ch. Div. 850; *Preservaline Mfg. Co. v. Heller Chemical Co.*, 118 Fed. Rep. 103; and § 4901, Rev. Stat. The English courts have established a similar doctrine.

In the case at bar, complainant relied on a secret process, and defendant used the name given to the article by the discoverer of the invention, adding, however, that it was manufactured by themselves. *Cheavin v. Walker*, 5 Ch. Div. 850; *Pharmaceutical Society v. Piper*, 1893, L. R. 1 Q. B. 686; *Fulton on Patents, Trade-marks and*

Designs (London, 1902), 188; *Consolidated v. Dorflinger*, Fed. Cas. No. 3129.

Complainant has been guilty of deceiving the public, and he now attempts to wash the stain of unconscionable conduct from his hands by a denial of misrepresentation. The case is unlike that of patent leather shoes, because the word "patent" as used by him is not descriptive.

The misrepresentation of manufacture in England, and the continued use of the name Thomas Beecham disentitle complainant to equitable relief. A complainant who has deceived the public by a false statement in regard to the place of manufacture of his commodity is not entitled to relief in equity. *Manhattan Medicine Co. v. Wood*, 108 U. S. 218, 222; *Worden v. California Fig Syrup Co.*, *supra*, at 528; *Palmer v. Harris*, 60 Pa. 156.

There is certainly enough in Joseph Beecham's labels to convey to everyone who can read that the pills are still made in England, where the business was solely conducted until about 1890, particularly in view of the express statements on circulars used for years thereafter that the pills were prepared in that country. *Saunion & Co.*, Cox's Manual, case 625; Browne on Trade-marks, 2d ed., § 71, p. 78; *Solez Cigar Co. v. Pozo & Suarez*, 16 Colorado, 388, 394; *Wrisley v. Iowa Soap Co.*, 104 Fed. Rep. 548. See also *Kenny v. Gillet*, 70 Maryland, 574; *Prince M. Co. v. Prince's Metallic Paint Co.*, 135 N. Y. 24; *Hobbs v. Francis*, 19 How. Pr. (N. Y.) 567; *Millrae Co. v. Taylor*, 37 Pac. Rep. 235 (Cal.); *Coleman Co. v. Dannenberg Co.*, 103 Georgia, 784; *Raymond v. Royal Baking Powder Co.*, 85 Fed. Rep. 231.

Complainant's failure to state in his labels the change of manufacture after the assignment from Thomas Beecham is another element of his inequitable conduct.

The continued use of the name of Thomas Beecham by complainant should, therefore, disentitle him to the relief

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sought. Paul on Trade-marks, § 318, p. 543; *Stachelberg v. Ponce*, 23 Fed. Rep. 430 (affirmed on other grounds, 128 U. S. 686); *Symonds v. Jones*, 82 Maine, 302, 315; *Hegeman & Co. v. Hegeman*, 8 Daly (N. Y.), 1, 22; *Royal Baking Powder Co. v. Raymond*, 70 Fed. Rep. 376; *S. C.*, aff'd 85 Fed. Rep. 231. See also *Seigert v. Abbott*, 61 Maryland, 276; *Alaska Packer's Assn. v. Alaska Imp. Co.*, 60 Fed. Rep. 103 (even where labels corrected after suit brought).

The court has jurisdiction of the case at bar under § 6 of the act of March 3, 1891.

*Mr. John L. Wilkie* for appellee.

The appellee has not represented that his pills are manufactured under letters patent by using the words "Patent Pills."

As to cases where the word "patent" was held not to indicate and did not in fact indicate that the article to which it was applied was in fact patented, see *Cahn v. Gottschalk*, 14 Daly, 542; *Cochrane v. McNish*, 1896, App. Cas. 225; *Marshall v. Ross*, L. R. 8 Eq. 651; *Stewart v. Smithson*, 1 Hilton, 119; *Leather Cloth Co. v. Am. Leather Cloth Co.*, 11 H. L. 523; *Ins. Oil Tank Co. v. Scott*, 33 La. Ann. 946.

The word "patent" is frequently used in combinations not intended to indicate that the article has been in fact patented. See *Century Dictionary*; *Murray's Oxford Dictionary*; *Encyclopædic Dictionary*; *Stormonth's Dictionary*; *Brewer's Etymological and Pronouncing Dictionary of Difficult Words*.

In many statutes in this country the word "patent" as applied to medicines is used as interchangeable with "proprietary," and such use of the word has, therefore, obtained a legislative sanction. The citations are so numerous that they can at best be merely classified.

In the following statutes the phrase "patent or proprietary medicines" occurs in provisions regulating their

preparation and sale: Rev. Stat., § 3436; Arkansas Dig. of Statutes, § 5283; Dakota Territory Rev. Stat., §§ 228, 229; Hawaii Territory Rev. Stat., § 1095; Illinois Rev. Stat., c. 91, § 30; Indiana Rev. Stat., § 5000i; Maine Rev. Stat., c. 30, § 13; Michigan Rev. Laws, § 5312; New Jersey Public Laws, 1895, p. 365, § 8; North Dakota Rev. Stat., § 7281; Ohio Rev. Stat., § 4405; Tennessee Code, § 3635; Vermont Rev. Stat., § 4663; Washington Codes and Statutes, § 2877; Wyoming Rev. Stat., § 2222.

In the following three statutes the phrase is "proprietary and patent medicines." Colorado Rev. Stat., § 4909; Florida Rev. Stat., § 814; Oregon Codes and Statutes, § 3811. See also Massachusetts Rev. Stat., c. 76, § 23; Utah Rev. Stat., § 1725; Kentucky Rev. Stat., § 2631; Delaware, c. 36, Vol. 18, § 1; South Carolina Civil Code, § 1126; Louisiana Laws of 1888, act 66, p. 74, § 3; Pennsylvania Public Laws, 189, § 6 (1887, May 24); Rhode Island Rev. Stat., c. 152, § 8; South Dakota Political Code, § 281; West Virginia Code, c. 150, § 7.

For legal construction see *State v. Donaldson*, 41 Minnesota, 74; *Nordyke v. Kehlor*, 155 Missouri, 643, 653; *Palmer v. McCormick*, 30 Fed. Rep. 82.

The appellee has not been guilty of any false representations either as to the place of manufacture of his product or the person by whom the same is manufactured.

Even if a statement as to place of manufacture were misleading, it has been abandoned for seventeen years and cannot be made the basis of successful piracy of the name "Beecham." The discontinuance of a misstatement when made before suit brought relieves the complainant of the effect of the rule. *Moxie Nerve & Food Co. v. Modox Co.*, 153 Fed. Rep. 487; *Johnson & Johnson v. Sedbury & Johnson* (N. J.), 67 Atl. Rep. 36; *Symonds v. Jones*, 82 Maine, 302.

As to the alleged misstatement that the pills are prepared only and sold wholesale by the proprietor, Thomas

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Beecham, Lancashire, England, all of the forms used since 1902 are necessarily objectionable and under the authorities cited appellant cannot rake up the past to find in a long discontinued user, evidence of untrue statements. See "*Moxie*" and other cases, *supra*.

Also the alleged misstatement is that the pills are specially packed for the United States of America, being covered with a quickly soluble, pleasant coating, completely disguising the taste of the pill. This was used while the pills were both packed and made in the United States, and the whole question is whether or not the clause is false, not by virtue of what it says, but of what it suggests. *Wrisley Co. v. Iowa Soap Co.*, 104 Fed. Rep. 548, does not apply. The words here do not call for the interpretation that the pills are made in England, although packed for the United States. They are equally true wherever the pills are made. See *Tarrant & Co. v. Johann Hoff*, 76 Fed. Rep. 959; *Clark Thread Co. v. Armitage*, 74 Fed. Rep. 936; *Société Anonyme v. Western Distilling Co.*, 43 Fed. Rep. 416; *Siebert v. Gandolfi*, 149 Fed. Rep. 100; *Gluckman v. Strauch*, 99 App. Div. 361; *aff'd* 186 N. Y. 560.

As to alleged misrepresentations as to the persons by whom the pills are manufactured, there was no misrepresentation. *Manhattan Medicine Co. v. Wood*, 108 U. S. 218.

The real proprietor of the trade-name used in connection with these pills has never been the person of Thomas Beecham as distinguished from Joseph, or any other person, but has always been and is "Thomas Beecham of St. Helens, England," a partnership formerly composed of both Thomas and Joseph to which the latter succeeded as sole surviving partner. The appellee is lawfully continuing the business under the old name, as he has done since 1895, and the statement that the pills were manufactured and sold "by the proprietor Thomas Beecham, St. Helens, England," was strictly speaking as accurate

in point of fact after the transfer of 1895 as it was before. It cannot be regarded as a misrepresentation or a fraudulent statement.

The appellee is not barred from relief because his pills happen to be made under a secret process or formula. The rule that an owner of a secret process, unpatented, may not enjoin another from manufacturing goods under that process and marketing them under the name used to describe them by the original manufacturer, and by which they have come to be known to the public, provided the latter comes to his knowledge of the process in good faith has no application to this case.

Appellee's right to relief does not depend in any way upon the fact of his goods being manufactured under a secret process. His right to relief depends simply upon the fact of the appellant's manufacturing and selling similar goods, calling them by his trade-name.

There is no less right on the part of a manufacturer of goods made under a secret process or formula to protection of his trade-name than on the part of an ordinary manufacturer of goods.

The rule is not that the owner of a valuable trade-name cannot enjoin the manufacturer of similar goods under the same name unless he can show that such goods are manufactured under a secret process other than that used by himself, but rather that he can enjoin such use of his trade-name unless the person attempting to use the same can justify his attempted use by showing similarity of secret process and good faith in the acquisition of knowledge as to the same.

MR. JUSTICE HOLMES delivered the opinion of the court.

This is a bill by the owner of a proprietary or patent medicine, so called, made according to a secret formula and known as Beecham's Pills, to restrain the defendant



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from using the same name on pills made by him, and trying to appropriate the plaintiff's good will. The plaintiff had a decree in the Circuit Court enjoining the defendant from using the word Beecham in connection with pills prepared or sold by him, which decree was affirmed by the Circuit Court of Appeals. 159 Fed. Rep. 129. 86 C. C. A. 623.

The present appeal is based on two or three different grounds. The first of these is that anyone who honestly can discover the formula has a right to use it, to tell the public that he is using it, and for that purpose to employ the only words by which the formula can be identified to the public mind. As to the defendant's having discovered the formula, it is said that if he makes a different or inferior article the burden is on the plaintiff to prove the fact. As to the method adopted by the defendant to advertise his wares, which, apart from other imitations, consists in simply marking them Beecham's Pills, it is said that the proper name cannot constitute a trade-mark and has become the generic designation of the thing. The defendant's use of the name is said to be saved from being unfair by the statement underneath that he made the pills.

*Corruptio optimi pessima.* Sound general propositions thus are turned to the support of a conclusion that manifestly should not be reached. We will follow and answer the argument in the order in which we have stated it. If, in a technical sense, the burden of proof is on the plaintiffs to prove that the defendant's pills are not made by his formula, there is at least a *prima facie* presumption of difference, just as in the case of slander there is a presumption that slanderous words are false. A different rule would prevent the owner of a secret process from protecting it except by giving up his secret. Again, when the defendant has to justify using the plaintiff's trade-name, the burden is on him. Finally, as the case presents what is a fraud on its face, it is more likely that the defendant is



a modern advertiser than that he has discovered the hidden formula of the plaintiff's success.

As to the defendant's method of advertising, he does not simply say that he has the Beecham formula, as in *Saxlehner v. Wagner*, 216 U. S. 375, but he says that he makes Beecham's Pills. The only sense in which Beecham's Pills can be said to have become a designation of the article is that Beecham, so far as appears, is the only man who has made it. But there is nothing generic in the designation. It is in the highest degree individual and means the producer as much as the product. It has not left the originator, to travel with the goods, as in *Chadwick v. Covell*, 151 Massachusetts, 190, 195, or come to express character rather than source, as it is admitted sometimes may be the case. *Holzapsfel's Compositions Co. v. Rahtjen's American Composition Co.*, 183 U. S. 1. *Goodyear's India Rubber Glove Manuf. Co. v. Goodyear Rubber Co.*, 128 U. S. 598. *Thomson v. Winchester*, 19 Pick. 214, 216. To call pills Beecham's Pills is to call them the plaintiff's pills. The statement that the defendant makes them does not save the fraud. That is not what the public would notice or is intended to notice, and, if it did, its natural interpretation would be that the defendant had bought the original business out and was carrying it on. It would be unfair, even if we could assume, as we cannot, that the defendant uses the plaintiff's formula for his pills. *McLean v. Fleming*, 96 U. S. 245, 252. *Millington v. Fox*, 3 My. & Cr. 338, 352. *Gilman v. Hunnewell*, 122 Massachusetts, 139, 148.

The other grounds of appeal are charges that the plaintiff's boxes have upon them false statements such as to exclude him from equitable relief. The one most pressed is that certain of the boxes carry the words Beecham's Patent Pills, and that the pills are not patented. The answer is that the word does not convey the notion that they are. To signify that, the proper word is 'patented'

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rather than 'patent,' and it commonly is used separately, not prefixed to a noun. On the other hand, the use of the word patent to indicate medicines made by secret formulas is widespread and well known. It is mentioned in the dictionaries, and it occurs in the plaintiff's circulars. We think it clear that there is no danger that anyone would be defrauded by the form of the label on the plaintiff's box, and that it would be wrong to press *Holzapsfel's Compositions Co. v. Rahtjen's American Composition Co.*, 183 U. S. 1, so far as to cover this case.

It is objected further that the plaintiff's boxes are labelled "Beecham's Patent Pills, price 25 cents, sold by the Proprietor, St. Helens, Lancashire, England," or "Beecham's Patent Pills, St. Helens, Lancashire," or "Beecham's Pills, Saint Helens," and that a circular contains the statement that "The pills accompanying this pamphlet are specially packed for U. S. America, being covered with a quickly soluble pleasant coating" &c. The statement in the circular is true in a literal sense, but suggests the belief that the pills were made in England whereas in fact they now are made in New York. The labels may be said to convey a similar suggestion in a fainter form. With this may be mentioned the remaining object of cavil, that some of the boxes still bear the name of Thomas Beecham, although Thomas Beecham transferred his interest to the plaintiff, his son, in 1895. Both of these matters are small survivals from a time when they were literally true and are far too insignificant when taken with the total character of the plaintiff's advertising to leave him a defenceless prey to the world. The facts are that the business was started by Thomas Beecham, in England, that he made the pills there and got a considerable custom in America, that he took the plaintiff into partnership, continuing the business under the old name, and that in 1895 he retired, turning over his interest to his son. The son went on under the same name for a time, but his boxes now bear his

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own name as proprietor, and his circulars show that he is his father's successor. About 1890 they began to make the pills in New York as well as in England, but, as has been seen, not every phrase in the advertisements was nicely readjusted to the change. That is all there is in the whole subject of complaint. There is not the slightest ground for charging the plaintiff with an attempt to defraud the public by these statements, or any reason why the judgment below should not be affirmed, unless it be in a motion of the plaintiff to dismiss. This was met by the fact that the bill seemingly relied upon the registration of the words Beecham's Pills as a trade-mark under the act of Congress as one ground for the jurisdiction of the Circuit Court. *Warner v. Searle & Hereth Co.*, 191 U. S. 195, 205, 206; *Standard Paint Co. v. Trinidad Asphalt Manuf. Co.*, 220 U. S. 446.

*Decree affirmed.*

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